No. 17-571	
Title:	**Fourth Estate Public Benefit Corporation, Petitioner** **v.** **Wall-Street.com, LLC, et al.**
Docketed:	October 16, 2017
Linked with 17A150	
Lower Ct:	United States Court of Appeals for the Eleventh Circuit
Case Numbers:	(16-13726)
Decision Date:	May 18, 2017
Questions Presented	

DATE	PROCEEDINGS AND ORDERS
Aug 04 2017	Application (17A150) to extend the time to file a petition for a writ of certiorari from August 16, 2017 to October 13, 2017, submitted to Justice Thomas.
Aug 07 2017	Application (17A150) granted by Justice Thomas extending the time to file until October 13, 2017.
Oct 13 2017	Petition for a writ of certiorari filed. (Response due November 15, 2017)
Oct 13 2017	Waiver of right of respondents Wall-Street.com, LLC, et al. to respond filed.
Nov 01 2017	DISTRIBUTED for Conference of 11/21/2017.
Nov 02 2017	Response Requested. (Due December 4, 2017)
Nov 28 2017	Brief of respondents Wall-Street.com, LLC, et al. in opposition filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Dec 13 2017	DISTRIBUTED for Conference of 1/5/2018.
Dec 13 2017	Reply of petitioner Fourth Estate Public Benefit Corporation filed. (Distributed) **Main Document** **Certificate of Word Count** **Proof of Service**
Jan 08 2018	The Solicitor General is invited to file a brief in this case expressing the views of the United States.

May 16 2018	Brief amicus curiae of United States filed. **Proof of Service** **Main Document**
Jun 05 2018	DISTRIBUTED for Conference of 6/21/2018.
Jun 05 2018	Supplemental brief of petitioner Fourth Estate Pub. Benefit Corp. filed. (Distributed) **Main Document** **Certificate of Word Count** **Proof of Service**
Jun 27 2018	DISTRIBUTED for Conference of 6/27/2018.
Jun 28 2018	Petition GRANTED.
Jul 23 2018	Motion for an extension of time filed. **Main Document** **Proof of Service**
Jul 24 2018	Blanket Consent received from counsel of record for Petitioner, Fourth Estate Public Benefit Corporation filed. **Blanket Consent** **Proof of Service**
Jul 24 2018	Motion to dispense with printing the joint appendix filed by petitioner Fourth Estate Pub. Benefit Corp. **Main Document** **Proof of Service**
Jul 25 2018	Blanket Consent filed by Respondents, Wall-Street.com, LLC, et al. **Blanket Consent** **Proof of Service**
Jul 27 2018	Motion to extend the time to file the opening briefs on the merits granted. The time to file the joint appendix and petitioner's brief on the merits is extended to and including August 27, 2018. The time to file respondents' brief on the merits is extended to and including October 11, 2018.
Aug 24 2018	Motion to dispense with printing the joint appendix filed by petitioner GRANTED.
Aug 27 2018	Brief of petitioner Fourth Estate Pub. Benefit Corp. filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Sep 04 2018	Brief amicus curiae of American Bar Association filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Sep 04 2018	Brief amicus curiae of The Copyright Alliance filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Sep 04 2018	Brief amici curiae of National Music Publishers' Association, et al. filed. **Main Document** **Proof of Service** **Certificate of Word Count**

Sep 04 2018	Brief amici curiae of Authors Guild and Other Artists' Rights Organizations filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Sep 04 2018	Brief amicus curiae of The International Trademark Association filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Oct 11 2018	Brief of respondents Wall-Street.com, LLC, et al. filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Oct 18 2018	Brief amici curiae of Authors and Educators filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Oct 18 2018	Brief amicus curiae of Washington Legal Foundation filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Oct 18 2018	Brief amicus curiae of United States filed. **Proof of Service** **Main Document**
Oct 18 2018	Motion of the Solicitor General for leave to participate in oral argument as amicus curiae and for divided argument filed. **Proof of Service** **Main Document**
Oct 18 2018	Brief amici curiae of Public Knowledge, et al. filed. **Main Document** **Proof of Service** **Certificate of Word Count**
Oct 26 2018	Motion of the Solicitor General for leave to participate in oral argument as amicus curiae and for divided argument GRANTED.
Nov 13 2018	Reply of petitioner Fourth Estate Pub. Benefit Corp. filed. **Main Document** **Certificate of Word Count** **Proof of Service**
Nov 28 2018	SET FOR ARGUMENT ON Tuesday, January 8, 2019
Nov 30 2018	CIRCULATED
Dec 11 2018	Record requested from the U.S.C.A. 11th Circuit.
Dec 13 2018	Record received from the U.S.D.C. Southern Dist. of Florida Fort Lauderdale Division is electronic and complete.
Dec 17 2018	Record from the U.S.C.A. 11th Circuit is electronic and located on PACER.
Jan 08 2019	Argued. For petitioner: Aaron M. Panner, Washington, D. C. For respondents: Peter K. Stris, Los Angeles, Cal.; and Jonathan Y. Ellis, Assistant to the Solicitor General, Department of Justice, Washington, D. C. (for United States, as amicus curiae.)

NAME	ADDRESS	PHONE
Attorneys for Petitioner		
Aaron M. Panner Counsel of Record	Kellogg, Hansen, Todd, Figel & Frederick, PLLC 1615 M Street, NW Suite 400 Washington, DC 20036 apanner@kellogghansen.com	202-326-7900
Party name: Fourth Estate Pub. Benefit Corp.		
Attorneys for Respondents		
Peter K. Stris Counsel of Record	Stris & Maher LLP 725 S. Figueroa St., Ste. 1830 Los Angeles, CA 90017 peter.stris@strismaher.com	(213) 995-6801
Party name: Wall-Street.com, LLC, et al.		
Other		
Cory L. Andrews Counsel of Record	Washington Legal Foundation 2009 Massachusetts Avenue, NW Washington, DC 20036 candrews@wlf.org	202.588.0302
Party name: Washington Legal Foundation		
Robert M. Carlson Counsel of Record	Corette Pohlman, et al. 129 W. Park Butte, MT 59701 annaliese.fleming@americanbar.org	312-988-5000
Party name: AMERICAN BAR ASSOCIATION		
Harold Feld Counsel of Record	Public Knowledge 1818 N Street NW Suite 410 Washington, DC 20036 hfeld@publicknowledge.org	202-861-0020
Party name: Public Knowledge and The R Street Institute		
Noel J. Francisco Counsel of Record	Solicitor General United States Department of Justice 950 Pennsylvania Avenue, NW Washington, DC 20530-0001 SupremeCtBriefs@USDOJ.gov	202-514-2217
Party name: United States		

Peter Jaszi
Counsel of Record
Washington College of Law, AU
4300 Nebraska Ave NW
Washington, DC 20016
pjaszi@wcl.american.edu
2406051934

Party name: Authors and Educators

Hillary Brill
Glushko Samuelson Intellectual Property Clinic
4300 Nebraska Ave NW
Washington, DC 20016
hillary_brill@yahoo.com
2028216698

Party name: Authors and Educators

Beth Susan Brinkmann
Counsel of Record
Covington & Burling
850 Tenth Street, NW
Washington, DC 20001-4956
bbrinkmann@cov.com
202-662-5312

Party name: National Music Publishers' Association; Recording Industry Association of America; American Society of Composers, Authors and Publishers; Broadcast Music, Inc.; Nashville Songwriters Association International; Songwriters of North America

Eleanor Martine Lackman
Counsel of Record
Cowan DeBaets Abrahams & Sheppard LLP
41 Madison Avenue, 38th Floor
New York, NY 10010
Elackman@cdas.com
212-974-7474

Party name: Authors Guild and Other Artists' Rights Organizations

Lawrence K. Nodine
Counsel of Record
Ballard Spahr, LLP
999 Peachtree St., Suite 1000
Atlanta, GA 30309
nodinel@ballardspahr.com
(678) 420-9422

Party name: THE INTERNATIONAL TRADEMARK ASSOCIATION

John Matthew DeWeese Williams
Counsel of Record
Mitchell Silberberg & Knupp LLP
1818 N. Street NW, 8th Floor
Washington, DC 20036
mxw@msk.com
202-355-7900

Party name: The Copyright Alliance

RECORD AND BRIEFS

17 571

No. __-____

IN THE
Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURDEN,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

PETITION FOR A WRIT OF CERTIORARI

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN INTELLECTUAL PROPERTY LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
COLLIN R. WHITE
KELLOGG, HANSEN, TODD, FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

October 13, 2017

Library of Congress
Law Library

QUESTION PRESENTED

Section 411(a) of the Copyright Act provides (with qualifications) that "no civil action for infringement of [a] copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). The question presented is:

Whether "registration of [a] copyright claim has been made" within the meaning of § 411(a) when the copyright holder delivers the required application, deposit, and fee to the Copyright Office, as the Fifth and Ninth Circuits have held, or only once the Copyright Office acts on that application, as the Tenth Circuit and, in the decision below, the Eleventh Circuit have held.

PARTIES TO THE PROCEEDINGS

Petitioner Fourth Estate Public Benefit Corporation was the plaintiff and the appellant in the proceedings below.

Respondents Wall-Street.com, LLC and Jerrold D. Burden were the defendants and the appellees in the proceedings below.

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, petitioner Fourth Estate Public Benefit Corporation states that it is a public benefit corporation that has not issued any stock.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

PARTIES TO THE PROCEEDINGS ii

RULE 29.6 STATEMENT iii

TABLE OF AUTHORITIES vii

OPINIONS BELOW 1

JURISDICTION 1

STATUTORY PROVISIONS INVOLVED 1

INTRODUCTION 1

STATEMENT 3

A. Statutory Background 3

B. Factual Background 6

C. Proceedings Below 7

REASONS FOR GRANTING THE PETITION 9

I. THE COURT SHOULD GRANT REVIEW TO RESOLVE A CONFLICT AMONG THE COURTS OF APPEALS ON A MATTER OF SIGNIFICANT PRACTICAL IMPORTANCE 9

A. The Courts Of Appeals Are Divided On The Question Presented And Will Remain So Absent This Court's Review 9

B. The Question Presented Is Important 15

C. This Case Provides An Appropriate Vehicle For Resolution Of The Question Presented 17

II. THE ELEVENTH CIRCUIT'S DECISION CONFLICTS WITH THE COPYRIGHT ACT 17

A. A Careful Reading Of The Statute's Text Establishes That The Eleventh Circuit's Construction Is Incorrect 18

B. The Eleventh Circuit's Interpretation Is Inconsistent With The Copyright Act's Scheme Of Rights and Remedies 22

CONCLUSION 26

APPENDIX

Opinion of the United States Court of Appeals for the Eleventh Circuit, *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, et al.*, No. 16-13726 (May 18, 2017) 1a

Order of the United States District Court for the Southern District of Florida Granting Motion To Dismiss, *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, et al.*, Civil Action No. 16-60497-Civ-Scola (May 23, 2016) 11a

Complaint for Copyright Infringement, *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, et al.*, Civil Action No. 16-60497-Civ-Scola (S.D. Fla. filed Mar. 11, 2016) (exhibits omitted) ... 15a

Statutory Provisions Involved 23a

Copyright Act (17 U.S.C.):

17 U.S.C. § 101 (excerpt) 23a

17 U.S.C. § 408 ..... 23a

17 U.S.C. § 409 ..... 28a

17 U.S.C. § 410 ..... 29a

17 U.S.C. § 411 ..... 30a

17 U.S.C. § 412 ..... 32a

17 U.S.C. § 501 ..... 33a

17 U.S.C. § 502 ..... 35a

Letter from Supreme Court Clerk regarding grant of extension of time for filing a petition for a writ of certiorari (Aug. 7, 2017) 36a

TABLE OF AUTHORITIES

Page

CASES

Alicea v. Machete Music, 744 F.3d 773 (1st Cir. 2014) 14

Apple Barrel Prods., Inc. v. Beard, 730 F.2d 384 (5th Cir. 1984) 10, 12

Barber v. Thomas, 560 U.S. 474 (2010) 21

Brooks-Ngwenya v. Indianapolis Pub. Sch., 564 F.3d 804 (7th Cir. 2009) 14

Caner v. Autry, 16 F. Supp. 3d 689 (W.D. Va. 2014) 14

Chevrestt v. American Media, Inc., 204 F. Supp. 3d 629 (S.D.N.Y. 2016) 14

Chicago Bd. of Educ. v. Substance, Inc., 354 F.3d 624 (7th Cir. 2003) 14

Cosmetic Ideas, Inc. v. IAC/Interactivecorp., 606 F.3d 612 (9th Cir. 2010) 10, 11, 12, 26

FDA v. Brown & Williamson Tobacco Corp., 529 U.S. 120 (2000) 22

Gaiman v. McFarlane, 360 F.3d 644 (7th Cir. 2004) 14

Gattoni v. Tibi, LLC, No. 16 Civ. 7527 (RWS), 2017 WL 2313882 (S.D.N.Y. May 25, 2017) 14

K-Beech, Inc. v. Doe, Civil Action No. 11-7083, 2012 WL 262722 (E.D. Pa. Jan. 30, 2012) 14

La Resolana Architects, PA v. Clay Realtors Angel Fire, 416 F.3d 1195 (10th Cir. 2005) 13, 14, 15, 24

Lakedreams v. Taylor, 932 F.2d 1103 (5th Cir. 1991).....10, 12

Liteky v. United States, 510 U.S. 540 (1994) 18-19

Mays & Assocs. Inc. v. Euler, 370 F. Supp. 2d 362 (D. Md. 2005) 14

Microsoft Corp. v. i4i Ltd. P'ship, 564 U.S. 91 (2011) 25

North Jersey Media Grp. Inc. v. Sasson, Civ. No. 2:12-3568 (WJM), 2013 WL 74237 (D.N.J. Jan. 4, 2013)..... 14

Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962 (2014)..... 5

Positive Black Talk Inc. v. Cash Money Records Inc., 394 F.3d 357 (5th Cir. 2004) 10, 12

Prunte v. Universal Music Grp., 484 F. Supp. 2d 32 (D.D.C. 2007) 15

Psihoyos v. John Wiley & Sons, Inc., 748 F.3d 120 (2d Cir. 2014) 5, 14

Reed Elsevier, Inc. v. Muchnick, 559 U.S. 154 (2010) 5, 10, 15

Strategy Source, Inc. v. Lee, 233 F. Supp. 2d 1 (D.D.C. 2002) 15

Syntek Semiconductor Co. v. Microchip Tech. Inc., 307 F.3d 775 (9th Cir. 2002) 25

STATUTES AND REGULATIONS

Copyright Act of 1909, ch. 320, 35 Stat. 1075 23

Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 20

Copyright Act (17 U.S.C.) ..... *passim*

17 U.S.C. § 101 ..... 10, 17

17 U.S.C. § 102(a) 3, 22, 25

17 U.S.C. § 106 3

17 U.S.C. § 408(a) 1, 3, 8, 22

17 U.S.C. § 408(b) 3

17 U.S.C. § 408(c)(3) 20

17 U.S.C. § 408(e) 20

17 U.S.C. § 408(f) 21

17 U.S.C. § 409 3

17 U.S.C. § 410(a) 3, 7, 13, 20, 21

17 U.S.C. § 410(b) 4, 7, 8, 13, 21

17 U.S.C. § 410(c) 6, 24, 25

17 U.S.C. § 410(d) 4, 8, 12, 14, 23

17 U.S.C. § 411(a) 1, 5, 6, 7, 9, 10, 12, 13, 15, 16, 17, 18, 22

17 U.S.C. § 411(b) 18

17 U.S.C. § 411(c) 19, 21

17 U.S.C. § 412 ..... 20, 21

17 U.S.C. § 412(2) 20, 21

17 U.S.C. § 501(a) 5

17 U.S.C. § 501(b) 5

17 U.S.C. § 502 5

17 U.S.C. § 504(a) 5

17 U.S.C. § 507(b) 5

28 U.S.C. § 1254(1) 1

37 C.F.R. § 202.5 4

LEGISLATIVE MATERIALS

H.R. Rep. No. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659 .....20, 22, 23

ADMINISTRATIVE MATERIALS

U.S. Copyright Office:

Compendium of U.S. Copyright Office Practices (3d ed. 2017), https://www.copyright.gov/comp3/docs/compendium.pdf 15, 16

Fiscal 2016 Annual Report, *available at* https://www.copyright.gov/reports/annual/2016/ar2016.pdf 4, 5

OTHER MATERIALS

Brief for the United States as Amicus Curiae Supporting Vacatur and Remand, *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) (No. 08-103) (U.S. filed June 8, 2009), https://www.justice.gov/sites/default/files/osg/briefs/2008/01/01/2008-0103.mer.ami.pdf 15

2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2008)..... 11

2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2013).....12, 13, 22, 25

5 William F. Patry, *Patry on Copyright* (2012)..... 13

Webster's New International Dictionary (2d ed. 1950)..... 19

The Fourth Estate Public Benefit Corporation respectfully petitions for a writ of certiorari to review the judgment of the Eleventh Circuit.

OPINIONS BELOW

The opinion of the court of appeals (App. 1a-10a) is reported at 856 F.3d 1338. The order of the district court granting respondents' motion to dismiss (App. 11a-14a) is not reported (but is available at 2016 WL 9045625).

JURISDICTION

The court of appeals entered its judgment on May 18, 2017. On August 7, 2017, Justice Thomas extended the time for filing a certiorari petition to and including October 13, 2017. App. 36a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Relevant provisions of the Copyright Act (17 U.S.C.) are reproduced at App. 23a-35a.

INTRODUCTION

The Eleventh Circuit's decision deepens division among the circuits about a question that arises at the start of most copyright infringement cases: whether the copyright holder registered the work with the Copyright Office before suing for infringement, as § 411(a) of the Copyright Act requires. The Fifth Circuit and the Ninth Circuit have held that, if a copyright holder files an application, deposits a copy of the work, and pays the required fee, as required by § 408(a) of the Copyright Act, the copyright holder has "made" the required "registration" within the meaning of § 411(a) – whether or not the Register of Copyrights has acted on that application. In the decision below, the Eleventh Circuit rejected that

view, joining the Tenth Circuit in holding that a copyright owner may not sue infringers until after the Copyright Office has acted on the application and registered (or refused to register) the copyright claim.

The Court should grant the petition. The question presented not only recurs repeatedly in copyright infringement cases but also frequently leads to wasteful litigation; worse, the interpretation adopted by the Eleventh Circuit can deprive the owner of a valid copyright of statutory remedies for infringement. Courts, including several courts of appeals, and scholars have addressed the question and reached opposing views, and there is no prospect that further litigation will resolve the conflict among the circuits. The judgment below turns wholly on the answer to the question, making this case an appropriate vehicle for this Court to resolve it.

Further, the Eleventh Circuit's decision is incorrect. The Copyright Act uses the phrase "registration . . . has been made" to refer to the action of the copyright holder in following the required procedures for registration of a copyright claim. The court of appeals misread the statute by focusing solely on the word "registration" – which by itself can refer to the action of the copyright holder or the Copyright Office – rather than reading the word in context. Moreover, the correct statutory reading leads to a far more sensible result, because the rule adopted in the decision under review leads to pointless delay and may prejudice the rights of copyright owners despite their compliance with the statute's requirements.

STATEMENT

A. Statutory Background

1. The Copyright Act protects "original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated." 17 U.S.C. § 102(a). As soon as a work is created, the copyright owner holds exclusive rights "to do and to authorize" others to do certain things with the work. *Id.* § 106. Accordingly, unlike useful inventions – which are protected by exclusive rights only after a patent application has been reviewed and approved by the Patent and Trademark Office ("PTO") and a patent issued – original works of authorship are protected by virtue of their creation, not an affirmative government grant.

The Copyright Act also contains provisions for registration of copyrights – even though "[s]uch registration is not a condition of copyright protection." 17 U.S.C. § 408(a). The copyright owner "may obtain registration of the copyright claim" by depositing a copy (or, in the case of published works, two copies) of the work, along with "the prescribed application and fee" with the Copyright Office. *Id.* § 408(a), (b); *see also id.* § 409 (describing required elements of the application). The Register of Copyrights is required to conduct an examination, and, if the Register determines that "the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met," the Register "shall register" the claim and issue a "certificate of registration." *Id.* § 410(a). The statute provides that the "effective date of a copyright registration" is not the date of issuance of the certificate but is instead "the day on which an application,

deposit, and fee, which are later determined . . . to be acceptable for registration, have all been received in the Copyright Office." *Id.* § 410(d).

If, on the other hand, the Register determines that "the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason," the Register "shall refuse registration" and notify the applicant of the reasons for refusal. *Id.* § 410(b).[1]

Relatively few works are registered each year, and only a small number of applications are refused for any reason.[2] In 2016, according to Copyright Office statistics, the Register received a little more than half a million claims and processed approximately 470,000. It refused registration on 12,656 claims, or less than 3%.[3] It is not clear what percentage of those rejections involved questions of copyrightable subject matter, but the very small number of requests for administrative review following a rejection – in Fiscal 2016, only 320 such requests involving 436 claims were made – may indicate that many rejections

---

[1] Copyright Office regulations provide for internal administrative review of an examiner's decision to refuse registration – a procedure referred to as "reconsideration." *See* 37 C.F.R. § 202.5. The statute does not have any specific provision for judicial review of a refusal decision, and a copyright owner need not obtain such review to sue for infringement.

[2] The number of potentially copyrightable works created each year is practically limitless: a child's thank-you note to her aunt would likely qualify. Unless the author anticipates enforcing her statutory rights, there is little reason to register.

[3] *See* U.S. Copyright Office, *Fiscal 2016 Annual Report* 9, *available at* https://www.copyright.gov/reports/annual/2016/ar2016.pdf.

are for "legal or procedural reasons" other than copyrightability.[4]

2. "Anyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright." 17 U.S.C. § 501(a). The copyright owner "is entitled . . . to institute an action for . . . infringement." *Id.* § 501(b). A federal court with jurisdiction over an infringement action may grant a temporary or permanent injunction, *see id.* § 502; an infringer is also liable for either "the copyright owner's actual damages and any additional profits of the infringer" or "statutory damages," *id.* § 504(a). The copyright owner must file that suit "within three years after the claim accrued." *Id.* § 507(b); *see generally Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014).[5]

Before bringing such an action, owners of a copyright in a United States (but not foreign) work must "register their works." *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 157 (2010). Specifically, § 411(a) of the Copyright Act provides that "no civil action for infringement of [a] copyright in any United States work shall be instituted until . . . registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). The right to proceed with litigation does not depend on whether the registration is granted, though a certificate of registration obtained before or promptly after publication

---

[4] *Id.*; *see id.* (noting that 2016 ended with "more than 316,000 claims on hand in the system, nearly 29,000 of which required more information from applicants").

[5] The courts of appeals have uniformly held that an infringement claim accrues on the date the copyright owner knew, or should have known, of the infringement. *See Psihoyos v. John Wiley & Sons, Inc.*, 748 F.3d 120, 124 (2d Cir. 2014) (collecting cases).

confers certain litigation advantages. In particular, if a plaintiff has a certificate of a registration "made before or within five years after first publication of the work," the certificate "shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate"; the "evidentiary weight to be accorded" a certificate granted thereafter is left to the court's discretion. *Id.* § 410(c).

In a case where registration has been refused, however, the applicant is nevertheless "entitled to institute a civil action for infringement." *Id.* § 411(a). In such a case, the plaintiff is required to serve a copy of the complaint on the Copyright Office, and the Register may intervene "with respect to the issue of registrability of the copyright claim." *Id.* But the litigation may proceed irrespective of the Register's participation. *See id.*

B. Factual Background

Fourth Estate "is an independent news organization" whose journalists produce "high quality, timely, accurate and compelling journalism." App. 15a-16a (Compl. ¶¶ 1-2). Fourth Estate owns the copyrights in those journalists' works and licenses them to a cloud-based news organization called AHN Feed Syndicate; AHN Feed Syndicate, in turn, licenses them to others. App. 16a, 18a (*id.* ¶¶ 2, 4, 14-15). Fourth Estate retains the right to sue for copyright infringement. App. 16a (*id.* ¶ 2).

This case concerns one of AHN Feed Syndicate's former licensees, Wall-Street.com, LLC ("Wall-Street"). Wall-Street secured a license to put some of Fourth Estate's works on the Internet. App. 18a (*id.* ¶ 17). Under that license, if Wall-Street canceled its account with AHN Feed Syndicate, Wall-Street was to "stop display of all Feed Syndicate provided content and permanently take down, remove and/or

delete all cached, saved, archived, stored or data-based content or data." *Id.* (*id.* ¶ 18). Wall-Street canceled its account but continued to copy and distribute 244 of Fourth Estate's works. App. 18a-19a (*id.* ¶¶ 15, 19); *see* Compl. Ex. 1, ECF 1-2.

In March 2016, Fourth Estate sued Wall-Street, seeking an injunction and damages. App. 21a-22a (Compl. at 7). Before it did so, it filed its application for registration with the Copyright Office; it did not wait for the Office to act on that application. App. 18a (*id.* ¶ 14). Nineteen months later – more than half the length of the Copyright Act's statute of limitations – that application remains pending.

C. Proceedings Below

Wall-Street moved to dismiss, arguing that § 411(a) bars Fourth Estate from suing until after the Register of Copyrights acts on its application. The district court granted the motion. App. 13a.

Recognizing that this case "require[d] [it] to decide an issue that has divided the circuits," App. 1a, the Eleventh Circuit held that the text of the Copyright Act required dismissal – aligning itself with the Tenth Circuit and expressly rejecting the contrary view of the Fifth Circuit and the Ninth Circuit. App. 4a-6a. The court stated that the Act "defines registration as a process that requires action by both the copyright owner and the Copyright Office." App. 6a. The copyright owner files an application, deposits a copy, and pays the required fee; the Register "then examines the material" and determines whether it is registrable. *Id.* The court held that the use of the phrase "after examination" in § 410(a) – which describes the procedure that the Register must follow in registering a claim – "makes explicit that an application alone is insufficient for registration." *Id.* Furthermore, § 410(b) authorizes the Register

to "refuse registration"; the court believed that, if "registration occurred as soon as an application was filed, then the Register of Copyrights would have no power to 'refuse registration.'" App. 7a (quoting 17 U.S.C. § 410(b)).

The court rejected Fourth Estate's contrary arguments based on other provisions of the statute. The court read § 408(a) – which states that a copyright owner "may obtain registration of the copyright claim by delivering" the required materials to the Register, 17 U.S.C. § 408(a) – to say nothing about when registration occurs, but only about "the conditions a copyright owner must satisfy to obtain registration." App. 7a. It likewise found it insignificant that § 410(d) provides that the effective date of registration is the date the application is complete, rather than the date the Copyright Office acts on an application. In the court's view, that section supports its rule because "registration occurs only after the Register of Copyrights deems an application 'to be acceptable.'" App. 8a (quoting 17 U.S.C. § 410(d)).

The court also acknowledged the harsh result that its rule, together with the statute of limitations, can bring about: "an owner who files an application late in the statute of limitations period risks losing the right to enforce his copyright in an infringement action because of the time needed to review an application." *Id.* "But," in the court's view, "this potential loss encourages an owner to register his copyright soon after he obtains the copyright and before infringement occurs." *Id.* The court also refused to consider the Copyright Act's legislative history and animating policy, instead finding the language that other courts of appeals had interpreted differently to be "unambiguous." App. 9a.

REASONS FOR GRANTING THE PETITION

The Eleventh Circuit's decision deepens an acknowledged circuit split about the meaning of the statutory phrase "registration . . . has been made" in § 411(a). In the Fifth and Ninth Circuits, a copyright owner may sue to enforce exclusive rights once the materials required for registration have been submitted to the Copyright Office. But, in the Tenth and Eleventh Circuits, a copyright owner has no remedy for infringement until after the Copyright Office has acted on the application.

That conflict, on a matter of great practical significance, will not be resolved without this Court's review. Furthermore, the rule adopted by the court below and previously by the Tenth Circuit misreads the statutory language, by (incorrectly) construing the word "registration" in isolation and failing to construe the operative phrase, "registration . . . has been made" – phrasing the statute uses repeatedly to refer to the actions of the copyright holder. The court's decision in this case invites wasteful litigation and jeopardizes copyright owners' ability to enforce their statutory rights. This case provides an ideal opportunity to resolve the issue correctly once and for all.

I. THE COURT SHOULD GRANT REVIEW TO RESOLVE A CONFLICT AMONG THE COURTS OF APPEALS ON A MATTER OF SIGNIFICANT PRACTICAL IMPORTANCE

A. The Courts Of Appeals Are Divided On The Question Presented And Will Remain So Absent This Court's Review

Four courts of appeals have resolved the question presented, dividing evenly on the issue.

1. The Ninth Circuit and the Fifth Circuit have held that "receipt by the Copyright Office of a complete application satisfies the registration requirement of § 411(a)." *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 621 (9th Cir. 2010); *see Positive Black Talk Inc. v. Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), *abrogated in part on other grounds by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 160 n.2 (2010); *Lakedreams v. Taylor*, 932 F.2d 1103, 1108 (5th Cir. 1991); *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984).

a. In *Cosmetic Ideas*, after noting that the circuits were already divided on the issue, the Ninth Circuit determined that § 411(a) itself "gives no guidance in interpreting the meaning of 'registration,'" which is "unhelpfully" defined elsewhere in the statute as "'a registration of a claim in the original or the renewed and extended term of copyright.'" 606 F.3d at 616 (quoting 17 U.S.C. § 101). The court found the "language of the statute as a whole" likewise to be ambiguous. *Id.* at 616-17.

Because the court found the statutory language to be ambiguous, it sought to "discern its meaning by looking to 'the broader context of the statute as a whole' and the purpose of the statute." *Id.* at 618. The court concluded that allowing a copyright holder to sue once it had submitted its complete application "better fulfills" the purpose of the statute. *Id.* at 619. The court noted that this approach "avoids unnecessary delay . . . , which could permit an infringing party to continue to profit from its wrongful acts." *Id.* The court emphasized that § 411(a) "allows a party, after applying for registration, to litigate the claim whether the Copyright Office accepts or rejects the registration." *Id.* Requiring a copyright holder to

wait until the Copyright Office has acted "'create[s] a period of "legal limbo" in which suit is barred.'" *Id.* at 620 (quoting 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][1][a][i] (2008)). At the same time, allowing a copyright owner to sue while the application is pending does not "impair[] the central goal of copyright registration" because the copyright holder is nevertheless obligated "to submit the information necessary to add the copyright to the federal registry." *Id.*

The court also found that the "requirement of affirmative approval or rejection before suit . . . amounts to little more than just the type of needless formality Congress generally worked to eliminate in the 1976 Act." *Id.* And, "in addition to being general inefficient, in the worst-case scenario the registration approach could cause a party to lose its ability to sue," given the three-year statute of limitations. *Id.* "This result does not square well with § 410(d)'s mandate that an application's effective registration date should be the day that a completed application is received." *Id.*

The court also rejected the argument that "deference to the Register" required a different result. *Id.* at 621. First, as a practical matter, because of the pace of litigation, the Copyright Office will typically have acted before a case is decided, and the Copyright Office, if it rejects an application, will still have an opportunity to intervene in the pending litigation. *See id.* Moreover, "the Register's decision of whether or not to grant a registration certificate is largely perfunctory, and is ultimately reviewable by the courts." *Id.* Thus, review by the Copyright Office and underlying litigation "can occur simultaneously with little or no prejudice to any involved parties." *Id.*

b. The result in *Cosmetic Ideas* accords with the result earlier reached and repeatedly reaffirmed by the Fifth Circuit, which, as the first court of appeals to address the issue, held that, "to bring suit for copyright infringement, it is not necessary to prove possession of a registration certificate. One need only prove payment of the required fee, deposit of the work in question, and receipt by the Copyright Office of a registration application." *Apple Barrel*, 730 F.2d at 386-87; *see also Lakedreams*, 932 F.2d at 1108 (5th Cir. 1991); *accord Positive Black Talk*, 394 F.3d at 365.

To support that conclusion, the Fifth Circuit relied on Professor Nimmer's analysis. *See Apple Barrel*, 730 F.2d at 386-87. His treatise concludes that this "approach to registration better comports with the statutory structure" than the one adopted below. 2 *Nimmer on Copyright* § 7.16[B][3][b][ii] (2013). Section 411(a) "requires only that '*registration* of the copyright claim has been made *in accordance with [Title 17]*,'" and Title 17 "elsewhere specifies that the 'effective date of a copyright registration is'" backdated to the day the completed application is received in the Copyright Office. *Id.* (quoting 17 U.S.C. §§ 410(d), 411(a)) (emphases in *Nimmer*). "Given that the claimant who has submitted an application that has yet to be acted upon at that juncture has done all that she can do, and will ultimately be allowed to proceed regardless of how the Copyright Office treats her application, it makes little sense," in Professor Nimmer's view, "to create a period of 'legal limbo' in which suit is barred." *Id.* (footnote omitted). Further, that rule promotes both judicial efficiency and copyright owners' substantive rights – "considerations" that "become especially *apropos* when one

reflects that the Copyright Office typically registers about 99 percent of the claims submitted to it." *Id.*[6]

2. By contrast, the Tenth Circuit, like the Eleventh Circuit, has held that "[t]he plain language of the statute" requires a copyright owner to await the Copyright Office's action before he may sue. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200-01 (10th Cir. 2005). The Tenth Circuit was of the view that "[n]o language in the Act suggests that registration is accomplished by mere receipt of copyrightable material by the Copyright Office." *Id.* at 1200. Until the Register affirmatively determines that copyright protection is warranted, the court held, "registration" is not "'made'" within the meaning of § 411(a). *Id.* at 1200-01. The court found this reading to be bolstered by § 410(a) – which requires the Register to "register [a] claim" only "after examination" – and by § 410(b) – which allows the Register to "refuse registration." *See id.*

The court noted the contrary view of the Fifth Circuit, and acknowledged that it "has some appeal." *Id.* at 1204 (noting that "it is odd that one can possess a copyright but be unable to file suit until it is 'voluntarily' registered"). Whatever the "practical force" of the contrary approach, the court stated that there were "three reasons" to reject it. *Id.* First, the court suggested that the statute does not "convey certain remedies and benefits upon application and other remedies and benefits upon registration." *Id.* Rather, the "remedies are part of a single package." *Id.* Second, the court found it "not illogical" for Congress to induce registration by withholding remedies until after "registration is accomplished." *Id.* at 1204-05.

---

[6] For what it is worth, Patry disagrees (strenuously). *See* 5 William F. Patry, *Patry on Copyright* § 17:78 (2012).

Third, the court found that a contrary approach would "allow[] for shifting legal entitlements," *id.* at 1205, though it did not attempt to square this observation with § 410(d), which makes the effective date of registration retroactive to the date that the copyright owner submits the required materials to the Copyright Office.

3. This split among the circuits is entrenched and is unlikely to be resolved without action by this Court. Both the First Circuit and the Second Circuit have recognized the split without finding occasion to address it. *See Psihoyos v. John Wiley & Sons, Inc.*, 748 F.3d 120, 125 (2d Cir. 2014); *Alicea v. Machete Music*, 744 F.3d 773, 779 & n.7 (1st Cir. 2014). The Seventh Circuit has issued contradictory dicta without squarely resolving the question. *See Brooks-Ngwenya v. Indianapolis Pub. Sch.*, 564 F.3d 804, 806 (7th Cir. 2009) (per curiam).[7] And district courts within the Second,[8] Third,[9] Fourth,[10] and

---

[7] *Compare Gaiman v. McFarlane*, 360 F.3d 644, 655 (7th Cir. 2004) (Registration "is a prerequisite to a suit to enforce a copyright. More precisely, an application to register must be filed, and either granted or refused, before suit can be brought."), *with Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003) (supporting the contrary approach).

[8] *Compare Gattoni v. Tibi, LLC*, No. 16 Civ. 7527 (RWS), 2017 WL 2313882, at *3 (S.D.N.Y. May 25, 2017), *with Chevrestt v. American Media, Inc.*, 204 F. Supp. 3d 629, 631 (S.D.N.Y. 2016).

[9] *Compare North Jersey Media Grp. Inc. v. Sasson*, Civ. No. 2:12-3568 (WJM), 2013 WL 74237, at *2 (D.N.J. Jan. 4, 2013), *with K-Beech, Inc. v. Doe*, Civil Action No. 11-7083, 2012 WL 262722, at *2-3 (E.D. Pa. Jan. 30, 2012).

[10] *Compare Caner v. Autry*, 16 F. Supp. 3d 689, 706-08 (W.D. Va. 2014), *with Mays & Assocs. Inc. v. Euler*, 370 F. Supp. 2d 362, 368-70 (D. Md. 2005).

D.C.[11] Circuits have recognized the split, reaching different conclusions.

The government and the Copyright Office in particular have likewise made their view known. In *Reed Elsevier*, the government acknowledged the split and endorsed *La Resolana Architects*' analysis. *See* Brief for the United States as Amicus Curiae Supporting Vacatur and Remand at 24 n.14, *Reed Elsevier*, No. 08-103 (U.S. filed June 8, 2009) ("U.S. *Reed Elsevier* Br."), https://www.justice.gov/sites/default/files/osg/briefs/2008/01/01/2008-0103.mer.ami.pdf; *see also* U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 625.5, at 217 (3d ed. 2017) ("*Copyright Office Compendium*") (acknowledging the split and stating that, "[i]n the Office's view, . . . filing a lawsuit based solely on the submission of an application for registration does not satisfy" the statutory requirement), https://www.copyright.gov/comp3/docs/compendium.pdf. The government has argued that, "if the district court were to adjudicate an infringement suit on the merits while the plaintiff's application was pending before the Copyright Office, the court would be deprived of the Register's views on such issues as copyrightability." U.S. *Reed Elsevier* Br. 25 n.14.

B. The Question Presented Is Important

The question presented is of significant practical importance. Whether the plaintiff has satisfied the registration requirement of § 411(a) may arise at the outset of any infringement case involving a non-exempt U.S. work. In cases where infringement

---

[11] *Compare Prunte v. Universal Music Grp.*, 484 F. Supp. 2d 32, 40 (D.D.C. 2007), *with Strategy Source, Inc. v. Lee*, 233 F. Supp. 2d 1, 3 (D.D.C. 2002).

is ongoing and an application for registration is complete but not yet acted on, an infringer can, at a minimum, delay proceedings on the merits and impose additional costs on the copyright owner while the question of compliance with § 411(a) is resolved. (That is what occurred here.) This is especially true in those eight regional circuits where the question has not yet been resolved by the court of appeals.

Even worse, in cases where a combination of delay in registration and delay by the Copyright Office leads to expiration of the statute of limitations before the Copyright Office acts, a copyright owner may lose a remedy altogether. And that is so even though the copyright exists from the time the work is first created, and registration, if granted, is retroactive to the date of application, and even though, if registration is denied, the copyright owner is nevertheless entitled to sue.

It is true that the Copyright Office has created a process for parties to request expedited "special handling" by filing additional paperwork and paying an additional $800 per work claimed. *Copyright Office Compendium* § 623, at 199. But that is many times the standard registration fee, and it can amount to a prohibitive sum when alleged infringement involves a number of separately registered works (for example, recordings by various artists on the same independent record label). In any event, the Copyright Act precludes the Office from exacting a significant surcharge simply to ensure that copyright owners can enforce their statutory rights.

C. This Case Provides An Appropriate Vehicle For Resolution Of The Question Presented

This case is the ideal vehicle in which to resolve the statutory issue presented. The question was squarely raised below, and the Eleventh Circuit's answer forms the sole basis for its judgment. App. 1a-2a. No better vehicle will emerge.

II. THE ELEVENTH CIRCUIT'S DECISION CONFLICTS WITH THE COPYRIGHT ACT

The Eleventh Circuit's decision is incorrect. The court focused on the word "registration" and concluded that the term must refer to the registration, memorialized by a certificate, that is granted by the Register after examination. But "registration" is not so defined in the statute. *Cf.* 17 U.S.C. § 101 (providing a circular definition of "registration" to mean "registration of a claim in the original or the renewed and extended term of copyright"). And the term "registration" is used in the statute in its ordinary sense to refer to both the action of the Copyright Office – that is, registration that the Office grants – and the action of a copyright owner, who registers a claim by following the required statutory procedures.

If the court had instead looked at the word in the context of the phrase it was construing – "registration . . . has been made" – the court would have found much more guidance in the statutory language, including both its immediate context and the use of the phrase elsewhere in the statute. Using these tools of statutory construction, it becomes clear that "registration has been made" for purposes of § 411(a) once a copyright holder submits the materials required for registration. Furthermore, that construction is

both more sensible and more consistent with the basic policies of the Copyright Act.

A. A Careful Reading Of The Statute's Text Establishes That The Eleventh Circuit's Construction Is Incorrect

Careful attention to the text makes clear that "registration . . . has been made" refers to the action of the copyright holder.

1. Start with the language of § 411(a) itself. That provision states, subject to a specified exception and the provisions of § 411(b), that "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). Yet the statute goes on to state that, "[i]n any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement," provided that the copyright owner gives notice to the Copyright Office. *Id.* The fact that a copyright holder is permitted to "institute a civil action" even though the Copyright Office refuses the application means that "registration . . . has been made" is most logically read to refer to the action of the copyright holder – that is, applying for registration – and not the action of the Copyright Office. Otherwise, the two sentences would contradict each other – that is, the second sentence would mean that a suit for infringement may be instituted even though registration had *not* been made. Statutes should be read to avoid, not create, such contradictions. *See Liteky v. United States*, 510 U.S. 540, 552

(1994) (rejecting reading that would cause statute "to contradict itself").

The use of the word "however" does not resolve the contradiction created by the Eleventh Circuit's reading of the statute – the word signals contrast or qualification, not literal contradiction. *See Webster's New International Dictionary* 1209 (2d ed. 1950) (defining "however" as "[n]evertheless; notwithstanding; yet; still"). The "however" signals that, if the Copyright Office refuses registration, an additional requirement is imposed – notice to the Office. It cannot reasonably be read to state that a civil action may be instituted even though registration has not been made at all. Put another way, cases where "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused" constitute a subset of those cases where "registration . . . has been made" that are subject to an additional procedural requirement.

The conclusion that the phrase "registration . . . has been made" refers to the action of the copyright holder is confirmed by the language of § 411(c). That provision, which applies to works consisting of "sounds, images, or both, the first fixation of which is made simultaneously with transmission," allows a copyright owner to institute an action for infringement if (among other requirements) "the copyright owner . . . makes registration for the work, if required by subsection (a), within three months after its first transmission." 17 U.S.C. § 411(c). This provision confirms, first of all, that "registration" can indeed refer to the action of the copyright owner in applying for registration. Moreover, the construction "copyright owner . . . makes registration" parallels the

passive-voice construction "registration . . . has been made," confirming that, while the Copyright Office "register[s] [a] claim," *id.* § 410(a), the copyright owner "makes registration."[12]

2. The use of similar constructions elsewhere in the statute reinforces the conclusion that "registration . . . has been made" refers to the action of the copyright owner. For example, § 408(c)(3) provides that "a single renewal registration *may be made* for a group of works by the same individual author . . . *upon the filing of a single application and fee*." 17 U.S.C. § 408(c)(3) (emphases added). This provision naturally is read to refer to the action of the copyright holder, as the only action required for such "registration" is the filing of the application and fee – not any action by the Copyright Office. *See also id.* § 408(e) (providing that "[r]egistration for the first published edition of a work previously registered in unpublished form *may be made*") (emphasis added).

Likewise, in § 412, the statute uses the phrase "registration is made" with clear reference to the action of the copyright holder. *Id.* § 412(2). That provision deals with limitations on certain remedies

---

[12] The legislative history of the Copyright Act of 1976 likewise refers to the owner registering his claim – not the Copyright Office. *See* H.R. Rep. No. 94-1476, at 157 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5773 (Comm. on the Judiciary) ("[A] copyright owner who has not registered his claim can have a valid cause of action against someone who has infringed his copyright, but he cannot enforce his rights in the courts until he has made registration."); *id.* at 152, 1976 U.S.C.C.A.N. 5768 ("Under section 408(a), registration of a claim to copyright in any work, whether published or unpublished, can be made voluntarily by 'the owner of copyright or of any exclusive right in the work' at any time during the copyright term."). This is consistent with the statutory construction that petitioner urges here.

in actions for infringement of a copyright of a work that has been preregistered under § 408(f); § 412 specifies that "no award of statutory damages or attorney's fees . . . shall be made for . . . any infringement of copyright commenced after first publication of the work and before the effective date of its registration, *unless such registration is made* within three months after the first publication of the work." *Id.* (emphasis added). It would make no sense for the three-month deadline to apply to action by the Copyright Office; rather, as with § 411(c), this provision requires *copyright owners* to make registration within three months (even though the Copyright Office may act later).

3. The Eleventh Circuit correctly noted that "registration" is also used in the statute to refer to the action of the Copyright Office – for example, § 410(a) directs the Register to "register" a claim when legal and formal requirements have been met, and § 410(b) directs the Register to "refuse registration" when such requirements are not met. But the observation that registration *can* refer to the action of the Copyright Office does not mean that it *cannot* refer, in appropriate context, to the action of the copyright holder in applying for registration. *See Barber v. Thomas*, 560 U.S. 474, 484 (2010). On the contrary, as explained above, the statute uses the term repeatedly in this sense.

As a matter of ordinary language, there is nothing paradoxical about this, because the word "registration" has substantial flexibility built in. A college student may register for classes (and thus complete registration) yet not get into a particular course (and thus be denied registration). Given the absence of any limiting definition of "registration" and the

diverse use of the word in the Copyright Act, the Eleventh Circuit's analysis does not hold up.

At the same time, the statute never uses the construction "make registration" or its passive-voice counterpart to refer specifically to the action of the Copyright Office. That phraseology is, however, repeatedly used to connote action by the copyright holder – and that is how it is used in § 411(a).

B. The Eleventh Circuit's Interpretation Is Inconsistent With The Copyright Act's Scheme Of Rights and Remedies

The statutory language resolves the question presented; furthermore, that reading avoids the inefficiency and inconsistency that the interpretation adopted by the court below invites. *See FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 132 (2000) (noting that "[a] court must . . . interpret [a] statute as a symmetrical and coherent regulatory scheme, and fit, if possible, all parts into an harmonious whole") (citation omitted); *see also* 2 *Nimmer on Copyright* § 7.16[B][3][b][ii] ("Indeed, some courts that follow the [Eleventh Circuit's] approach concede that it yields an inefficient and peculiar result.").

1. Making the Copyright Office the gatekeeper to enforcement of copyrights is inconsistent with the rest of the Copyright Act, which makes clear that a copyright owner's rights do not depend on any affirmative government grant. The Act grants a copyright owner exclusive rights in a work as soon as it is fixed in a tangible medium of expression. *See* 17 U.S.C. § 102(a). Those rights are not granted by the Copyright Office; they, instead, come about by virtue of the creation of the work. *See id.* § 408(a) ("[R]egistration is not a condition of copyright protection."); *see also* H.R. Rep. No. 94-1476, at 129, 1976

U.S.C.C.A.N. 5745 (protecting a work "as soon as it is 'created'").

To be sure, before a copyright owner can sue to enforce those rights, the copyright owner must register the claim with the Copyright Office. In this way, copyright owners that intend to seek judicial enforcement of their copyrights are given an incentive – indeed, they are required – to make use of the statutory system of registration. But once the copyright owner has made registration, that policy is fully vindicated. That is confirmed by the fact that registration *by the Register* is not a precondition to enforcement of copyright at all: on the contrary, if the Register refuses registration, the copyright owner may sue nevertheless.

Furthermore, none of the copyright owner's statutory remedies turns on the timing of action by the Copyright Office: the Copyright Act deems registration effective on the day a complete application for registration is received. *See* 17 U.S.C. § 410(d). That is so whether the determination that the requirements for registration are met is made by the Register or "by a court of competent jurisdiction." *Id.*[13]

Because neither the copyright holder's right to sue nor the copyright holder's remedies depend on the outcome of the examination by the Register, it makes

---

[13] This is in marked contrast to the regime that governed under the Copyright Act of 1909. That statute had imposed "a dual system" that distinguished between registered, published works, which Congress protected by federal law, and unpublished works, which received their only copyright protection by the States. *See* H.R. Rep No. 94-1476, at 129, 1976 U.S.C.C.A.N. 5745. Congress abandoned that "anachronistic, uncertain, impractical, and highly complicated dual system" system in favor of a "single Federal system" that granted "statutory protection" to a work "as soon as it is 'created.'" *Id.*

little sense to place a copyright holder in months of "legal limbo" while the examination of a registration application is completed.

2. Nor is the Eleventh Circuit's reading required to allow courts to take advantage of the expertise of the Copyright Office on matters of copyrightability. At the outset, it is not the case, as the Eleventh Circuit thought, that allowing litigation to be instituted after the copyright holder has registered the claim (but before the Copyright Office has acted) would deprive the Register of "power to 'refuse registration.'" App. 7a. Whatever the status of any litigation commenced in federal court, the Register will be able to act in due course on the application submitted to the Copyright Office. Nor is it correct, as the Tenth Circuit thought, that "an applicant could obtain the advantage" of a presumption of validity "upon application" only to lose it if the Register denied the application. *La Resolana Architects*, 416 F.3d at 1205. The presumption of validity depends on a "*certificate* of a registration," not registration. 17 U.S.C. § 410(c) (emphasis added). Accordingly, if the Copyright Office has not registered the claim and issued a certificate of registration, the copyright holder will not gain any evidentiary advantage from having made registration. In any event, the statute has a degree of "shifting legal entitlements" built in, *La Resolana Architects*, 416 F.3d at 1205, because it makes the effective date of registration retroactive to the date of application.

It is likewise not the case (as the government has asserted in the past) that allowing litigation to proceed while registration is pending will deprive the Copyright Office of its right to intervene in litigation in cases where registration is refused: if an application were refused, notice would be required, and the

government could choose to intervene at that point. Absent unreasonable delay in examination, there is no risk that the government will lose its chance to participate at a meaningful time – and the possibility of such unreasonable delay is an argument in favor of petitioner's reading of the statute.

As noted, litigation may proceed irrespective of the view of the Copyright Office, and the determination of the Copyright Office constitutes "prima facie" evidence only in cases where it *grants* a certification of registration, 17 U.S.C. § 410(c).[14] As the leading treatise has pointed out, in most cases, even if litigation begins before the Copyright Office has granted or refused registration, such action can be expected during the course of litigation, giving the court the benefit of the Register's views. *See* 2 *Nimmer on Copyright* § 7.16[B][3][b][ii]. Just as important, in any case where a claim's eligibility for copyright protection presents a substantial issue, a court can make use of the ordinary tools of litigation management – including the doctrine of primary jurisdiction – to give the Copyright Office the first crack at determining whether the subject matter of the work is copyrightable. *Cf. Syntek Semiconductor Co. v. Microchip Tech. Inc.*, 307 F.3d 775, 781 (9th Cir. 2002) (similar). Given the breadth of copyright law's protections, *see* 17 U.S.C. § 102(a), the Office typically grants the overwhelming majority of applications. *See* 2 *Nimmer on Copyright* § 7.16[B][3][b][ii]. There is no reason to believe that substantial issues of

---

[14] By contrast, after the PTO has issued a patent, a litigant must present "clear and convincing" evidence to overcome the presumption that the patent is valid. *See generally Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91 (2011).

copyrightability will arise often – and no such defense has been asserted in this case.

3. By contrast, the Eleventh Circuit's approach creates significant practical problems, some of which the Ninth Circuit recognized in adopting the contrary rule. First, by barring a copyright owner from seeking the injunctive relief to which the Copyright Act entitles copyright owners until the Copyright Office acts, the rule requires the copyright owner to endure the ongoing theft of intellectual property rights the copyright owner already possesses – to the benefit of the infringer. *See Cosmetic Ideas*, 606 F.3d at 620. Second, if the Act's statute of limitations elapses before the Office acts on the application, the copyright owner may forever lose any ability to enforce the very same rights the Act grants. *See id.*

Third, the Eleventh Circuit's rule creates a procedural trap and invites pointless litigation. In many cases, the consequence of dismissal is simply to require refiling of a suit once the Copyright Office has acted. In such a situation, even if no remedy is lost, the copyright holder will necessarily incur the additional – and needless – expense of filing a duplicative complaint. That, in turn, imposes a corresponding administrative burden on the district courts. And, in the typical case where disputed issues involve the parties' conduct and not the validity of copyright, additional passage of time may risk blurring the evidence.

It is of course within the power of Congress to mandate such results, but the Copyright Act requires the opposite, and sensible, result here.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN
INTELLECTUAL PROPERTY
LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

October 13, 2017

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
COLLIN R. WHITE
KELLOGG, HANSEN, TODD,
FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

APPENDIX

TABLE OF CONTENTS

Page

Opinion of the United States Court of Appeals for the Eleventh Circuit, *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, et al.*, No. 16-13726 (May 18, 2017) 1a

Order of the United States District Court for the Southern District of Florida Granting Motion To Dismiss, *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, et al.*, Civil Action No. 16-60497-Civ-Scola (May 23, 2016) 11a

Complaint for Copyright Infringement, *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, et al.*, Civil Action No. 16-60497-Civ-Scola (S.D. Fla. filed Mar. 11, 2016) (exhibits omitted) ... 15a

Statutory Provisions Involved 23a

Copyright Act (17 U.S.C.):

17 U.S.C. § 101 (excerpt) 23a

17 U.S.C. § 408 ..... 23a

17 U.S.C. § 409 ..... 28a

17 U.S.C. § 410 ..... 29a

17 U.S.C. § 411 ..... 30a

17 U.S.C. § 412 ..... 32a

17 U.S.C. § 501 ..... 33a

17 U.S.C. § 502 ..... 35a

Letter from Supreme Court Clerk regarding grant of extension of time for filing a petition for a writ of certiorari (Aug. 7, 2017) 36a

UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 16-13726

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Plaintiff-Appellant,

v.

WALL-STREET.COM, LLC, JERROLD D. BURBEN,
Defendants-Appellees.

[Filed May 18, 2017]

Before WILLIAM PRYOR, MARTIN, and BOGGS,* Circuit Judges.

WILLIAM PRYOR, Circuit Judge:

"Registration" of a copyright is a precondition to filing suit for copyright infringement. 17 U.S.C. § 411(a). This appeal requires us to decide an issue that has divided the circuits: whether registration occurs when an owner files an application to register the copyright or when the Register of Copyrights registers the copyright. *Compare Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 619 (9th Cir. 2010) (concluding that registration occurs when the owner files an application), *with La Resolana*

---

* Honorable Danny J. Boggs, United States Circuit Judge for the Sixth Circuit, sitting by designation.

Architects, PA v. Clay Realtors Angel Fire, 416 F.3d 1195, 1197 (10th Cir. 2005) (concluding that registration occurs when the Register approves an application), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 157, 130 S. Ct. 1237, 176 L.Ed.2d 18 (2010). Fourth Estate Public Benefit Corporation filed a suit for infringement against Wall-Street.com and Jerrold Burden. The complaint alleged that Fourth Estate had filed an application to register its allegedly infringed copyrights, but that the Copyright Office had not registered its claims. The district court dismissed the action because Fourth Estate failed to plead compliance with the registration requirement. 17 U.S.C. § 411(a). Because registration occurs when the Register of Copyrights "register[s] the claim," *id.* § 410(a), we affirm.

I. BACKGROUND

Fourth Estate Public Benefit Corporation is a news organization that produces online journalism. It licenses articles to websites but retains the copyright to the articles. Wall-Street.com, a news website, obtained licenses to a number of articles produced by Fourth Estate. The license agreement required Wall-Street to remove all of the content produced by Fourth Estate from its website before Wall-Street cancelled its account. But when Wall-Street cancelled its account, it continued to display the articles produced by Fourth Estate.

Fourth Estate filed a complaint for copyright infringement, 17 U.S.C. § 501, against Wall-Street and its owner, Jerrold Burden. The complaint alleged that Fourth Estate had filed "applications to register [the] articles with the Register of Copyrights." But the complaint did not allege that the Register of Copyrights had yet acted on the application.

Wall-Street and Burden moved to dismiss the complaint. They argued that the Copyright Act, *id.* § 411(a), permits a suit for copyright infringement only after the Register of Copyrights approves or denies an application to register a copyright. The district court agreed and dismissed the complaint without prejudice.

II. STANDARD OF REVIEW

"We review *de novo* the district court's grant of a motion to dismiss under [Federal Rule of Civil Procedure] 12(b)(6) for failure to state a claim, accepting the factual allegations in the complaint as true and construing them in the light most favorable to the plaintiff." *Glover v. Liggett Grp., Inc.*, 459 F.3d 1304, 1308 (11th Cir. 2006) (emphasis added).

III. DISCUSSION

As a preliminary matter, the issue presented does not involve jurisdiction. Until 2010, our precedent held that registration was a jurisdictional prerequisite to filing an action for infringement. *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488 (11th Cir. 1990). But in *Reed Elsevier, Inc. v. Muchnick*, the Supreme Court held that the "registration requirement is a precondition to filing a claim that does not restrict a federal court's subject-matter jurisdiction." 559 U.S. 154, 157, 130 S. Ct. 1237, 176 L.Ed.2d 18 (2010).

Although registration is voluntary under the Copyright Act, Congress created several incentives for a copyright owner to register his copyright, *Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1301 (11th Cir. 2012), one of which is the right to enforce a copyright in an infringement action:

> [N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.

17 U.S.C. § 411(a); *see also id.* § 408(f) (explaining that the Register "shall permit preregistration" for a limited class of works that have "a history of infringement prior to authorized commercial distribution"); 37 C.F.R. § 202.16(b)(1) (defining the limited class of works capable of preregistration to include material such as movies and sound recordings not at issue in this appeal). The question we must decide is when registration occurs.

The question when registration occurs has split the circuits. The Tenth Circuit follows the "registration" approach to section 411(a), which requires a copyright owner to plead that the Register of Copyrights has acted on the application—either by approving or denying it—before a copyright owner can file an infringement action. *La Resolana*, 416 F.3d at 1197-1203. In contrast, the Ninth and Fifth Circuits follow the "application" approach, which requires a copyright owner to plead that he has filed "the deposit, application, and fee required for registration," 17 U.S.C. § 411(a), before filing a suit for infringement. *Cosmetic Ideas*, 606 F.3d at 618-19; *Positive Black Talk Inc. v. Cash Money Records Inc.*, 394 F.3d 357,

365 (5th Cir. 2004), *abrogated in part by Muchnick*, 559 U.S. 154, 130 S. Ct. 1237, 176 L.Ed.2d 18; *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984); *see also* Melville B. Nimmer, et al., 2 *Nimmer on Copyright* § 7.16 [B][3][b][v] (2016). The Eighth Circuit, in dicta, also endorsed the application approach. *Action Tapes, Inc. v. Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006). The caselaw of the Seventh Circuit contains conflicting dicta on whether it follows the application approach, *Chi. Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 631 (7th Cir. 2003) ("[A]n application for registration must be filed before the copyright can be sued upon."), or the registration approach, *Gaiman v. McFarlane*, 360 F.3d 644, 655 (7th Cir. 2004) ("[A]n application to register must be filed, and either granted or refused, before suit can be brought."), or whether it has even decided this question, *Brooks-Ngwenya v. Indianapolis Pub. Sch.*, 564 F.3d 804, 806 (7th Cir. 2009). And both the First and Second Circuits have acknowledged the circuit split but have declined to decide whether to adopt the application approach or the registration approach. *Alicea v. Machete Music*, 744 F.3d 773, 779 (1st Cir. 2014); *Psihoyos v. John Wiley & Sons, Inc.*, 748 F.3d 120, 125 (2d Cir. 2014).

The parties dispute whether our precedents bind us to follow either approach. Wall-Street argues that our Circuit has adopted the registration approach and cites *M.G.B. Homes*, where we stated that a "lawsuit for copyright infringement cannot be filed unless plaintiff has a *registered* copyright." *M.G.B. Homes*, 903 F.2d at 1488 n.4 (quoting *Haan Crafts Corp. v. Craft Masters, Inc.*, 683 F. Supp. 1234, 1242 (N.D. Ind. 1988)); *see also Kernel Records*, 694 F.3d at 1302 n.8 (stating that "[w]e adopted the 'registra-

tion' approach in *M.G.B. Homes*."). Fourth Estate counters that we are not bound by *M.G.B. Homes* because *Muchnick* eroded the rationale for following the registration approach.

We need not decide this dispute about our precedents because the text of the Copyright Act makes clear that the registration approach that we endorsed in *M.G.B. Homes* and *Kernel Records* is correct. "[R]egistration of [a] copyright . . . has [not] been made in accordance with . . . title [17]," 17 U.S.C. § 411(a), until "the Register . . . register[s] the claim," *id.* § 410(a). Filing an application does not amount to registration.

The Copyright Act defines registration as a process that requires action by both the copyright owner and the Copyright Office. A copyright owner must first deposit a copy of the material with the Copyright Office, file an application, and pay a fee. *Id.* § 408(a). The Register of Copyrights then examines the material and determines whether "the material deposited constitutes copyrightable subject matter." *Id.* § 410(a). If the material is copyrightable "the Register shall register the claim and issue to the applicant a certificate of registration." *Id.* If "the material deposited does not constitute copyrightable subject matter . . . , the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal." *Id.* § 410(b).

The use of the phrase "after examination" in section 410(a) makes explicit that an application alone is insufficient for registration:

> When, *after examination*, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that

> the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office.

Id. § 410(a) (emphasis added). That registration occurs only *after* examination of an application necessarily means that registration occurs "[l]ater in time than" or "subsequent to" the filing of the application for registration. *After*, *Webster's New International Dictionary* 45 (2d ed. 1961).

Section 410(b) also establishes that registration can occur only after application and examination. That section states, "In any case in which the Register of Copyrights determines that . . . the material deposited does not constitute copyrightable subject matter . . . the Register shall refuse registration." 17 U.S.C. § 410(b). And section 411(a) allows a copyright holder who filed an application for registration to file an infringement suit if "registration has been refused." *Id.* § 411(a). If registration occurred as soon as an application was filed, then the Register of Copyrights would have no power to "refuse registration." *Id.* § 410(b).

Fourth Estate argues that section 408(a) supports the application approach because it fails to mention the certificate of registration, but we disagree. Section 408(a) states, "[T]he owner of copyright . . . may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708." *Id.* § 408(a). This section states only the conditions a copyright owner must satisfy to obtain registration. It does not speak to the timing of registration or the obligation

of the Register of Copyrights to examine and approve or refuse an application.

Section 410(d) also supports the registration approach, notwithstanding the argument of Fourth Estate to the contrary. That section states that "[t]he effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office." § 410(d). To be sure, section 410(d) relates registration back to the date that the owner files an application, but section 410(d) also makes evident that registration occurs only after the Register of Copyrights deems an application "to be acceptable." *Id.* Like other provisions of Title 17, section 410(d) establishes that registration occurs only after review and approval by the Register of Copyrights.

Fourth Estate argues that the three-year statute of limitations for infringement suits, *id.* § 507(b), supports the application approach, but we disagree. Considered together, the registration requirement and the three-year statute of limitations reflect a statutory plan to encourage registration. *See La Resolana*, 416 F.3d at 1199 ("Although Congress established a voluntary registration system, it created incentives for copyright owners to register their copyrights."). True, an owner who files an application late in the statute of limitations period risks losing the right to enforce his copyright in an infringement action because of the time needed to review an application. But this potential loss encourages an owner to register his copyright soon after he obtains the copyright and before infringement occurs. And section 507(b) is not the only provision of the Copyright

Act that favors prompt registration. *See* 17 U.S.C. § 410(c) ("[R]egistration *made before or within five years* after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate." (emphasis added)). That is, far from undermining the registration approach, the three-year statute of limitations further evidences that the Copyright Act encourages registration.

Fourth Estate devotes its remaining statutory arguments to legislative history and policy, but "[w]hen," as here, "the words of a statute are unambiguous, then . . . judicial inquiry is complete." *Villarreal v. R.J. Reynolds Tobacco Co.*, 839 F.3d 958, 969 (11th Cir. 2016) (en banc) (internal quotation marks omitted) (quoting *Conn. Nat'l Bank v. Germain*, 503 U.S. 249, 254, 112 S. Ct. 1146, 117 L.Ed.2d 391 (1992)). Indeed, "[e]ven if a statute's legislative history evinces an intent contrary to its straightforward statutory command, we do not resort to legislative history to cloud a statutory text that is clear." *Id.* (internal quotation marks omitted) (quoting *Harry v. Marchant*, 291 F.3d 767, 772 (11th Cir. 2002) (en banc)).

Finally, this appeal is not akin to the "unusual circumstance" presented by *Pacific & Southern Co. v. Duncan*, 744 F.2d 1490 (11th Cir. 1984), in which we "allowed injunctive relief to be sought prior to registration" where there was "infringement of a registered work, a continuing series of original works created with predictable regularity, and a substantial likelihood of future infringements." *Stuart Weitzman, LLC v. Microcomputer Res., Inc.*, 542 F.3d 859, 865 n.6 (11th Cir. 2008) (citing *Pacific*, 744 F.2d at 1499 & n.17). As explained, Fourth Estate has not alleged

infringement of any registered work. And this appeal, unlike *Pacific*, does not involve the ongoing creation of original works, or potential future infringement of works not yet created.

IV. CONCLUSION

We **AFFIRM** the dismissal of the complaint filed by Fourth Estate.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Civil Action No. 16-60497-Civ-Scola

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Plaintiff,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURBEN,
Defendants.

[Signed 03/23/2016
Entered 05/23/2016]

Order Granting Motion to Dismiss

Robert N. Scola, Jr., United States District Judge

The Defendants Wall-Street.com, LLC and Jerrold D. Burden ask the Court to dismiss the Plaintiff Fourth Estate Public Benefit Corp.'s Complaint for copyright infringement (Counts 1 and 2) and removal of copyright management information (Count 3). (See Compl., ECF No. 1.) The Defendants argue that the copyright infringement claims must be dismissed, because Fourth Estate's alleged copyrighted works have not been registered. (Mot. 2, ECF No. 9.) As to the remaining claim, the Defendants argue that Fourth Estate lacks standing. In its response, although Fourth Estate defended against dismissal

of its copyright infringement claim, it did not address the Defendants request to dismiss for lack of standing. (Resp., ECF No. 16.) After reviewing the motion, the record, and the relevant legal authorities and for the reasons explained more fully below, the Court **grants** the Motion to Dismiss (ECF No. 9).

A court considering a motion to dismiss, filed under Federal Rule of Civil Procedure 12(b)(6), must accept all of the complaint's allegations as true, construing them in the light most favorable to the plaintiff. *Pielage v. McConnell*, 516 F.3d 1282, 1284 (11th Cir. 2008). Although a pleading need only contain a short and plain statement of the claim showing that the pleader is entitled to relief, a plaintiff must nevertheless articulate "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A court must dismiss a plaintiff's claims if she fails to nudge her "claims across the line from conceivable to plausible." *Twombly*, 550 U.S. at 570.

"To make out a prima facie case of copyright infringement, a plaintiff must show that (1) it owns a valid copyright in the [work] and (2) defendants copied protected elements from the [work]." *Peter Letterese & Assocs., Inc. v. World Inst. of Scientology Enters.*, 533 F.3d 1287, 1300 (11th Cir. 2008) (citations omitted). The Copyright Act provides that "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." *Watson v. K2 Design Grp., Inc.*, No. 15-CIV-61020, 2015 WL 4720797, at *2-3 (S.D. Fla. Aug. 7, 2015) (Bloom, J.) (quoting 17 U.S.C. § 411(a)).

The Defendants argue that because Fourth Estate's alleged copyrighted works are not registered, Fourth Estate has not satisfied the precondition for bringing an infringement action under the Copyright Act. Fourth Estate counters that although its works were not registered, an application to register was pending at the time of the suit, which is sufficient to survive a motion to dismiss. (Resp. 2, ECF No. 16.)

Although registration is no longer a jurisdictional requirement, *see Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 169 (2010), it is nonetheless a procedural bar to infringement claims. *See Dowbenko v. Google Inc.*, 582 Fed. Appx. 801, 805 (11th Cir. 2014) ("The Supreme Court recently clarified that, although § 411(a)'s registration requirement is not jurisdictional, it nevertheless amounts to 'a precondition to filing a claim.'"); *see also Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1303-05 (11th Cir. 2012) (noting that if the work was not foreign, "registration was required prior to suit," and finding that work was not a foreign work exempt from the registration requirement). *See generally, Watson*, 2015 WL 4720797, at *2-3 (providing a comprehensive summary of the case law on this issue). As a result, because a plaintiff must first obtain registration for the work at issue prior to initiating suit, the Court must dismiss Fourth Estate's claims for copyright infringement.

As to the remaining claim for injunctive relief based on removal of copyright management information, Fourth Estate's response is silent as to Count 3 in its entirety—Fourth Estate offers no opposition to Defendants' claims that Fourth Estate lacks standing to obtain injunctive relief on behalf of a third-party. Accordingly, the Court holds that

Fourth Estate has abandoned Count 3. *Phan v. Accredited Home Lenders Holding Co.*, No. 309-CV-328-J-32TEM, 2010 WL 1268013, at *5 (M.D. Fla. Mar. 29, 2010) (citing *Abolition of Marijuana Prohibition v. City of Atlanta*, 219 F.3d 1301, 1326 (11th Cir. 2000)).

Accordingly, for the foregoing reasons, the Court **grants** without prejudice the Motion to Dismiss (ECF No. 9). The Court **denies** the Request for Oral Argument (ECF No. 17) and directs the Clerk to **close** the case.

Done and ordered, at Miami, Florida, on March 23, 2016.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
FORT LAUDERDALE DIVISION

Civil Action No. 16-60497-Civ-Scola

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Plaintiff,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURBEN,
Defendants.

COMPLAINT FOR COPYRIGHT INFRINGEMENT

(INJUNCTIVE RELIEF DEMANDED)

Plaintiff, FOURTH ESTATE PUBLIC BENEFIT CORPORATION, by and through undersigned counsel, brings this Complaint against Defendants, WALL-STREET.COM, LLC and JERROLD D. BURDEN, for damages and injunctive relief, and in support thereof states as follows:

SUMMARY OF THE ACTION

1. Plaintiff FOURTH ESTATE PUBLIC BENEFIT CORPORATION ("Fourth Estate") is an independent news organization built for the public benefit on strong journalistic principles and designed to build a long-term, stable and sustainable economic relationship based on fair treatment and equity for all stakeholders of the journalism community. The mission of Fourth Estate is to contribute to a healthy

society by fostering, supporting and incubating a sustainable and vibrant free press. Fourth Estate equips individuals and communities with the news and information they need to make wise decisions.

2. In service to its mission, Fourth Estate produces high quality, timely, accurate and compelling journalism created by reporters working all over the world. Fourth Estate owns the copyright in the articles produced by its journalists. Fourth Estate licenses its content to AHN Feed Syndicate ("Feed Syndicate"), a global leader of cloud-based news and content solutions for the enterprise, pursuant to a non-exclusive license agreement under which Fourth Estate retains the copyrights to its content, as well as the rights to pursue infringements of its content and recover damages.

3. Fourth Estate brings this action for violations of Fourth Estate's exclusive rights under the Copyright Act, 17 U.S.C. § 106, to copy and distribute Fourth Estate's original copyrighted works of authorship in its news articles and content.

4. The Defendants own and operate an on-line news and advertising website at the URL www.Wall-Street.com. Defendants obtained Fourth Estate's copyrighted works from Feed Syndicate pursuant to a limited license. After that license expired, Defendants continued to copy and distribute Fourth Estate's copyrighted works in violation of Fourth Estate's exclusive rights under the Copyright Act without Fourth Estate's permission.

5. Defendants copied and distributed Fourth Estate's copyrighted works not only to earn advertising revenue from readers of those works, but also to advertise and market the sale of the domain and

website Wall-Street.com, which Defendants market and promote at www.wallstreetcloud.com.

6. Fourth Estate's works are protected by copyright but are not otherwise confidential, proprietary, or trade secrets.

JURISDICTION AND VENUE

7. This is an action arising under the Copyright Act, 17 U.S.C. § 501.

8. This Court has subject matter jurisdiction over these claims pursuant to 15 U.S.C. § 1121, and 28 U.S.C. §§ 1331, 1338(a), and 1367.

9. Defendants are subject to personal jurisdiction in Florida.

10. Venue is proper in this district under 28 U.S.C. § 1391(b) and (c) and 1400(a) because the events giving rise to the claims occurred in this district, Defendants engaged in infringement in this district, Defendants reside in this district, and Defendants are subject to personal jurisdiction in this district.

PARTIES

11. Plaintiff FOURTH ESTATE PUBLIC BENEFIT CORPORATION is a Delaware corporation authorized to do business in Florida.

12. Defendant WALL-STREET.COM, LLC ("Wall-Street"), is a Florida limited liability company with a principal address at 6301 NW 5th Way, Suite 1400, Ft. Lauderdale, FL 33309.

13. Defendant JERROLD D. BURDEN ("Burden") is an individual residing in Broward County, Florida. Burden is the owner and operator of Wall-Street and www.WallStreet.com.

THE COPYRIGHTED WORKS AT ISSUE

14. Fourth Estate owns the copyright in thousands of copyrighted articles, including hundreds of articles first published in the three months since the filing of Fourth Estate's applications to register these articles with the Register of Copyrights immediately prior to the filing of this case. Upon receipt of the registration certificate for these works, Fourth Estate will file this certificate with the court. Consistent with the Copyright Act and the regulations promulgated thereunder, when issued by the Register of Copyrights the registration certificate will be dated prior to the filing of this action.

15. A list of the copyrighted works at issue in this case that were infringed by Defendants is attached hereto as Exhibit 1.

16. At all relevant times Fourth Estate was the owner of the copyrighted works at issue in this case. Fourth Estate became the owner of the copyrighted works either by virtue of the fact that the works were works for hire and/or by written assignment from the original authors of said works.

INFRINGEMENT BY DEFENDANTS

17. Feed Syndicate licensed the works at issue in this action to Defendants pursuant to the Terms of Use attached hereto as Exhibit 2.

18. The Terms of Use provide that "Prior to account cancellation you must stop display of all Feed-Syndicate provided content and permanently take down, remove and/or delete all cached, saved, archived, stored or databased content or data."

19. Defendants canceled their account with Feed-Syndicate but failed to comply with the provisions of the Terms of Use. Specifically, Defendants continued to display Fourth Estate's copyrighted works and

failed to permanently take down, remove and/or delete all cached, saved, archived, stored or data-based Fourth Estate copyrighted works.

20. Fourth Estate and Feed Syndicate never gave Defendants permission or authority to copy or distribute the works at issue in this case after termination of their license.

21. The Fourth Estate copyrighted works contain copyright management information.

22. The Terms of Use provide that the Fourth Estate copyrighted works licensed by Feed Syndicate contain copyright management information that reads "(c) FeedSyndicate – All Rights Reserved. The writer or author byline, if included."

23. When Defendants copied and distributed Fourth Estate's copyrighted works they removed Fourth Estate's copyright management information.

24. Fourth Estate and Feed Syndicate never gave Defendants permission or authority to remove copyright management information from the works at issue in this case.

25. Plaintiff has engaged the undersigned attorneys and has agreed to pay them a reasonable fee.

COUNT I

COPYRIGHT INFRINGEMENT AGAINST ALL DEFENDANTS

26. Plaintiff Fourth Estate incorporates the allegations of paragraphs 1 through 25 of this complaint as if fully set forth herein.

27. Fourth Estate owns valid copyrights in the works at issue in this case.

28. Fourth Estate registered the works at issue in this case with the Register of Copyrights pursuant to 17 U.S.C. § 411(a).

29. Defendants copied and distributed the works at issue in this case and made derivatives of the works without Fourth Estate's authorization in violation of 17 U.S.C. § 501.

30. Defendants performed the acts alleged in furtherance of their business for profit and to promote the sale of Wall-Street.com.

31. Fourth Estate has been damaged.

32. The harm caused to Fourth Estate has been irreparable.

COUNT II

COPYRIGHT INFRINGEMENT AGAINST BURDEN

33. Plaintiff Fourth Estate incorporates the allegations of paragraphs 1 through 25 of this complaint as if fully set forth herein.

34. Fourth Estate owns valid copyrights in the works at issue in this case.

35. Fourth Estate's registered the works at issue in this case with the Register of Copyrights pursuant to 17 U.S.C. § 411(a).

36. Defendants copied and distributed the works at issue in this case and made derivatives of the works without Fourth Estate's authorization in violation of 17 U.S.C. § 501.

37. Burden profited from the infringement of the exclusive rights of Fourth Estate in the works at issue in this case under the Copyright Act while declining to exercise a right to stop it.

38. Fourth Estate has been damaged.

39. The harm caused to Fourth Estate has been irreparable.

COUNT III
REMOVAL OF COPYRIGHT MANAGEMENT INFORMATION

40. Plaintiff Fourth Estate incorporates the allegations of paragraphs 1 through 25 of this complaint as if fully set forth herein.

41. The works at issue in this case contain copyright management information ("CMI").

42. Defendants knowingly and with the intent to enable or facilitate copyright infringement, removed CMI from the works at issue in this action in violation of 17 U.S.C. § 1202(b).

43. Defendants committed these acts knowing or having reasonable grounds to know that they will induce, enable, facilitate or conceal infringement of Fourth Estate's rights in the works at issue in this action protected under the Copyright Act.

44. Fourth Estate has been damaged.

45. The harm caused to Fourth Estate has been irreparable.

WHEREFORE, the Plaintiff Fourth Estate prays for judgment against the Defendants that:

a. Defendants and their officers, agents, servants, employees, affiliated entities, and all of those in active concert with them, be preliminarily and permanently enjoined from committing the acts alleged herein in violation of 17 U.S.C. §§ 501;

b. Defendants be required to pay Plaintiff its actual damages and Defendants' profits attributable to the infringement, or, at Plaintiff's election, statutory damages, as provided in 17 U.S.C. §§ 504.

c. Plaintiff be awarded its attorneys' fees and costs of suit under the applicable statutes sued upon; and

d. Plaintiff be awarded such other and further relief as the Court deems just and proper.

JURY DEMAND

Plaintiff hereby demands a trial by jury of all issues so triable.

DATED: March 11, 2016

Respectfully submitted,
/s/ Joel B. Rothman
JOEL B. ROTHMAN
Florida Bar Number: 98220
joel.rothman@sriplaw.com
JEROLD I. SCHNEIDER
Florida Bar Number: 26975
jerold.schneider@sriplaw.com
DIANA F. MEDEROS
Florida Bar Number: 99881
diana.mederos@sriplaw.com

SCHNEIDER ROTHMAN
INTELLECTUAL PROPERTY
LAW GROUP, PLLC
4651 North Federal Highway
Boca Raton, FL 33431
561.404.4350 – Telephone
561.404.4353 – Facsimile

Attorneys for Plaintiff
Fourth Estate Public
Benefit Corporation

STATUTORY PROVISIONS INVOLVED

The Copyright Act (17 U.S.C.) provides in relevant part:

§ 101. Definitions

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

* * *

"Registration", for purposes of sections 205(c)(2), 405, 406, 410(d), 411, 412, and 506(e), means a registration of a claim in the original or the renewed and extended term of copyright.

* * *

§ 408. Copyright registration in general

(a) Registration Permissive.—At any time during the subsistence of the first term of copyright in any published or unpublished work in which the copyright was secured before January 1, 1978, and during the subsistence of any copyright secured on or after that date, the owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708. Such registration is not a condition of copyright protection.

(b) Deposit for Copyright Registration.—Except as provided by subsection (c), the material deposited for registration shall include—

(1) in the case of an unpublished work, one complete copy or phonorecord;

(2) in the case of a published work, two complete copies or phonorecords of the best edition;

(3) in the case of a work first published outside the United States, one complete copy or phonorecord as so published;

(4) in the case of a contribution to a collective work, one complete copy or phonorecord of the best edition of the collective work.

Copies or phonorecords deposited for the Library of Congress under section 407 may be used to satisfy the deposit provisions of this section, if they are accompanied by the prescribed application and fee, and by any additional identifying material that the Register may, by regulation, require. The Register shall also prescribe regulations establishing requirements under which copies or phonorecords acquired for the Library of Congress under subsection (e) of section 407, otherwise than by deposit, may be used to satisfy the deposit provisions of this section.

(c) Administrative Classification and Optional Deposit.—

(1) The Register of Copyrights is authorized to specify by regulation the administrative classes into which works are to be placed for purposes of deposit and registration, and the nature of the copies or phonorecords to be deposited in the various classes specified. The regulations may require or permit, for particular classes, the deposit of identifying material instead of copies or phonorecords, the deposit of only one copy or phonorecord where two would normally be required, or a single

registration for a group of related works. This administrative classification of works has no significance with respect to the subject matter of copyright or the exclusive rights provided by this title.

(2) Without prejudice to the general authority provided under clause (1), the Register of Copyrights shall establish regulations specifically permitting a single registration for a group of works by the same individual author, all first published as contributions to periodicals, including newspapers, within a twelve-month period, on the basis of a single deposit, application, and registration fee, under the following conditions:

(A) if the deposit consists of one copy of the entire issue of the periodical, or of the entire section in the case of a newspaper, in which each contribution was first published; and

(B) if the application identifies each work separately, including the periodical containing it and its date of first publication.

(3) As an alternative to separate renewal registrations under subsection (a) of section 304, a single renewal registration may be made for a group of works by the same individual author, all first published as contributions to periodicals, including newspapers, upon the filing of a single application and fee, under all of the following conditions:

(A) the renewal claimant or claimants, and the basis of claim or claims under section 304(a), is the same for each of the works; and

(B) the works were all copyrighted upon their first publication, either through separate copy-

right notice and registration or by virtue of a general copyright notice in the periodical issue as a whole; and

(C) the renewal application and fee are received not more than twenty-eight or less than twenty-seven years after the thirty-first day of December of the calendar year in which all of the works were first published; and

(D) the renewal application identifies each work separately, including the periodical containing it and its date of first publication.

(d) Corrections and Amplifications.—The Register may also establish, by regulation, formal procedures for the filing of an application for supplementary registration, to correct an error in a copyright registration or to amplify the information given in a registration. Such application shall be accompanied by the fee provided by section 708, and shall clearly identify the registration to be corrected or amplified. The information contained in a supplementary registration augments but does not supersede that contained in the earlier registration.

(e) Published Edition of Previously Registered Work.—Registration for the first published edition of a work previously registered in unpublished form may be made even though the work as published is substantially the same as the unpublished version.

(f) Preregistration of Works Being Prepared for Commercial Distribution.—

(1) Rulemaking.—Not later than 180 days after the date of enactment of this subsection, the Register of Copyrights shall issue regulations to

establish procedures for preregistration of a work that is being prepared for commercial distribution and has not been published.

(2) Class of works.—The regulations established under paragraph (1) shall permit preregistration for any work that is in a class of works that the Register determines has had a history of infringement prior to authorized commercial distribution.

(3) Application for registration.—Not later than 3 months after the first publication of a work preregistered under this subsection, the applicant shall submit to the Copyright Office—

(A) an application for registration of the work;

(B) a deposit; and

(C) the applicable fee.

(4) Effect of untimely application.—An action under this chapter for infringement of a work preregistered under this subsection, in a case in which the infringement commenced no later than 2 months after the first publication of the work, shall be dismissed if the items described in paragraph (3) are not submitted to the Copyright Office in proper form within the earlier of—

(A) 3 months after the first publication of the work; or

(B) 1 month after the copyright owner has learned of the infringement.

§ 409. Application for copyright registration

The application for copyright registration shall be made on a form prescribed by the Register of Copyrights and shall include—

(1) the name and address of the copyright claimant;

(2) in the case of a work other than an anonymous or pseudonymous work, the name and nationality or domicile of the author or authors, and, if one or more of the authors is dead, the dates of their deaths;

(3) if the work is anonymous or pseudonymous, the nationality or domicile of the author or authors;

(4) in the case of a work made for hire, a statement to this effect;

(5) if the copyright claimant is not the author, a brief statement of how the claimant obtained ownership of the copyright;

(6) the title of the work, together with any previous or alternative titles under which the work can be identified;

(7) the year in which creation of the work was completed;

(8) if the work has been published, the date and nation of its first publication;

(9) in the case of a compilation or derivative work, an identification of any preexisting work or works that it is based on or incorporates, and a brief, general statement of the additional material covered by the copyright claim being registered; and

(10) any other information regarded by the Register of Copyrights as bearing upon the preparation or identification of the work or the existence, ownership, or duration of the copyright.

If an application is submitted for the renewed and extended term provided for in section 304(a)(3)(A) and an original term registration has not been made, the Register may request information with respect to the existence, ownership, or duration of the copyright for the original term.

§ 410. Registration of claim and issuance of certificate

(a) When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.

(b) In any case in which the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.

(c) In any judicial proceedings the certificate of a registration made before or within five years after

first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.

(d) The effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.

§ 411. Registration and civil infringement actions

(a) Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not

deprive the court of jurisdiction to determine that issue.

(b)(1) A certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information, unless—

(A) the inaccurate information was included on the application for copyright registration with knowledge that it was inaccurate; and

(B) the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.

(2) In any case in which inaccurate information described under paragraph (1) is alleged, the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.

(3) Nothing in this subsection shall affect any rights, obligations, or requirements of a person related to information contained in a registration certificate, except for the institution of and remedies in infringement actions under this section and section 412.

(c) In the case of a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission, the copyright owner may, either before or after such fixation takes place, institute an action for infringement under section 501, fully subject to the remedies provided by sections 502 through 505 and section 510, if, in accordance with requirements that the Register of Copyrights shall prescribe by regulation, the copyright owner—

(1) serves notice upon the infringer, not less than 48 hours before such fixation, identifying the work and the specific time and source of its first transmission, and declaring an intention to secure copyright in the work; and

(2) makes registration for the work, if required by subsection (a), within three months after its first transmission.

§ 412. Registration as prerequisite to certain remedies for infringement

In any action under this title, other than an action brought for a violation of the rights of the author under section 106A(a), an action for infringement of the copyright of a work that has been preregistered under section 408(f) before the commencement of the infringement and that has an effective date of registration not later than the earlier of 3 months after the first publication of the work or 1 month after the copyright owner has learned of the infringement, or an action instituted under section 411(c), no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for—

(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or

(2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.

§ 501. Infringement of copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122 or of the author as provided in section 106A(a), or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright or right of the author, as the case may be. For purposes of this chapter (other than section 506), any reference to copyright shall be deemed to include the rights conferred by section 106A(a). As used in this subsection, the term "anyone" includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

(b) The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of section 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it. The court may require such owner to serve written notice of the action with a copy of the complaint upon any person shown, by the records of the Copyright Office or otherwise, to have or claim an interest in the copyright, and shall require that such notice be served upon any person whose interest is likely to be affected by a decision in the case. The court may require the joinder, and shall permit the intervention, of any person having or claiming an interest in the copyright.

(c) For any secondary transmission by a cable system that embodies a performance or a display of a

work which is actionable as an act of infringement under subsection (c) of section 111, a television broadcast station holding a copyright or other license to transmit or perform the same version of that work shall, for purposes of subsection (b) of this section, be treated as a legal or beneficial owner if such secondary transmission occurs within the local service area of that television station.

(d) For any secondary transmission by a cable system that is actionable as an act of infringement pursuant to section 111(c)(3), the following shall also have standing to sue: (i) the primary transmitter whose transmission has been altered by the cable system; and (ii) any broadcast station within whose local service area the secondary transmission occurs.

(e) With respect to any secondary transmission that is made by a satellite carrier of a performance or display of a work embodied in a primary transmission and is actionable as an act of infringement under section 119(a)(5), a network station holding a copyright or other license to transmit or perform the same version of that work shall, for purposes of subsection (b) of this section, be treated as a legal or beneficial owner if such secondary transmission occurs within the local service area of that station.

(f)(1) With respect to any secondary transmission that is made by a satellite carrier of a performance or display of a work embodied in a primary transmission and is actionable as an act of infringement under section 122, a television broadcast station holding a copyright or other license to transmit or perform the same version of that work shall, for purposes of subsection (b) of this section, be treated as a legal or beneficial owner if such secondary

transmission occurs within the local market of that station.

(2) A television broadcast station may file a civil action against any satellite carrier that has refused to carry television broadcast signals, as required under section 122(a)(2), to enforce that television broadcast station's rights under section 338(a) of the Communications Act of 1934.

§ 502. Remedies for infringement: Injunctions

(a) Any court having jurisdiction of a civil action arising under this title may, subject to the provisions of section 1498 of title 28, grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.

(b) Any such injunction may be served anywhere in the United States on the person enjoined; it shall be operative throughout the United States and shall be enforceable, by proceedings in contempt or otherwise, by any United States court having jurisdiction of that person. The clerk of the court granting the injunction shall, when requested by any other court in which enforcement of the injunction is sought, transmit promptly to the other court a certified copy of all the papers in the case on file in such clerk's office.

Supreme Court of the United States
Office of the Clerk
Washington, DC 20543-0001

SCOTT S. HARRIS
Clerk of the Court
(202) 479-3011

August 7, 2017

Mr. Aaron M. Panner
Kellogg, Hansen, Todd,
Figel & Frederick, P.L.L.C.
1615 M Street, NW
Suite 400
Washington, DC 20036-3209

Re: Fourth Estate Public Benefit Corporation
v. Wall-Street.com, LLC, et al.
Application No. 17A150

Dear Mr. Panner:

The application for an extension of time within which to file a petition for a writ of certiorari in the above-entitled case has been presented to Justice Thomas, who on August 7, 2017, extended the time to and including October 13, 2017.

This letter has been sent to those designated on the attached notification list.

Sincerely,

Scott S. Harris, Clerk
by /s/ JACOB A. LEVITAN
Jacob A. Levitan
Case Analyst

[attached notification list omitted]

No. 17-571

In the Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE RESPONDENTS IN OPPOSITION

DAVID A. GELLER
1221 S. 21st Avenue
Hollywood, FL 33020

PETER K. STRIS
Counsel of Record
ELIZABETH BRANNEN
JOHN STOKES
STRIS & MAHER LLP
725 S. Figueroa Street
Suite 1830
Los Angeles, CA 90017
(213) 995-6800
peter.stris@strismaher.com

Counsel for Respondents

PARTIES TO THE PROCEEDING BELOW

Petitioner is Fourth Estate Public Benefit Corporation, the plaintiff-appellant below.

Respondents are Wall-Street.com, LLC, and Jerrold D. Burden, the defendants-appellees below.

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, respondent Wall-Street.com, LLC certifies that it has no parent company and that no publicly held company owns 10% or more of its stock.

TABLE OF CONTENTS

Page

Opinions below 1
Jurisdiction 1
Introduction 2
Statement 3
Argument 5
A. The question presented lacks sufficient importance to merit review by this Court 6
B. The decision below is correct 9
Conclusion 21

TABLE OF AUTHORITIES

Cases:

Cosmetic Ideas, Inc. v. *IAC/Interactivecorp*, 606 F.3d 612 (9th Cir. 2010) 4
Havens Realty Corp. v. *Coleman*, 455 U.S. 363 (1982) 7
La Resolana Architects, PA v. *Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), abrogated in part on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010) 4, 10, 15, 17
Petrella v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014) 6, 7
Positive Black Talk Inc. v. *Cash Money Records Inc.*, 394 F.3d 357 (5th Cir. 2004), abrogated in part on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010) 4
Reed Elsevier, Inc. v. *Muchnick*, 559 U.S. 154 (2010) 16
Vacheron & Constantin-Le Coultre Watches, Inc. v. *Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958) 4, 19
William A. Graham Co. v. *Haughey*, 568 F.3d 425 (3d Cir. 2009) 6

Statutes: Page

Copyright Act, 17 U.S.C. 101 *et seq.* ..... *passim*
17 U.S.C. 408(f) 8, 15
17 U.S.C. 408(f)(3) 15
17 U.S.C. 408(f)(4) 15
17 U.S.C. 410(a) 9
17 U.S.C. 410(d) 10
17 U.S.C. 411(a) ..... *passim*
17 U.S.C. 411(b) 9, 10
17 U.S.C. 411(c) ..... *passim*
17 U.S.C. 412 17
28 U.S.C. 1254(1) 1
28 U.S.C. 1914(a) 7
46 Fed. Reg. 28,846 (May 29, 1981) 8, 13, 14
Family Entertainment and Copyright Act, Pub. L. No. 109-9, 119 Stat. 221 (17 U.S.C. 408(f)) 15
Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. No. 110-403, 122 Stat. 4257 13

Miscellaneous:

2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2017) 2, 6, 18
5 William F. Patry, *Patry on Copyright* (2017) 11
6 William F. Patry, *Patry on Copyright* (2017) 6
Benjamin Kaplan, *Study No. 17: The Registration of Copyright, Copyright Law Revision Studies Prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the Comm. on the Judiciary*, 86th Cong., 2d Sess. (Comm. Print 1960) 16, 19
H.R. Rep. No. 1476, 94th Cong., 2d Sess. (1976) 8, 13, 19
H.R. Rep. No. 388, 103d Cong., 1st Sess. (1993) 20
H.R. Rep. No. 609, 100th Cong., 2d Sess. (1988) 17
Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess. (Comm. Print 1961) 18, 19

Miscellaneous—continued: Page

S. Rep. No. 473, 94th Cong., 1st Sess. (1975) 8, 13, 19
U.S. Amicus Br., *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010) (No. 08-103)..... 4, 16
U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* (3d ed. 2017) 5
U.S. Copyright Office, *Multiple Works* (*Circular 34*) (2017), https://www.copyright.gov/circs/circ34.pdf..... 8
U.S. Copyright Office, *Special Handling* (*Circular 10*) (2017), https://www.copyright.gov/circs/circ10.pdf..... 7
U.S. Judicial Conference, *District Court Miscellaneous Fee Schedule* (2016), https://goo.gl/mNWFhX..... 8

In the Supreme Court of the United States

No. 17-571

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE RESPONDENTS IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-10a) is reported at 856 F.3d 1338. The opinion of the district court (Pet. App. 11a-14a) is unreported.

JURISDICTION

The judgment of the court of appeals was entered on May 18, 2017. Pet. App. 1a. Justice Thomas extended the time for filing a petition for certiorari to and including October 13, 2017. Pet. App. 36a. The petition for a writ of certiorari was filed on October 13, 2017. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

INTRODUCTION

According to petitioner, this case presents a straightforward circuit conflict on an important question of federal law: whether, for purposes of instituting a copyright infringement action, a claimant's "registration * * * has been made" once the claimant has applied for registration (the application approach) or only once the Register of Copyrights has acted on that application (the registration approach). 17 U.S.C. 411(a).

Petitioner is correct that this question has divided the courts of appeals. The Fifth and Ninth Circuits have adopted the application approach, while the Tenth and Eleventh Circuits follow the registration approach. Review is nonetheless unwarranted for two reasons.

First, the petition vastly overstates the importance of the question presented. Professor Nimmer has aptly called the debate over this question "a tempest in a teapot." 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][3][b][v] (2017). And the petition gives this Court no reason to think otherwise. Petitioner warns of dire consequences to the registration approach: meritorious claims lost to the statute of limitations while applications languish in the Copyright Office. But the petition cites not a single case in which this has occurred.

That is because reality is quite different. A copyright owner faces risk to her claim only if she waits until deep into the limitations period to seek registration. Even then, her most likely loss would be not her entire claim, as petitioner alarmingly contends, but rather some limited measure of damages. And in the hypothetical case where processing times would substantially impair a copyright owner's remedies, a claimant may expedite registration in a matter of days and at little cost compared to the expense of litigating an infringement action. As such, this is not the sort of substantial question worthy of this Court's review.

Second, review is unwarranted because the decision below is correct. Indeed, the answer to the question presented is quite simple. Section 411(a) does not say a claimant may file an infringement action upon application for registration. It says she may do so only once registration "has been made" or "refused." 17 U.S.C. 411(a).

Petitioner's reading of Section 411(a) is both unfaithful to the statutory text and would render important portions of the Copyright Act superfluous. A copyright simply cannot be registered or refused without action by the Register of Copyrights. That is clear from the plain language of Section 411(a) and from a multitude of surrounding provisions that speak to the Register's central role in making registration. Those provisions would lack meaning under the application approach.

The entire four-decade history of the Copyright Act overwhelmingly supports this conclusion. From enactment through several attempts at amendment, the legislative debate has rested on the premise that registration means certification by the Register. That debate has always been over whether to eliminate this requirement (in light of the very policy reasons petitioner advances here), not over what the requirement means. Congress has carefully and exhaustively engaged in the debate for forty years—and as the text and structure of the Copyright Act reflect, it has settled on a clear answer. Registration, not simply application, is necessary. Petitioner asks for an end-run around that legislative judgment, an invitation the Eleventh Circuit correctly declined.

The petition for a writ of certiorari should be denied.

STATEMENT

1. Petitioner Fourth Estate is an independent news organization that licenses its journalism to other outlets. Pet. App. 15a-16a. Petitioner alleges that Wall-Street.com

obtained a license to distribute petitioner's work, but then continued distributing that work after the license expired. *Id.* at 16a. Petitioner sued Wall-Street.com for copyright infringement "immediately" after filing an application for copyright registration with the Copyright Office. *Id.* at 18a. Because the Register had not yet acted on petitioner's application, the district court dismissed the suit under Section 411(a). *Id.* at 13a.

2. A unanimous Eleventh Circuit panel affirmed, joining the Tenth Circuit in requiring the Register to act on a copyright holder's application before suit may be filed. See *La Resolana Architects, PA* v. *Clay Realtors Angel Fire*, 416 F.3d 1195, 1197 (10th Cir. 2005), abrogated in part on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010); but see *Cosmetic Ideas, Inc.* v. *IAC/Interactivecorp*, 606 F.3d 612 (9th Cir. 2010) (adopting the application approach); *Positive Black Talk Inc.* v. *Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004) (same), abrogated in part on other grounds by *Reed Elsevier*, 559 U.S. 154.

The court of appeals recognized that this question "has split the circuits." Pet. App. 4a. But as Judge Tymkovich noted in *La Resolana*, 416 F.3d at 1202, the circuits that have adopted the registration approach are in good company. Judge Learned Hand concluded an earlier version of the Copyright Act made both "an application" for registration and "acceptance by the Register" prerequisites to suit. *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637, 640-641 (2d Cir. 1958). More recently, the United States Solicitor General and the Copyright Office have each separately endorsed the registration approach. U.S. Amicus Br. at 24 n.14, *Reed Elsevier*, 559 U.S. 154 (No. 08-103) ("Although some courts have held that Section 411(a)'s precondition to suit is satisfied by simply filing an application for registration,

* * * those decisions are contrary to Section 411(a)'s plain text, and therefore incorrect."); U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 625.5 (3d ed. 2017) ("The mere submission of an application to the U.S. Copyright Office does not amount to a registration. This is corroborated by the statute and the legislative history.").

In line with these authorities, Judge Pryor's opinion below concluded that "the text of the Copyright Act makes clear that the registration approach * * * is correct." Pet. App. 6a. The court reasoned that the "Copyright Act defines registration as a process that requires action by both the copyright owner and the Copyright Office." *Ibid.* The application approach, in contrast, renders meaningless numerous provisions detailing the Register's role in this process. Because the court found the Act's plain language unambiguous, it declined to consider petitioner's policy and legislative history arguments.

ARGUMENT

Petitioner is correct that the question presented has divided the courts of appeals. The petition should, nonetheless, be denied for two reasons. First (pp. 5-8, *infra*), the question presented lacks sufficient general importance to merit review by this Court. It will rarely have any practical effect on a copyright owner's rights or remedies, and when it does, that effect is far more limited than petitioner contends. Second (pp. 8-20, *infra*), the decision below correctly concluded that Section 411(a) of the Copyright Act permits suit only after the Register has acted on an application. The Act's plain language compels that result, and every other indication of Congress's intent confirms it.

A. The Question Presented Lacks Sufficient Importance To Merit Review By This Court

This Court reserves its limited resources for questions of significant importance. Although petitioner contends the question presented fits that bill, the reality is far different. In the vast majority of cases, the stakes are low—no claims or even significant damages will be lost by requiring claimants to register before filing suit. That is precisely why Professor Nimmer has labeled this debate "a tempest in a teapot." 2 *Nimmer on Copyright* § 7.16[B][3][b][v].

Petitioner's most dire warning is that "a copyright owner may lose a remedy altogether" if the statute of limitations expires while her application remains pending. Pet. 16. That concern, however, is unfounded. The best evidence is petitioner's failure to cite any case where such forfeiture has occurred.

In reality, a claimant faces risk to her claim only if she waits to seek registration until long after infringement has begun. Given normal six- to eight-month application processing times, a plaintiff would have to delay seeking registration more than two years for the statute of limitations to become relevant. And in most courts the clock begins to run only based upon discovery of infringement.[1]

---

[1] See 6 William F. Patry, *Patry on Copyright* § 20:19 (2017) ("The overwhelming majority of courts use discovery accrual in copyright cases."); *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 n.4 (2014) ("Although [this Court] has not passed on the question, nine Courts of Appeals have adopted * * * [this] 'discovery rule,' which starts the limitations period when 'the plaintiff discovers, or with due diligence should have discovered, the injury that forms the basis for the claim.'" (quoting *William A. Graham Co.* v. *Haughey*, 568 F.3d 425, 433 (3d Cir. 2009))); see also Pet. 5 n.5 (noting that "[t]he courts of appeals have uniformly" adopted the discovery rule).

Even if a claimant delays seeking registration beyond that point, she typically stands to lose not her entire remedy, but rather some measure of damages. That is because "the separate-accrual rule attends the copyright statute of limitations. Under that rule, when a defendant commits successive violations, the statute of limitations runs separately from each violation." *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 (2014).

Nor will a plaintiff lose her claim in a case involving ongoing (rather than separate) violations that began more than three years previously. "Where a plaintiff challenges an unlawful practice that continues into the limitations period, the complaint is timely when it is filed within the limitations period, measured from the last asserted occurrence of that practice." *Petrella*, 134 S. Ct. at 1969 n.6 (quoting *Havens Realty Corp.* v. *Coleman*, 455 U.S. 363, 380-381 (1982) (brackets and ellipses omitted)). Thus, a plaintiff's damages window may shift to a less-lucrative time frame pending registration of her copyright. But it is unlikely to be eliminated. And while lost damages are undoubtedly a legitimate concern, that scenario is a far cry from the dire picture painted by petitioner.

It is theoretically possible that petitioner's worst-case scenario will arise. But even then, a claimant seeing that result on the horizon may seek "special handling" of her application and have her registration in hand within a matter of days (typically five). See U.S. Copyright Office, *Special Handling* (*Circular 10*), at 2 (2017), https://www.copyright.gov/circs/circ10.pdf. Petitioner acknowledges the availability of special handling, but contends it is no solution because the cost of expediting may be prohibitive to litigants. Pet. 16. The $800 special handling fee, however, is a pittance compared to the cost of litigating a copyright action in federal court. The case initiation fee *alone* is $400. See 28 U.S.C. 1914(a) ("instituting any civil

action" requires "a filing fee of $350"); U.S. Judicial Conference, *District Court Miscellaneous Fee Schedule* (2016) (additional $50 "[a]dministrative fee for filing a civil action"), https://goo.gl/mNWFhX. Thus, in the hypothetical case where waiting out the normal process would substantially jeopardize a claim, the special handling fee is at worst a marginal additional burden on the copyright holder.[2]

Finally, Congress has accounted for the circumstances where a delay in filing suit would be most likely to cause irreparable harm. Section 411(c), for example, permits claimants to seek an injunction against a potential infringer in advance of a live broadcast (such as the Super Bowl). See H.R. Rep. No. 1476, 94th Cong., 2d Sess. 157 (1976); S. Rep. No. 473, 94th Cong., 1st Sess. 140 (1975).[3] Similarly, Section 408(f) allows claimants to "preregister" a copyright, even before first publication, in certain circumstances where the delay in obtaining registration could cause irreparable harm (for example, to prevent piracy of highly anticipated movies or musical albums).

---

[2] Petitioner argues the expense of expediting is particularly problematic in cases involving multiple works. Pet. 16. But here again petitioner dramatically overstates the scale of the issue. In many cases, a group of works (like a musical album, an anthology of poems, or a collection of articles in a periodical) can be expedited together, with the payment of a single fee. See U.S. Copyright Office, *Multiple Works (Circular 34)*, at 2-4 (2017), https://www.copyright.gov/circs/circ34.pdf. Petitioner's example of multiple recordings by various artists on an independent record label (Pet. 16) may be incapable of group registration, but its suggestion that this problem will exist in the mine-run case is simply false.

[3] In most Section 411(c) cases, no remedy beyond the time-of-broadcast injunction is pursued, and claimants therefore never seek registration. See 46 Fed. Reg. 28,846 (May 29, 1981).

17 U.S.C. 408(f). These provisions entirely defuse petitioner's concerns in the contexts where they might otherwise be most valid.

B. The Decision Below Is Correct

This Court should also deny review because the Eleventh Circuit correctly concluded that Section 411(a) permits suit only after the Register of Copyrights has acted on an application for registration.

1. The plain language of Section 411(a) and its relationship to the surrounding provisions permit only one reading: the Register must act on an application before suit may be filed. The clearest evidence of this is the text of Section 411(a) itself, which says:

> [N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.

17 U.S.C. 411(a).

By far the most natural reading of this language is that no suit may be instituted until "registration * * * has been made" or "refused." Plainly, this requires action by the Register of Copyrights before suit may be filed. The answer is that simple.

Nonetheless, the very next provision confirms the Register's central role in making registration. Section 411(b) says "[a] certificate of registration satisfies the requirements of this section." 17 U.S.C. 411(b). Only

the Register of Copyrights issues certificates of registration, and it does so only "after examination." 17 U.S.C. 410(a). If an application for registration were sufficient on its own to satisfy Section 411(a), there would be no reason for Section 411(b)'s existence. Anytime the Register issued a certificate of registration, the application would have already satisfied Section 411(a). Constructions that create this type of surplusage should be avoided. See, *e.g.*, *La Resolana*, 416 F.3d at 1203 (reasoning that the application approach would make the examination requirement meaningless).

Petitioner's reading would also render unnecessary other important parts of the statute. For example, Section 410(d) says "[t]he effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights * * * to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. 410(d). If registration were complete upon application, there would be no need for Section 410(d) to relate the effective date back to the application's filing. Section 410(d) would be entirely unnecessary.

Perhaps even more problematic, petitioner's approach would render part of Section 411(a) *itself* unnecessary. After setting out the registration requirement, Section 411(a) goes on to say: "In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a).

In plain English: Section 411(a) permits suit to be filed even if the Register refuses registration, as long as notice is given. But if an application alone were sufficient to

make registration, Congress would not need to give applicants permission to sue upon refusal. Registration would always already "ha[ve] been made" under the provision's first sentence. Fully half of Section 411(a) would become surplusage.

Petitioner attempts to escape this problem by arguing that the second half of Section 411(a) actually imposes an additional *procedural* requirement, not a prerequisite to suit. That is incorrect.

As an initial matter, petitioner's reading would require the Court to give "registration" different meanings in consecutive sentences. Section 411(a)'s first sentence would require action only by the claimant, whereas its second sentence would involve action by the Register as well (refusal to make registration). This runs afoul of basic canons of statutory interpretation.

But even were it plausible to read "registration" differently in consecutive sentences, petitioner's interpretation would not be colorable. Petitioner's proposed scheme would permit suit to be filed upon application, and then require notice if the Register *later* refuses registration. But the text of the statute contemplates that refusal will come *before* the suit commences. It says that "where * * * registration *has been refused*, the applicant is entitled to *institute* a civil action for infringement." 17 U.S.C. 411(a) (emphasis added); see 5 William F. Patry, *Patry on Copyright* § 17:78 (2017) (The Copyright Act of 1976 "changed [the operative verb from] 'maintained' to 'instituted' in order to make as clear as possible" that the Register's action must come before suit is filed.). Petitioner's approach thus does not stand up to the text Congress actually enacted.

2. Each of these flaws in petitioner's reasoning arises from the same fundamental problem: petitioner's interpretation rests on the premise that "making registration"

requires action *only* by the copyright holder. But that premise is unsound. To be sure: registration cannot happen without action by the copyright holder. As discussed above, however, registration *also* requires action by the Register of Copyrights.

Indeed, petitioner has no choice but to acknowledge that the Register registers copyrights. Pet. 20, 21. Its approach would otherwise read the Register out of the Act. To avoid that result but still reach its desired construction, the petition engages in serious interpretive gymnastics, and it ultimately lands at an equally untenable solution: whenever Congress said "make" registration, it really meant "apply for" registration. See *id.* at 20 ("while the Copyright Office 'registers a claim,' the copyright owner 'makes registration'" (citations and brackets omitted)). This construction violates basic tenets of statutory interpretation. The Eleventh Circuit properly rejected it.

a. Petitioner contends that Section 411(c) "confirms" its dual-meaning interpretation of the word "registration." Pet. 19. Not so. Section 411(c) provides:

> In the case of a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission, the copyright owner may, either before or after such fixation takes place, institute an action for infringement * * * fully subject to the remedies provided by [the Act], if * * * the copyright owner—
>
> (1) serves notice upon the infringer, not less than 48 hours before such fixation, identifying the work and the specific time and source of its first transmission, and declaring an intention to secure copyright in the work; and
>
> (2) makes registration for the work, if required by [Section 411(a)], within three months after its first transmission.

17 U.S.C. 411(c).[4]

Because a person who seeks remedies under Section 411(c) must, in certain circumstances, "make[] registration for the work * * * within three months after its first transmission," petitioner argues an application alone must be all that is necessary. Given normal six- to eight-month application processing times, petitioner suggests, it would be odd for Congress to require the Register to have acted within only three.

But that is precisely what Congress did. Section 411(c) does not purport to change the meaning of Section 411(a)'s registration requirement. It instead creates a narrow but powerful *exception* to that requirement—permitting a claimant to seek injunctive relief under the Act *without* first obtaining registration. As Congress itself explained, Section 411(c) was intended

> to deal with the special situation presented by works that are being transmitted 'live' at the same time they are being fixed in tangible form for the first time. Under certain circumstances, where the infringer has been given advance notice, an injunction could be obtained to prevent the unauthorized use of the material included in the transmission.

H.R. Rep. No. 1476, *supra*, at 157; S. Rep. No. 473, *supra*, at 140.

The Copyright Office and all relevant stakeholders understood that the purpose of Section 411(c) was to enjoin infringement of live broadcasts (for example, the Super Bowl). See 46 Fed. Reg. 28,846 (May 29, 1981). And in

---

[4] Prior to the Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. No. 110-403, 122 Stat. 4257, this provision was labeled Section 411(b).

most cases, an injunction *at the time of broadcast* is adequate to protect the copyright holder's interests—no ongoing infringement suit is necessary. Thus, in the mine-run case, the copyright holder need not seek registration at all. *Ibid.*[5]

In the rare case where an injunction at the time of broadcast does not satisfy the copyright holder, it makes perfect sense that Congress imposed an exacting burden to maintaining suit. Section 411(c) is a strong remedy and a major exception to Section 411(a)'s general rule. That a copyright owner might have to seek special handling to take advantage of it is hardly surprising. And to prevent powerful stakeholders (like professional sports interests) from abusing Section 411(c), it is entirely logical that Congress desired the Register's input in such cases on an expedited time frame.[6]

Given the reality of Section 411(c)'s purpose and function, petitioner's reasoning is simply a red herring. Properly understood, this provision offers no reason to

---

[5] That is what stakeholders themselves told the Copyright Office. For example, in response to the Register's 1981 Notice of Rulemaking regarding Section 411(c),

> [c]omments submitted on behalf of the professional sports interests * * * argued that the registration requirement is triggered only if the author or copyright owner proceeds to file an action for infringement. They indicated that they do not intend to register every work that is mentioned in [a pre-broadcast injunction], but will of course register the works if an infringement action is brought.

46 Fed. Reg. at 28,847. The Register accepted this view and thus declined to require registration anytime a copyright holder obtained a time-of-broadcast injunction. *Ibid.*

[6] Thus, to be clear, a court would be wrong to permit a Section 411(c) suit to continue beyond three months based only on an application for registration. Respondents are unaware of any case where that has occurred. And, notably, petitioner does not cite any.

believe Congress intended registration "has been made" to mean registration "has been applied for."

b. That Congress distinguished between "having made" and "having applied for" registration is emphatically underscored by the preregistration provisions of Section 408(f). Congress amended the Copyright Act in 2005 to permit "preregistration for [certain] * * * works that the Register determines ha[ve] had a history of infringement prior to authorized commercial distribution." Pub. L. No. 109-9, 119 Stat. 221 (amending 17 U.S.C. 408 to add Subsection (f)). This provision was designed to combat problems like piracy of highly anticipated movies or musical albums before they are released. See *La Resolana*, 416 F.3d at 1207.

Unlike Section 411(c), Section 408(f) does not require a claimant to "have made" registration within three months. Instead, a person who files an infringement action under Section 408(f) must "*appl[y]* for registration of the work" within "3 months after first publication." 17 U.S.C. 408(f)(3) (emphasis added).[7] Section 408(f) unequivocally shows that Congress specified "applying for" registration when that is what it meant. It entirely undermines petitioner's already suspect contention that Congress did so with the "make registration" construction. When Congress wished to make "an application for registration" the only requirement for maintaining suit, it did so expressly.

That is the bottom line: Congress meant what it said. Section 411(a) requires registration or refusal, not simply application, before suit may be filed.

---

[7] Failure to do so may result in dismissal. 17 U.S.C. 408(f)(4) (requiring dismissal if the infringement commenced within two months of first publication and the application is not submitted "within the earlier of—(A) 3 months after first publication of the work; or (B) 1 month after the copyright owner has learned of the infringement").

3. Petitioner's resort to the policy underlying the Act fares no better than its textual argument. As the United States explained in *Reed Elsevier*, the registration approach entirely vindicates Congress's intent to induce registration by making it a prerequisite to suit. See U.S. Amicus Br. at 20, *Reed Elsevier*, *supra* (No. 08-103). Indeed, this requirement "serves broad[] systemic interests." *Ibid.* For example, "[b]y making the right to sue for copyright infringement contingent on registration, Congress sought to expand the Library of Congress's collection of copyrighted works, provide a public record of copyright ownership, and afford courts the benefit of the Copyright Office's expertise." *Ibid.* And as explained above (pp. 6-8, 14-15, *supra*), the registration requirement achieves these goals while imposing only a limited burden on copyright holders' ability to vindicate their rights. The registration approach thus reflects a careful balance of "incentives and sanctions" designed "to bring about the desired registration." Benjamin Kaplan, *Study No. 17: The Registration of Copyright, Copyright Law Revision Studies Prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the Comm. on the Judiciary*, 86th Cong., 2d Sess. 65 (Comm. Print 1960).

Petitioner's arguments to the contrary do not show how its interpretation fulfills these policy goals; they explain, rather, why petitioner believes Congress should have chosen different goals in the first place. For example, petitioner argues that courts should adopt the application approach because "a copyright owner's rights do not depend on any affirmative government grant." Pet. 22. But that argument either (1) entirely ignores Congress's goal of inducing registration by making it a prerequisite to suit, or (2) expresses a preference for a different balance of incentives than the one Congress se-

lected. Either way, it is no reason to conclude an application alone satisfies Section 411(a). See *La Resolana*, 416 F.3d at 1204 (explaining that a similar argument "begs the question" because "Congress created significant incentives for registration" by "condition[ing] the remedies of the Act" on registration).[8]

Similarly, petitioner argues that its approach would not deprive courts of the Register's view on registrability, because the Register could intervene in an ongoing action if it ultimately refused the plaintiff's application. Pet. 24. Again, this may well be a sensible policy. But it hardly explains how the application approach vindicates Congress's evident desire to have the Register's input *before* suit is filed—both to weed out frivolous claims and to shape the issues that must be litigated in any given case. See, *e.g.*, H.R. Rep. No. 609, 100th Cong., 2d Sess. 41-42 (1988) ("If the requirement of registration as a prerequisite to suit were eliminated, there would likely be increased difficulty in trying copyright cases."); *id.* at 41 (the registration requirement "promotes efficient litigation practices, to the benefit of the courts and the public as well as to the parties in the lawsuit"); *id.* at 42 (discussing with approval that "suits have been kept out of court by the necessity of * * * registration and by the unwillingness of potential plaintiffs * * * following the [Register's] refusal to register because of the unfavorable light in which a judge might view the refusal to register and the undesirability of having the Copyright Office intervene in opposition"); *Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong., 1st Sess. 75

---

[8] Another example: promptly seeking registration is a prerequisite to seeking statutory damages and attorney's fees. See 17 U.S.C. 412 (precluding certain awards based on the "effective date" of registration, which relates back to the date the application was filed).

(Comm. Print 1961) ("Since the registration process identifies unfounded claims and assists the courts in establishing presumptive facts and applying the law, we believe the requirement of registration before suit should be maintained.").

If anything, petitioner's policy arguments underscore how the application approach *diverges* from current law, and would serve policy goals different from the ones embodied in the Copyright Act.[9]

4. Even if the application approach were the better policy, the Copyright Act's history confirms what is al-

---

[9] Petitioner's policy argument also relies heavily on Professor Nimmer's criticism of the registration approach. Pet. 22, 25. Notably, though, Nimmer frames his discussion as a "critique of the current regime." 2 *Nimmer on Copyright* § 7.16[B]. And the approach he ultimately recommends is emphatically *not* the application approach. Nimmer instead proposes that courts apply a "harmonized solution" that draws elements from *both* approaches. *Id.* § 7.16[B][3][b][vi].

To be sure, in laying the groundwork for this solution, Nimmer says the application approach "better comports with the statutory structure" than the registration approach. 2 *Nimmer on Copyright* § [B][3][b][ii]. But this preference in fact sounds in policy, not text.

Nimmer reasons that because "the claimant * * * has done all that she can do, and will ultimately be allowed to proceed regardless of how the Copyright Office treats her application, it makes little sense to create a period of 'legal limbo' in which suit is barred." 2 *Nimmer on Copyright* § [B][3][b][ii]. Thus, "the application approach best effectuates the interests of justice and promotes judicial economy," particularly because "the Copyright Office typically registers about 99 percent of the claims submitted to it." *Ibid.* (internal quotation marks and brackets omitted).

Certainly, these are thoughtful reasons one might disfavor the registration approach as a *policy* matter, but they say little indeed about the meaning of Section 411(a)'s *text*. And in any event, this passage is but a stop along the way to Nimmer's preferred policy—the "harmonized solution." Nimmer's view, therefore, is of limited relevance, if any, in resolving the question presented.

ready plain from the Act's text: it is not the approach Congress enacted. Indeed, the legislative history *overwhelmingly* supports the Eleventh Circuit's conclusion that the Act requires registration, not just application. It does so not because it reveals some intent not otherwise embodied in the text, but because it unequivocally shows that for forty years, the entire legislative debate has rested on the premise that registration requires action by the Register.

In passing the Copyright Act of 1976, Congress debated whether to make registration a prerequisite to suit, but it never questioned what that requirement entails. The legislative history shows, for example, that Judge Hand's decision in *Vacheron*, 260 F.2d at 640-641 (holding that "acceptance by the Register" was a prerequisite to suit), informed Congress's understanding of the background law against which it was legislating. Although Congress partially abrogated *Vacheron* by permitting suit even where the Register refuses registration, it explained that "[u]nder the bill, *as under the law now in effect*, a copyright owner who has not registered his claim * * * cannot enforce his rights in the courts." H.R. Rep. No. 1476, *supra*, at 157 (emphasis added); S. Rep. No. 473, *supra*, at 139; see *ibid.* ("The second and third sentences of [S]ection 411(a) would alter the present law as interpreted in *Vacheron*" by permitting infringement actions where the Register refuses registration, rather than "requir[ing] an applicant * * * to bring an action against the Register."); *Report of the Register* 75 (same).

Congress did not make this decision lightly. It exhaustively considered options for eliminating the registration requirement altogether or replacing it with a less stringent alternative. See, *e.g.*, Kaplan 1-65, 85-98 (detailing alternative approaches). Among the "major issues" in that debate was whether "registration, *or application*

therefor, [should be] a prerequisite to an action for infringement." *Id.* at 98 (emphasis added).

The terms of the debate could not have been clearer. Both the registration approach and the application approach were on the table, and the text of Section 411(a) shows Congress made a clear choice between them.

In the intervening years, Congress has twice more considered eliminating the registration requirement. Legislators have repeatedly raised policy considerations similar to the ones petitioner relies on here—that the registration requirement is a wasteful formality that does not effectively accomplish its stated goal of inducing registration. *E.g.*, H.R. Rep. No. 388, 103d Cong., 1st Sess. 9-11 (1993) (arguing in favor of "eliminat[ing] the last significant vestiges of the formality-based approach to United States copyright law" for these reasons); compare *id.* at 10-11 (suggesting the Copyright Office's "role of gatekeeper to the courts" was inappropriate), with Pet. 22 ("Making the Copyright Office the gatekeeper to enforcement of copyrights is inconsistent with the rest of the Copyright Act."). But throughout this debate, no legislator has ever suggested that registration does not actually require the Register to act on the application. Both sides of the debate have always operated on the premise that registration means registration.

The importance of this history is hard to overstate. It is not just that Congress has three times rejected petitioner's position. Far more important to the *textual* analysis is that all stakeholders on both sides of the policy question have agreed on the debate's terms.

Petitioner now attempts to rewrite those terms not through advocacy to Congress, but through judicial revision. The Eleventh Circuit properly rejected this effort to subvert Congress's judgment, and it correctly concluded

that Section 411(a) permits suit only once the Register has acted on a copyright owner's application for registration.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

DAVID A. GELLER
1221 S. 21st Avenue
Hollywood, FL 33020

PETER K. STRIS
Counsel of Record
ELIZABETH BRANNEN
JOHN STOKES
STRIS & MAHER LLP
725 S. Figueroa Street
Suite 1830
Los Angeles, CA 90017
(213) 995-6800
peter.stris@strismaher.com

NOVEMBER 2017

No. 17-571

IN THE
Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURDEN,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

REPLY BRIEF FOR PETITIONER

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN INTELLECTUAL PROPERTY LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
COLLIN R. WHITE
KELLOGG, HANSEN, TODD, FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

December 13, 2017

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, petitioner Fourth Estate Public Benefit Corporation states that it is a public benefit corporation that has not issued any stock.

TABLE OF CONTENTS

Page

RULE 29.6 STATEMENT i

TABLE OF AUTHORITIES iii

ARGUMENT 2

I. THE QUESTION PRESENTED MERITS REVIEW 2

II. THE ELEVENTH CIRCUIT'S JUDGMENT IS INCORRECT 5

CONCLUSION 11

TABLE OF AUTHORITIES

Page

CASES

Apple Barrel Prods., Inc. v. Beard, 730 F.2d 384 (5th Cir. 1984) 11

Bruesewitz v. Wyeth LLC, 562 U.S. 223 (2011) 11

Cosmetic Ideas, Inc. v. IAC/Interactivecorp, 606 F.3d 612 (9th Cir. 2010) 3

Lakedreams v. Taylor, 932 F.2d 1103 (5th Cir. 1991) 11

Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962 (2014) 4

STATUTES AND RULES

Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 ..... 9, 10

Copyright Act (17 U.S.C.) 1, 3, 4, 5, 8, 9

17 U.S.C. § 102(a) 8

17 U.S.C. § 106 8

17 U.S.C. § 408 8

17 U.S.C. § 408(c)(3) 6

17 U.S.C. § 408(f) 4

17 U.S.C. § 408(f)(1) 8

17 U.S.C. § 408(f)(3) 8

17 U.S.C. § 408(f)(3)(A)-(C) 8

17 U.S.C. § 410(a) 5

17 U.S.C. § 410(d) 7, 8

17 U.S.C. § 411(a) 1, 2, 3, 5, 6, 7, 9, 11
17 U.S.C. § 411(b) 7
17 U.S.C. § 411(c) 4, 5, 6, 8
17 U.S.C. § 411(c)(2) 6
17 U.S.C. § 412 6
17 U.S.C. § 505 4
Sup. Ct. R. 10(a) 1

LEGISLATIVE MATERIALS

Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong. (Comm. Print 1961), *available at* https://www.copyright.gov/history/1961_registers_report.pdf 10

Copyright Law Revision: Studies Prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary, 86th Cong. (Comm. Print 1960), *available at* https://www.copyright.gov/history/studies/:

Study No. 17 – The Registration of Copyright 10

Study No. 18 – Authority of the Register of Copyrights To Reject Applications for Registration 10

H.R. Rep. No. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659 ..... 8, 9, 10

H.R. Rep. No. 103-388 (1993) 11

OTHER MATERIALS

2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2013).....3, 5, 9

Respondents concede that the Eleventh Circuit "has entered a decision in conflict with the decision of another United States court of appeals," Sup. Ct. R. 10(a), with respect to the meaning of the phrase "registration . . . has been made" in § 411(a) of the Copyright Act, 17 U.S.C. § 411(a). They do not contend that this conflict will be resolved absent this Court's review, nor do they deny that the question is cleanly presented in this case. Instead, they devote most of their brief to defending the Eleventh Circuit's rule. But arguments that the decision below is correct do not lessen the need for review. If respondents are right, the rule in two regional circuits – including the largest – permits copyright infringement actions to proceed in violation of the statute. That is reason enough to grant the petition.

Respondents argue that the importance of the question presented is modest, and, viewing the importance of the case through the lens of any particular infringement action, that will often (though not always) be true. But this procedural issue is presented at the threshold of virtually every copyright infringement action. Uncertainty over this question – which eight regional circuits have yet to resolve – invites needless litigation. Once this Court resolves the question, litigants will be able to abide by the rule, but, as long as the question remains unresolved, there is the prospect of needless delay and litigation – and, at least in the Tenth and Eleventh Circuits, the needless expenditure of funds to avoid protracted administrative delay.

Respondents' merits position echoes the key flaw of the decision below: it reads the word "registration" in isolation from its context. Consistent with common usage, Congress used the word "registration" in the Copyright Act in different ways. Sometimes it refers

to the action of the Copyright Office. Other times – particularly when used in the construction "make registration" – it refers to the actions of the copyright holder. Its use in § 411(a) falls in the latter category. And for good reason: barring a copyright owner from enforcing a copyright until after the Copyright Office disposes of the application pointlessly delays an action that will proceed regardless of whether the Copyright Office grants or refuses registration. The requirement of § 411(a) – as the plain language of the statute makes clear – is to ensure that copyright holders make registration before filing suit, not to ensure that the Copyright Office grants it.

The Court should grant the petition and reverse the judgment of the Eleventh Circuit.

ARGUMENT

I. THE QUESTION PRESENTED MERITS REVIEW

Respondents concede that the question presented has split the lower courts. Opp. 2; *see also* Pet. 9-15. The Court should resolve that conflict and do so in this case.

Respondents do not contend that permitting additional courts of appeals to weigh in on the question presented would yield either new arguments or resolution without this Court's review. It would not. The issue is narrow, yet the split has only deepened over time. Nor do respondents identify any reason this Court cannot resolve this confusion in this case. None exists.[1]

---

[1] After the petition was filed, counsel for the Copyright Office provided counsel for petitioner with an unsigned draft of a letter (dated August 4, 2017) rejecting petitioner's application for registration. Assuming that petitioner's application has now

Respondents' position that the split is not important enough to warrant resolution is undermined by their extended focus on the merits. *See* Opp. 9-21. On their telling, the courts that have adopted petitioner's rule are in conflict with the Copyright Act's plain text, disregarding copyright defendants' rights and undermining the Copyright Office's role as gatekeeper to the courts. Respondents misread the statute, but, if they were right, those would be reasons to grant review, not to deny it.

Further, like the court below, *see* App. 8a, respondents admit their rule's consequence if the Copyright Office fails to process an application promptly: the copyright owner can lose damages or, in the worst case, an entire claim. Opp. 6-7; *see also* 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][3][b][iii] (2013) (respondents' rule "may indeed occasion complete inability to recover damages") (footnote omitted). They never dispute that their rule can preclude preliminary injunctive relief – a vital remedy for many copyright owners. *See Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 620 (9th Cir. 2010); 2 *Nimmer on Copyright* § 7.16 n.214 ("in some cases, a preliminary injunction is of the essence," and the rule respondents endorse "could effectively squelch that remedy, too"). Nor do respondents deny that, even where the owner does not lose a remedy, their rule may require the copyright holder to re-file the same infringement action after the Copyright Office has acted, burdening both parties and courts with duplicative litigation.

---

been acted on, that does not moot the controversy in this case, which depends on whether the allegations of the complaint – that petitioner had made the deposit, application, and fee required for registration – satisfy § 411(a).

The question presented does not become unimportant because a copyright owner can expedite an application by paying the Copyright Office an $800 "special handling" fee. Opp. 7-8. At the outset, when a copyright holder seeks relief for infringement of multiple works, all requiring separate registration, the cost of expediting the administrative process may easily amount to many thousands of dollars. To be sure, the special handling fee will usually be smaller than the expected costs of copyright litigation (though not always: a prevailing copyright owner may recover attorney's fees, 17 U.S.C. § 505). But the observation that litigation is expensive is not a reason to ignore a rule that makes it more expensive still.

No other source of law respondents identify fully mitigates these harms. True, the Copyright Act qualifies the registration requirement in certain cases. *See* 17 U.S.C. § 411(c) (live broadcasts); *id.* § 408(f) (preregistration for certain works prepared for commercial distribution). But those provisions do nothing to help the many copyright owners that, like petitioner, do not fall within their protections. Similarly, respondents observe that, "in a case involving ongoing (rather than separate) violations that began more than three years previously," the rule they endorse would not deprive a copyright owner of a claim, but merely move the damages period. Opp. 7 (citing *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 n.6 (2014)). But, as respondents concede (*id.*), reducing a copyright holder's recovery is "a legitimate concern" in its own right, and one for which respondents have no answer.[2]

---

[2] Respondents (at 2, 6) selectively quote part of Professor Nimmer's aside that, "[i]n some sense," this conflict is a

In all events, assuming that a copyright holder may usually be able to avoid the worst consequences of delay by the Copyright Office, the uncertainty engendered by the current division of authority affects countless cases in which this issue is implicated. The rule adopted by the court of appeals would require many copyright holders either to delay suit or to incur hundreds if not thousands of dollars in fees to expedite the administrative process. In the majority of circuits where the rule is unsettled, parties may needlessly litigate over the issue, as they have done in this case. The systemic cost is substantial, and the issue is important for that reason.

II. THE ELEVENTH CIRCUIT'S JUDGMENT IS INCORRECT

1. Respondents insist that the term "registration," whenever it is used in the Copyright Act, must refer to the action of the Register of Copyrights under § 410(a) – that is, issuing a certificate of registration. Accordingly, they argue, the phrase "registration . . . has been made" in § 411(a) must mean that the Copyright Office has registered the work. But the argument that "registration" always implies action by the Register cannot be squared with the statutory text.

Section 411(c) – with which respondents grapple unsuccessfully for three pages of their brief – most

---

"tempest in a teapot" because "plaintiffs could always avoid dismissal of their case by filing a new application for registration with the Copyright Office on an expedited basis." 2 *Nimmer on Copyright* § 7.16[B][3][b][v]. In the same paragraph, however, he goes on to catalog the problems with that solution: it requires "payment of a stiff charge" and the potential "loss of vital remedies," which might "render[] [the copyright owner's] suit pointless." *Id.*

clearly demonstrates respondents' error.[3] That provision allows a copyright owner to institute an action for infringement of certain types of works so long as "the *copyright owner* . . . makes registration for the work[s]" within three months of instituting suit. 17 U.S.C. § 411(c)(2) (emphasis added). That provision thus makes explicit *who* "makes registration": the "copyright owner." It is thus natural to read the parallel construction in § 411(a) – "registration . . . has been made" – likewise to refer to the action of the copyright owner.

Respondents assert that § 411(c) actually "require[s] the *Register*" – not the copyright owner – "to have acted" within three months. Opp. 13 (emphasis added). But the language of the provision is to the contrary. It permits a copyright owner to seek injunctive relief so long as *the copyright owner* takes action – that is, makes registration – within the prescribed time. The provision does not require the copyright owner to have *obtained* a certificate of registration, nor does it refer to any action of the Copyright Office. Section 411(c)'s requirement to make registration is a

---

[3] Respondents do not even address the other provisions of the statute that similarly use "make registration" or a variant to refer to the actions of the copyright holder. *See* 17 U.S.C. § 408(c)(3) ("a single renewal registration may be made for a group of works by the same individual author . . . upon the filing of a single application and fee"); *id.* § 412 ("[N]o award of statutory damages or of attorney's fees . . . shall be made for . . . any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work."); Pet. 20-21.

procedural obligation placed on the copyright owner; the same is true of § 411(a).[4]

Section 411(b) does not support a different result. It clarifies that (with narrow exceptions) a copyright owner may rely on a certificate of registration even if it contains inaccurate information. But the fact that an inaccurate certificate is not disqualifying does not suggest that *every* infringement plaintiff will be able to provide a certificate of registration – on the contrary, all agree that in some cases (for example, when registration has been refused) the copyright owner will not have such a certificate. Likewise, in those cases where a copyright owner has made registration but has not yet received a certificate, § 411(b) will not apply – but that does not render it superfluous.

Contrary to respondents' argument (at 10), petitioner's interpretation of § 411(a) is in no tension with § 410(d), which establishes the effective date of registration. As respondents acknowledge, petitioner does not contend that registration *cannot* refer to the action of the Copyright Office. By the same token, there is no linguistic reason that the "effective date of a copyright registration" – which affects the rights and remedies of infringers – could not be the date on which a certificate of registration is issued. But the statute makes clear that the effective date is instead the date on which the "application, deposit, and fee"

---

[4] Respondents have no answer to the argument that their reading creates a contradiction between the first and second sentences of § 411(a). *See* Pet. 18-19. Nor does § 411(a)'s second sentence suggest that a copyright owner must obtain a certificate of registration to sue under § 411(a)'s first sentence – rather, it clarifies that, if a copyright owner whose application is rejected initiates suit, the copyright owner must notify the Copyright Office.

are received, 17 U.S.C. § 410(d) – that is, the date on which the copyright owner makes registration, not the date on which the Copyright Office registers the claim.

Section 408(f)(3) – which speaks to works that a copyright owner, anticipating commercial distribution, preregisters while they were unpublished, *see id.* § 408(f)(1) – does not, as respondents suggest (at 15), show that Congress distinguished "making registration" from "applying for" registration. Indeed, the latter phrase does not appear in § 408. The statute provides that, "[n]ot later than 3 months after the first publication of a work preregistered under this subsection, the applicant shall submit to the Copyright Office" the same three things she would have to submit to register any other claim: "an application for registration of the work," "a deposit," and "the applicable fee." 17 U.S.C. § 408(f)(3)(A-C). By taking these actions, the copyright owner makes registration of the work – as § 411(c) and other provisions make clear.

2. Respondents do not seriously dispute that petitioner's reading is more consistent, as well, with the Copyright Act's remedial scheme. Again (and unlike the patent laws), the Act grants copyright owners exclusive rights in their works from the moment of fixation. *See* 17 U.S.C. §§ 102(a), 106; H.R. Rep. No. 94-1476, at 129 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5745. And, regardless of whether the Register of Copyrights accepts or refuses registration, the copyright owner still has the right to sue and enforce those rights. To be sure, the registration requirement encourages registration, with related public benefits (for example, adding the work to the collection of the Library of Congress).

See Opp. 16; *accord* Pet. 23. "But" – again – "once the copyright owner has made registration, that policy is fully vindicated." Pet. 23. Respondents never explain why the "legal limbo" their approach creates is necessary to further that policy. Opp. 18 n.9.

Nor is respondents' rule required to secure the Copyright Office's expertise in the unusual case that calls for it. *Cf.* Opp. 17. Instead, in an appropriate case, the court can invite the Office to act on an application before litigation proceeds. *See* Pet. 25-26. That is the point of Professor Nimmer's "harmonized solution," which respondents misunderstand (at 18 n.9) to conflict with petitioner's reading. Under his approach, cases filed after the owner submits a completed application but before the Office acts on that application should generally proceed on the merits. But, in the rare dispute that turns on copyrightability, the court should stay proceedings pending the Office's action. *See* 2 *Nimmer on Copyright* § 7.16[B][3][b][vi]. As to the question presented, Professor Nimmer rejects respondents' rule and endorses petitioner's, and for the same reasons: respondents' rule conflicts with the Copyright Act's text, structure, and purpose. *See id.* § 7.16[B][3][b][ii].

3. Section 411(a)'s legislative history likewise offers respondents little support. On the contrary, the 1976 Act's legislative history confirms that the term "registration" can, in context, refer to the copyright owner's actions – not the Copyright Office's. *See* H.R. Rep. No. 94-1476, at 157, 1976 U.S.C.C.A.N. 5773 ("[A] copyright owner who has not registered his claim can have a valid cause of action against someone who has infringed his copyright, but he

cannot enforce his rights in the courts until *he* has made registration.") (emphasis added); *id.* at 152, 1976 U.S.C.C.A.N. 5768 ("Under section 408(a), registration of a claim to copyright in any work, whether published or unpublished, can be made voluntarily by '*the owner of copyright* or of any exclusive right in the work' at any time during the copyright term.") (emphasis added); *accord* Opp. 19 ("'[A] copyright owner who has not registered his claim cannot enforce his rights in the courts.'") (quoting H.R. Rep. No. 94-1476, at 157, 1976 U.S.C.C.A.N. 5773) (alteration omitted).

Respondents cite discussions from early in the unusually lengthy history of the 1976 Act, but statements in committee materials from 1958,[5] 1959,[6] and 1961[7] are hardly dispositive of the meaning of the words Congress adopted more than a decade later. For similar reasons, the post-1976 Act legislative history on which respondents rely is also inapt. To start, "[p]ost-enactment legislative history (a contradiction in terms) is not a legitimate

---

[5] *See Copyright Law Revision: Studies Prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary; Study No. 17 – The Registration of Copyright*, 86th Cong. 65 (Comm. Print 1960), *available at* https://www.copyright.gov/history/studies/.

[6] *See Copyright Law Revision: Studies Prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary; Study No. 18 – Authority of the Register of Copyrights To Reject Applications for Registration*, 86th Cong. 89 (Comm. Print 1960), *available at* https://www.copyright.gov/history/studies/.

[7] *See Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong. 75 (Comm. Print 1961), *available at* https://www.copyright.gov/history/1961_registers_report.pdf.

tool of statutory interpretation." *Bruesewitz v. Wyeth LLC*, 562 U.S. 223, 242 (2011). Moreover, although statements in those materials appear to assume respondents' view of § 411(a),[8] they ignore contrary circuit-level authority. *See Lakedreams v. Taylor*, 932 F.2d 1103, 1108 (5th Cir. 1991); *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984) (citing then-current version of *Nimmer on Copyright*). A post-enactment gloss in a committee report provides no basis to ignore the text of the statute.

CONCLUSION

The petition for a writ of certiorari should be granted.

---

[8] *See, e.g.*, H.R. Rep. No. 103-388, at 9-11 (1993) (speaking of a "requirement that a registration or refusal to register be obtained from the Copyright Office before an action for infringement be obtained").

Respectfully submitted,

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN
INTELLECTUAL PROPERTY
LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
COLLIN R. WHITE
KELLOGG, HANSEN, TODD,
FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

December 13, 2017

No. 17-571

In the Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

NOEL J. FRANCISCO
Solicitor General
Counsel of Record
CHAD A. READLER
Acting Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
JONATHAN Y. ELLIS
Assistant to the Solicitor General
MARK R. FREEMAN
DENNIS FAN
Attorneys

Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

SARANG VIJAY DAMLE
General Counsel and Associate Register of Copyrights
REGAN A. SMITH
Deputy General Counsel
JASON E. SLOAN
Attorney Advisor
United States Copyright Office
Washington, D.C. 20540

QUESTION PRESENTED

Section 411(a) of the Copyright Act provides that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with this title," or (2) "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused." 17 U.S.C. 411(a). The question presented is as follows:

Whether a copyright owner may commence an infringement suit after delivering the proper deposit, application, and fee to the Copyright Office, but before the Register of Copyrights has acted on the application for registration.

TABLE OF CONTENTS

Page

Interest of the United States 1
Statement 1
Discussion 8
A. The question presented is the subject of an entrenched circuit conflict that warrants resolution by this Court 9
B. Under Section 411(a), a copyright-infringement suit may not be filed until the Register of Copyrights has either approved or refused registration of the work 12
Conclusion 23
Appendix A — United States Copyright Office letter to William Brown (Apr. 4, 2016) 1a
Appendix B — United States Copyright Office letter to William Brown (Aug. 4, 2017) 3a

TABLE OF AUTHORITIES

Cases:

Action Tapes, Inc. v. *Mattson*, 462 F.3d 1010 (8th Cir. 2006) 9
Algonquin Music, Inc. v. *Mills Music, Inc.*, 93 F. Supp. 268 (S.D.N.Y. 1950) 18
Alicea v. *Machete Music*, 744 F.3d 773 (1st Cir. 2014) 10
Brooks-Ngwenya v. *Indianapolis Pub. Sch.*, 564 F.3d 804 (7th Cir. 2009) 10
Clark v. *Rameker*, 134 S. Ct. 2242 (2014) 16
Cosmetic Ideas, Inc. v. *IAC/Interactivecorp*, 606 F.3d 612 (9th Cir.), cert. denied, 562 U.S. 1062 (2010) 7, 9
Hall v. *United States*, 566 U.S. 506 (2012) 20
Kernel Records Oy v. *Mosley*, 694 F.3d 1294 (11th Cir. 2012), cert. denied, 569 U.S. 919 (2013) 7

Cases—Continued: Page

La Resolana Architects, PA v. *Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010) 6, 9, 10
Lumiere v. *Pathe Exch., Inc.*, 275 F. 428 (2d Cir. 1921) 17
Mellouli v. *Lynch*, 135 S. Ct. 1980 (2015) 16
Petrella v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014) 14
Positive Black Talk Inc. v. *Cash Money Records Inc.*, 394 F.3d 357 (5th Cir. 2004), abrogated on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010) 7, 9
Psihoyos v. *John Wiley & Sons, Inc.*, 748 F.3d 120 (2d Cir. 2014) 10
Reed Elsevier, Inc. v. *Muchnick*, 559 U.S. 154 (2010) 4, 7, 13
Rosedale v. *News Syndicate Co.*, 39 F. Supp. 357 (S.D.N.Y. 1941) 18
Star Athletica, L.L.C. v. *Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) 12
Vacheron & Constatin-Le Coultre Watches, Inc. v. *Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958) 18

Statutes and regulations:

Act of May 31, 1790, ch. 15, 1 Stat. 124 2
§ 3, 1 Stat. 125 2
Act of Mar. 4, 1909, ch. 320, § 12, 35 Stat. 1078 17
Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541 (17 U.S.C. 101 *et seq.*) 1, 18
17 U.S.C. 101 4
17 U.S.C. 102(a) 1

Statutes and regulations—Continued: Page

17 U.S.C. 106 1
17 U.S.C. 205(c) 21
17 U.S.C. 406(a) 21
17 U.S.C. 408 14
17 U.S.C. 408(a) 2
17 U.S.C. 408(b) 2
17 U.S.C. 408(c)(3) 20
17 U.S.C. 408(e) 20
17 U.S.C. 408(f) 16, 22
17 U.S.C. 408(f)(2) 17
17 U.S.C. 408(f)(3) 16
17 U.S.C. 409 ..... 2, 14
17 U.S.C. 410 2
17 U.S.C. 410(a) 2, 3, 7, 14
17 U.S.C. 410(b) 3
17 U.S.C. 410(c) 5
17 U.S.C. 410(d) 4, 14, 16
17 U.S.C. 411 4
17 U.S.C. 411(a) (§ 101, 90 Stat. 2583) ..... *passim*
17 U.S.C. 411(b) 4, 14
17 U.S.C. 411(c) 20, 22
17 U.S.C. 412 ..... 5, 22
17 U.S.C. 412(2) 20
17 U.S.C. 501(a) 1
17 U.S.C. 502 1
17 U.S.C. 503 1
17 U.S.C. 504 1
17 U.S.C. 504(c) 5
17 U.S.C. 505 ..... 1, 5
17 U.S.C. 705 ..... 3, 21

Regulations—Continued: Page

37 C.F.R.:
Section 201.3(d)(7) 4
Section 202.16(b)(1) 17
Section 202.16(c) 17

Miscellaneous:

Black's Law Dictionary:
revised 4th ed. 1968 ..... 13, 16
10th ed. 2014 13
H.R. Rep. No. 1476, 94th Cong., 2d Sess. (1976) 18, 19
Prof. Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (Aug. 1958), reprinted in Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revision: Studies Prepared Pursuant to S. Res. 240, Studies 17-19* (Comm. Print 1960) 2
2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2018) 10
5 William F. Patry, *Patry on Copyright* (2017) 10
U.S. Copyright Office:
Compendium of U.S. Copyright Office Practices (3d ed. 2017) 3, 4, 6, 13, 22
Public Catalog, http://cocatalog.loc.gov 3
Webster's Third New International Dictionary (1966) 13

In the Supreme Court of the United States

No. 17-571

FOURTH ESTATE PUBLIC BENEFIT CORPORATION, PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

INTEREST OF THE UNITED STATES

This brief is submitted in response to the Court's order inviting the Solicitor General to express the views of the United States. In the view of the United States, the petition for a writ of certiorari should be granted.

STATEMENT

1. The Copyright Act of 1976, 17 U.S.C. 101 *et seq.*, grants copyright protection to "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. 102(a). Among other rights and benefits, copyright protection confers on owners the exclusive rights to copy, distribute, and perform the works. 17 U.S.C. 106. Anyone who violates these rights is "an infringer of the copyright" and may be liable for actual or statutory damages, injunctive relief, and attorney's fees and costs. 17 U.S.C. 501(a), 502, 503, 504, 505.

Since the initial Copyright Act of 1790, Act of May 31, 1790, ch. 15, 1 Stat. 124, Congress has provided for the official registration of copyrighted works. See generally Prof. Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (Aug. 1958), reprinted in Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revisions: Studies Prepared Pursuant to S. Res. 240, Studies 17-19*, at 9-27 (Comm. Print 1960). Initially, each author was required, as a condition of copyright protection, to deposit a copy of his work in the clerk's office of the district court where the author resided so that the clerk could "record the same forthwith, in a book to be kept by him for that purpose." § 3, 1 Stat. 125. Under current law, the responsibility for registration rests with the Register of Copyrights as director of the Copyright Office. 17 U.S.C. 408(a), 410. "Such registration is not a condition of copyright protection." 17 U.S.C. 408(a). As described below, however, an author generally must register his work in order to commence an action for infringement or to obtain certain statutory remedies and evidentiary benefits.

a. A copyright owner "may obtain registration of the copyright claim by delivering to the Copyright Office" generally two copies of the work, along with an application containing information about the work and the application fee. 17 U.S.C. 408(a) and (b), 409. Upon receiving the copies, a compliant application, and the appropriate fee, the Register "examin[es]" the "material deposited" to determine whether the work "constitutes copyrightable subject matter" and whether "other legal and formal requirements of [the Copyright Act] have been met." 17 U.S.C. 410(a).

If "after examination" the Register determines that the legal and formal requirements are satisfied, "the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office." 17 U.S.C. 410(a). The Office also enters the registration into its records catalog, creating an official public record of the work and of its copyrighted status. See 17 U.S.C. 705; U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 209 (3d ed. 2017) (*Compendium*). Records of post-1977 registered works are available on the Internet to be searched by the public. See U.S. Copyright Office, *Public Catalog*, http://cocatalog.loc.gov. If the Register instead finds that "the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration" and shall notify the applicant of that refusal. 17 U.S.C. 410(b).

This examination process often involves a dialogue between the Copyright Office and the applicant. For example, an examiner may "discover[] that the applicant failed to provide sufficient information in a particular field or space of the application or elsewhere in the registration materials, or [that] the applicant otherwise failed to meet the registration requirements." *Compendium* § 605.3(B). In the course of such correspondence, an owner can clarify the scope of his application or may withdraw or otherwise abandon his claim. *Id.* §§ 605.3(B), 605.7, 605.9.

Depending on the necessary correspondence and the complexity of the legal issues presented, the time to complete this process varies, but the average time for the Office to resolve a registration application is ap-

proximately eight months. Applicants may request expedited processing of their claims at any time, however, and for an additional fee "the Office will make every attempt to examine the application or the document within five working days." *Compendium* § 623.4; see *id.* § 623.6.[1] If the Register ultimately grants registration of a work, the effective date of that registration is the date on which the Copyright Office first received a proper application, deposit, and fee. See 17 U.S.C. 410(d).

b. Although registration is no longer a condition of copyright protection, the Copyright Act continues to provide a number of incentives for copyright owners to seek registration promptly.

As most relevant here, Section 411(a) provides that "no civil action for infringement of the copyright in any United States work shall be instituted until * * * registration of the copyright claim has been made in accordance with this title." 17 U.S.C. 411(a); see *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154, 157 (2010) (explaining that Section 411(a) establishes a nonjurisdictional precondition to suit).[2] Absent an allegation that the owner knowingly submitted an inaccurate application, the Register's issued certificate of registration "satisfies the requirements of" Section 411. 17 U.S.C. 411(b). Section 411(a) further provides that, "[i]n any case * * * where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement," as long as "notice thereof, with

---

[1] The current fee for expedited processing is $800. 37 C.F.R. 201.3(d)(7).

[2] In general, "United States work[s]" are works created in the United States or exclusively by domestic authors. 17 U.S.C. 101.

a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a). Within the 60-day period after such notice has been served, the Register may intervene "with respect to the issue of registrability of the copyright claim." *Ibid.*

The Copyright Act provides additional incentives for prompt submission of applications to register authors' works. The Act authorizes awards of statutory damages, costs, and attorney's fees to prevailing copyright owners. 17 U.S.C. 504(c), 505. Those remedies generally are available, however, only for acts of infringement that occur *after* the effective date of registration. See 17 U.S.C. 412. In addition, a "certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. 410(c).

2. Petitioner Fourth Estate Public Benefit Corporation generates news articles, which it licenses to various websites while retaining ownership of the copyrights. Pet. App. 2a. Respondents Wall-Street.com and its owner initially published petitioner's articles online pursuant to such a licensing agreement. *Ibid.* Petitioner alleges, however, that after respondents cancelled the agreement, they continued to display the articles on their website without petitioner's permission. *Ibid.*

In early March 2016, petitioner deposited a number of those articles with the Copyright Office and submitted an application and fee for registration of a computer database. See App., *infra*, 3a-4a. "For purposes of copyright registration, a database is defined as a compilation of digital information" where the "selection, coordination, and/or arrangement of data or other component elements within the database is sufficiently creative to

warrant registration." *Compendium* §§ 1117.1, 1117.2. Petitioner did not request expedited processing of its claim.

Days later, before the Register had acted on the application, petitioner filed this copyright infringement suit. Pet. App. 15a-22a. The Copyright Office subsequently informed petitioner that its initial check for the application fee could not be processed. App., *infra*, 1a-2a. On April 11, 2016, the Copyright Office received a collectable fee and commenced examining petitioner's application materials. See *id.* at 3a-4a.

3. a. While petitioner's application for registration remained pending, the district court dismissed the complaint without prejudice. Pet. App. 11a-14a. The court explained that, although Section 411(a)'s registration requirement "is no longer a jurisdictional requirement" for a copyright-infringement suit, "it is nonetheless a procedural bar to infringement claims." *Id.* at 12a. The court rejected petitioner's argument that having "an application to register * * * pending at the time of the suit" was "sufficient to survive a motion to dismiss." *Ibid.*

b. The court of appeals affirmed. Pet. App. 1a-10a. The court recognized that the question presented here has "split the circuits." *Id.* at 4a. The court explained that the Tenth Circuit "follows the 'registration' approach * * * , which requires a copyright owner to plead that the Register of Copyrights has acted on the application [for registration]—either by approving or denying it—before a copyright owner can file an infringement action." *Ibid.* (citing *La Resolana Architects, PA* v. *Clay Realtors Angel Fire*, 416 F.3d 1195, 1197 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier*, *supra*). On the other hand, the court ob-

served, the Fifth and Ninth Circuits "follow the 'application' approach, which requires a copyright owner to plead that he has filed 'the deposit, application, and fee required for registration,' 17 U.S.C. § 411(a), before filing a suit for infringement." *Ibid.* (citing *Cosmetic Ideas, Inc.* v. *IAC/Interactivecorp*, 606 F.3d 612, 619 (9th Cir.), cert. denied, 562 U.S. 1062 (2010); *Positive Black Talk Inc.* v. *Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), abrogated on other grounds by *Reed Elsevier, supra*).

The court of appeals noted that its own circuit precedent had previously endorsed the registration approach. Pet. App. 6a (citing *Kernel Records Oy* v. *Mosley*, 694 F.3d 1294 (11th Cir. 2012), cert. denied, 569 U.S. 919 (2013)). Petitioner argued that this Court's decision in *Reed Elsevier, supra*, holding that Section 411(a) does not establish a jurisdictional requirement, had "eroded the rationale for following the registration approach." Pet. App. 6a. The court reexamined the question, however, and reaffirmed its view that Section 411(a) bars a copyright owner from instituting an infringement action until the Register has either approved or refused registration. *Id.* at 6a-9a.

The court of appeals concluded that, under the Copyright Act, "'registration of a copyright ... has not been made in accordance with ... title 17' * * * until 'the Register ... registers the claim.'" Pet. App. 6a (quoting 17 U.S.C. 410(a), 411(a)) (alterations omitted). The court explained that "[t]he Copyright Act defines registration as a process that requires action by both the copyright owner and the Copyright Office." *Ibid.* Although the Act requires the owner to commence the registration process by submitting a deposit, application, and fee, it directs that Office to "examine[]" the

submissions and to "determine[]" whether the work is copyrightable before approving or refusing registration. *Ibid.* Under the Act's plain meaning, the court concluded, "[f]iling an application does not amount to registration." *Ibid.* The court rejected petitioner's arguments regarding "legislative history and policy" as insufficient to overcome that plain meaning. *Id.* at 9a.

4. In August 2017, after the court of appeals' mandate had issued, the Copyright Office notified petitioner that the Register had refused registration. App., *infra*, 3a-9a; cf. Pet. Reply Br. 2 n.1. Noting that petitioner had sought registration on the ground that its articles comprised a database, the Copyright Office explained that the registrability of a database, like that of a compilation, depends on whether the selection and arrangement of those elements qualifies as a work of authorship. App., *infra*, 7a. Among other grounds for rejection, the Office concluded that the selection and arrangement of petitioner's database, in which individual articles were arranged in chronological order, lacked sufficient originality to warrant registration. *Id.* at 7a-8a. The Office further noted that, because the check that petitioner had initially tendered with its application was uncollectable, the effective date of registration would have been April 11, 2016, when the proper fee was received. *Id.* at 3a-4a.

DISCUSSION

Section 411(a) of the Copyright Act provides that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with" Title 17, or (2) the required deposit, application, and fee have been "delivered to the Copyright Office in proper form" and "registration has been

refused." 17 U.S.C. 411(a). The court of appeals correctly affirmed the dismissal of petitioner's copyright-infringement suit because petitioner had filed its complaint before the Register of Copyrights had either approved or refused petitioner's application for registration. This Court's review is warranted, however, because the decision below implicates a longstanding circuit conflict on an important and recurring question of copyright law. The petition for a writ of certiorari therefore should be granted.

A. The Question Presented Is The Subject Of An Entrenched Circuit Conflict That Warrants Resolution By This Court

1. In construing Section 411(a), the Eleventh and Tenth Circuits have adopted the "registration approach," under which the Register must approve or refuse registration before a copyright owner may commence an infringement suit. See Pet. App. 1a-10a; *La Resolana Architects, PA* v. *Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010). The Fifth and Ninth Circuits, by contrast, have taken the "application approach" advocated by petitioner, under which "receipt by the Copyright Office of a complete application satisfies the registration requirement of § 411(a)." *Cosmetic Ideas, Inc.* v. *IAC/InteractiveCorp*, 606 F.3d 612, 621 (9th Cir.), cert. denied, 562 U.S. 1062 (2010); see *Positive Black Talk, Inc.* v. *Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), abrogated on other grounds by *Reed Elsevier*, *supra*; see also *Action Tapes, Inc.* v. *Mattson*, 462 F.3d 1010, 1013 (8th Cir. 2006) (indicating that delivery of deposit, application, and fee is necessary for suit, without specifying that it is alone sufficient). The existence of

that circuit split has been widely recognized by courts of appeals, see, *e.g.*, *Psihoyos* v. *John Wiley & Sons, Inc.*, 748 F.3d 120, 125 (2d Cir. 2014); *Alicea* v. *Machete Music*, 744 F.3d 773, 779 (1st Cir. 2014); *Brooks-Ngwenya* v. *Indianapolis Pub. Sch.*, 564 F.3d 804, 806 (7th Cir. 2009) (per curiam); *La Resolana*, 416 F.3d at 1201-1202, and the competing views have been analyzed at length by the two leading copyright treatises, compare 5 William F. Patry, *Patry on Copyright* § 17:78 (2017) (Patry) (advocating the registration approach), with 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][3] (2018) (proposing a variant of the application approach).

2. The question presented warrants this Court's review. The issue has arisen frequently in the lower courts, including in numerous reported court of appeals decisions over the past several years. See pp. 9-10, *supra*; Patry § 17:78 nn.10-12 (collecting decisions addressing the issue from every circuit). There is no realistic possibility that the circuit conflict will be eliminated without this Court's intervention. In the court of appeals, petitioner argued that the Court's decision in *Reed Elsevier* cast doubt on the Eleventh Circuit's prior analysis of the question. The court below rejected that argument, however, and we are aware of no court that has understood *Reed Elsevier* in the manner that petitioner advocates. See Patry § 17:78, at 17-232 & n.13.60 ("Courts have continued to reject the application approach after the Supreme Court's *Reed Elsevier* opinion.") (collecting cases).

3. This case is a suitable vehicle for resolving the question presented. The district court dismissed petitioner's suit based solely on petitioner's acknowledg-

ment that it had not obtained a registration determination from the Register of Copyrights. Pet. App. 11a-14a. The court of appeals affirmed on that basis alone. *Id.* at 22-6a.

Although the Register completed her examination process and refused petitioner's application for registration after the court of appeals issued its decision, see App., *infra*, 3a-9a; p. 8, *supra*, the case continues to present a live controversy. Section 411(a) specifies that a copyright owner may not "institute a civil action for infringement" until the statutory prerequisites have been satisfied. 17 U.S.C. 411(a). Under the registration approach adopted by the court of appeals, the district court was correct to dismiss the complaint without prejudice because petitioner had not secured a registration determination before filing the complaint. To be sure, under either of the competing views of Section 411(a), the Register's refusal of registration leaves petitioner free to commence a *new* copyright-infringement suit. The choice between those two interpretations, however, remains relevant to the determination whether petitioner's *current* suit can go forward.

The Register's decision also does not counsel against further review in this case as a prudential matter. The question presented here concerns the proper disposition of an infringement suit that is brought after the copyright owner has applied for registration, but before the Copyright Office has approved or rejected that application. Given the relative speed with which registration decisions are rendered compared to the pace of federal litigation, this Court likely could not resolve that question in any future case before the Copyright Office has acted on the relevant application for registration.

The fact that the Copyright Office initially could not process petitioner's fee (see App., *infra*, 1a-2a) likewise would not prevent this Court from resolving the circuit conflict. The question presented (Pet. i) is whether the owner's action of delivering the "required application, deposit, and fee to the Copyright Office" constitutes "registration of the copyright claim" within the meaning of Section 411(a). The district court and court of appeals decided the case on the assumption that, at the time the suit was commenced, petitioner had delivered those materials to the Copyright Office, but the Register had not yet approved or refused the application for registration. 17 U.S.C. 411(a). Because this case was resolved on a motion to dismiss, the district court was required to accept as true petitioner's allegations to that effect. Pet. App. 18a. This Court may review the court of appeals' decision on the same assumption.

B. Under Section 411(a), A Copyright-Infringement Suit May Not Be Filed Until The Register Of Copyrights Has Either Approved Or Refused Registration Of The Work

The text, structure, and history of the Copyright Act confirm that the Register must have acted on an application for copyright registration—either by approving or refusing registration—before the copyright owner may institute a copyright-infringement suit. Petitioner's contrary arguments are unavailing.

1. In construing Section 411(a), the Court should begin its "inquiry with the text, giving each word its ordinary, contemporary, common meaning," and should "look to the provisions of the whole law to determine [the section's] meaning." *Star Athletica, L.L.C.* v. *Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (citations and internal quotation marks omitted). Section 411(a)

states that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with this title," or (2) "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused." 17 U.S.C. 411(a). Although Section 411(a)'s requirements are not jurisdictional, the provision "imposes a precondition to filing a claim" of infringement. *Reed Elsevier*, 559 U.S. at 166. Several aspects of Section 411(a) itself, and of the larger statutory scheme, support the court of appeals' conclusion that "registration of [a] copyright claim has been made," 17 U.S.C. 411(a), only when the Register has approved an application.

a. The term "registration" in Section 411(a) is most naturally read to refer to the Copyright Office's official recording of an accepted copyright claim. Both at the time of Section 411(a)'s enactment and today, the term "registration" signified (and signifies) an authoritative act of "[r]ecording" or "inserting in an official register." *Black's Law Dictionary* 1449 (revised 4th ed. 1968); see *Webster's Third New International Dictionary* 1912 (1966) ("something registered" or "an entry in a register"); see also *Black's Law Dictionary* 1474 (10th ed. 2014) ("The act of recording or enrolling."). Where copyrighted works are involved, "registration" denotes the act of the eponymous Register of Copyrights in entering a claim of copyright into an official register. See *Compendium*, Glossary 14 ("Registration involves examining the claim, and if the claim is approved by the U.S. Copyright Office, numbering the claim, issuing a certificate of registration, and creating a public record.").

Section 411(a)'s requirement that "registration" have been "made in accordance with this title" reinforces this natural meaning. 17 U.S.C. 411(a). In order for a copyright to be registered, the owner of a copyrighted work must deliver a deposit, application, and fee to the Copyright Office. See 17 U.S.C. 408, 409. Registration "in accordance with" Title 17 occurs only "after examination" of those submissions by the Register, who then "determines" whether the submissions are "acceptable for registration." 17 U.S.C. 410(a) and (d). Only then does the Register "register the claim," by recording the work as copyrightable, and "issue to the applicant a certificate of registration under the seal of the Copyright Office." 17 U.S.C. 410(a); see 17 U.S.C. 411(b) (explaining that this "certification of registration satisfies the requirements of [Section 411(a)]"). Thus, in the ordinary case, "both the certificate and the original work must be on file with the Copyright Office before a copyright owner can sue for infringement." *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1977 (2014).

The second sentence of Section 411(a), which creates an exception to the registration requirement, underscores that conclusion. That sentence provides: "In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a). Thus, an applicant who has submitted a proper application package may file an infringement suit once the Register has issued a final decision refusing registration. That exception would be superfluous

if an applicant was entitled to commence suit as soon as he had submitted the required materials.

Petitioner reads (Pet. 19) Section 411(a)'s second sentence to mean that, although a copyright owner may initiate suit as soon as the required materials have been submitted, he must notify the Register about the suit if the Register refuses registration while the litigation is ongoing. But if Congress had intended that result, it could have required the copyright owner to provide notice to the Register in order to "maintain" or "continue with" the suit. Section 411(a)'s second sentence instead provides that, in circumstances where registration has been refused, "the applicant is entitled to *institute* a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a) (emphasis added). That language assumes that, in cases where the Register refuses registration, the requisite notice to the Register will be provided at the time suit is commenced.

Petitioner's approach would also subvert the congressional purpose that underlies Section 411(a)'s *third* sentence, which authorizes the Register to intervene in cases where registration is refused. See 17 U.S.C. 411(a) (authorizing the Register to "become a party to the action with respect to the issue of registrability of the copyright claim" when she has refused registration). The evident purpose of that provision is to ensure that the Register can explain to the court in the infringement suit why she concluded that the requirements for registration were not satisfied. That provision could not fully serve its intended purpose if the applicant could initiate suit, and the district court potentially could decide the case on the merits, before the

Register had either rendered her registration decision or received the mandated notice.

b. Other Copyright Act provisions reinforce the court of appeals' interpretation of Section 411(a)'s registration requirement. See, *e.g.*, *Mellouli* v. *Lynch*, 135 S. Ct. 1980, 1989 (2015) ("Statutes should be interpreted 'as a symmetrical and coherent regulatory scheme.'") (citation omitted); *Clark* v. *Rameker*, 134 S. Ct. 2242, 2248 (2014) ("[A] statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous.") (citation omitted).

The Copyright Act describes the copyright owner's submission of his deposit, application, and fee to the Copyright Office as an "application for registration." 17 U.S.C. 408(f)(3) (capitalization altered); see *Black's Law Dictionary* (1968), *supra*, at 127 (defining "application" as "[t]he act of making a request for something"). That language assumes that submission of the required materials is an action distinct from "registration" itself. Petitioner's approach is also inconsistent with Section 410(d), which specifies the effective date of a copyright registration. Under that provision, the "effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights * * * to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. 410(d). If "registration of [a] copyright claim" were "made" on the date those materials are submitted, 17 U.S.C. 411(a), there would be no need for the back-dating rule of Section 410(d).

Petitioner's approach would also render substantially meaningless the Copyright Act's "preregistration" regime for certain works. See 17 U.S.C. 408(f).

Preregistration is available for limited classes of unpublished commercial works (such as prerelease versions of mainstream films) that the Copyright Office determines have a history of infringement before commercial distribution. *Ibid.* After the Copyright Office conducts a truncated review based on a description of the unpublished work, see 17 U.S.C. 408(f)(2); 37 C.F.R. 202.16(b)(1) and (c), Section 411(a) permits the copyright owner to sue based on preregistration. The preregistration regime ensures that, for these limited classes of works, the time required for the Register to examine and register the work does not preclude the copyright owner from obtaining an effective judicial remedy. But if a copyright owner could file an infringement suit as soon as it had delivered the required deposit, application, and fee to the Copyright Office—*i.e.*, if the time required for the Register to examine and register a work would *never* delay the commencement of suit—there would be little need for the preregistration scheme.

c. The history of the Copyright Act likewise supports the court of appeals' interpretation of Section 411(a).

The Copyright Act of 1909 provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with." Act of Mar. 4, 1909, ch. 320, § 12, 35 Stat. 1078. Courts interpreted that language as requiring dismissal of any infringement suit that was filed before the owner had obtained a certificate of registration, even if the proper deposit had been made. See, *e.g.*, *Lumiere* v. *Pathe Exch., Inc.*, 275 F. 428, 430 (2d Cir. 1921) (affirming dismissal of suit

and explaining that, "[w]hen this bill was filed, two copies of each of the [copyrighted] photographs had been deposited, but the registration required by the act had not been obtained"); *Algonquin Music, Inc.* v. *Mills Music*, 93 F. Supp. 268, 268 (S.D.N.Y. 1950); *Rosedale* v. *News Syndicate Co.*, 39 F. Supp. 357, 357 (S.D.N.Y. 1941). The Second Circuit explained that the 1909 Act required compliance with statutory provisions governing "'registration of [the] work'" as well as with those governing "'deposit of copies,'" and that the court could "think of no other added condition for 'registration' but acceptance by the Register." *Vacheron & Constatin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637, 640-641 (1958) (Hand, J.) (citation omitted). Indeed, even after registration had been refused, a copyright owner was required to obtain a writ of mandamus compelling the Register to grant registration of its copyright before instituting an infringement suit. See *id.* at 639 ("Title 17 forbade any action for infringement of the copyright when the Register of Copyrights had refused * * * to accept [it]."); *id.* at 640 (discussing the use of mandamus in this context).

In 1976, Congress enacted Section 411(a) against the backdrop of this rule. See Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2583. By authorizing a copyright owner to "institute a civil action for infringement" when he has delivered "the deposit, application, and fee required for registration * * * and registration has been refused," Congress eliminated the need to obtain a writ of mandamus against the Register after such a refusal. 17 U.S.C. 411(a); see H.R. Rep. No. 1476, 94th Cong., 2d Sess. 157 (1976) (1976 House Report) ("The second and third sentences of section 411(a) would alter the present law as interpreted in *Vacheron*."). But the

legislative history does not suggest that Congress intended to allow commencement of an infringement suit while the plaintiff's application for copyright registration remains pending. To the contrary, the House Report for the 1976 Act explained that "[t]he first sentence of [S]ection 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted." 1976 House Report 157.

2. a. Petitioner contends (Pet. 17-20) that the term "registration" can refer either to the action of the Register in granting registration or to the action of the copyright owner in seeking registration. Petitioner argues (Pet. 18) that the phrase "registration ... has been made" in the first sentence of Section 411(a) refers solely "to the action of the copyright holder." In support of that contention, petitioner invokes (*ibid.*) the second sentence of Section 411(a), which authorizes a copyright owner who has been refused registration to institute an infringement suit. Petitioner contends (*ibid.*) that, if "registration" is "made" only when the Register approves an application, the second sentence of Section 411(a) would "contradict" the first. See *ibid.* ("[A] suit for infringement may be instituted even though registration had *not* been made.").

As explained above, Section 411(a)'s second sentence is best understood as creating an *exception* to the requirement that "registration" must be "made" before an infringement suit may be commenced. To be sure, Congress could have communicated more precisely the relationship between the provision's first two sentences. But the word "however" in the second sentence at least makes clear that Congress understood that sentence as a departure from, or qualification of, the rule announced

in the sentence that precedes it. Taken as a whole, Section 411(a) provides that a copyright owner may initiate infringement litigation if he has submitted a compliant application and the Register has acted on that application, either by granting or denying it. There is nothing substantively contradictory about that regime.

Under petitioner's approach, moreover, the term "registration" would have a quite different meaning in Section 411(a)'s second sentence than it has in the first. Petitioner construes (Pet. 18) that term in the first sentence to refer solely "to the action of the copyright holder." But the second sentence, which addresses cases in which "registration has been refused," clearly uses the term to refer to the Register's disposition of the application, not to the copyright owner's submission of it. "[I]dentical words and phrases within the same statute should normally be given the same meaning," *Hall* v. *United States*, 566 U.S. 506, 519 (2012) (citation omitted), and that common-sense understanding applies with particular force when the same word appears in consecutive sentences of a single statutory subsection.

b. Citing a handful of other Copyright Act provisions that contain some variant of the phrase "making registration" or "registration having been made," petitioner contends (Pet. 20) that those provisions are most naturally read to refer to action by the copyright owner. See Pet. 20-21 (citing 17 U.S.C. 408(c)(3) and (e), 411(c), 412(2)). But the court below did not suggest that the copyright owner's actions are divorced from the process by which copyright "registration" is "made." The court simply recognized that, even after the copyright owner has done his part, "registration" can be "made" only after the Register does hers.

Other Copyright Act provisions use the phrase "registration has been made" (or a close variant) to refer to circumstances in which the entire registration process, including the Copyright Office's disposition of the copyright owner's application to register his work, has been completed. The Act provides that recording the transfer of ownership of a copyrighted work with the Office gives the public "constructive notice" of ownership once "registration has been made for the work." 17 U.S.C. 205(c). In certain circumstances, a copyright infringer who began the infringement in good faith under a purported license from someone other than the copyright owner has a "complete defense" to infringement liability unless "registration for the work had been made in the name of the owner of copyright." 17 U.S.C. 406(a). These constructive-notice provisions assume that, once "registration has been made," a public record will have been created. That will be true if, but only if, "registration" is "made" when the Register approves an application and the Copyright Office enters the registration into its records catalog. See 17 U.S.C. 705; p. 3, *supra*.

c. Petitioner contends (Pet. 23-24) that, because the Act's exclusive rights, right to sue, and remedies are ultimately available whether the Register approves or refuses registration, "it makes little sense to place a copyright holder in months of 'legal limbo' while the examination of a registration application is completed." But while Section 411(a) allows a copyright owner to sue regardless of the Copyright Office's conclusion as to registrability, the court in adjudicating an infringement suit still can benefit from knowing what that conclusion is. And by deferring the initiation of suit until the Register has determined whether a work is registrable, the

Act provides a significant incentive for copyright owners to begin the registration process promptly after publication, rather than waiting until an infringement dispute arises.

Petitioner also expresses concern (Pet. 26) about the potential practical consequences of the court of appeals' construction of Section 411(a). Those consequences include the unavailability of injunctive relief until the Register has ruled on the application; the possible running of the statute of limitations; and the potential loss of evidence. But Congress has provided various means of mitigating these risks, while maintaining a strong incentive for prompt submission of applications to register copyrights. See, *e.g.*, 17 U.S.C. 408(f), 411(a) (conferring immediate right to sue after preregistration); 17 U.S.C. 411(c) (conferring immediate right to sue for infringement of live broadcasts); 17 U.S.C. 412 (permitting statutory damages and attorney's fees dating back to the filing of an application for registration); see also *Compendium* § 623.4 (permitting expedited consideration for registration of all works).

In any event, the text of Section 411(a), and of the Copyright Act as a whole, is the best indication of the balance between competing objectives that Congress sought to draw. Any adjustment of that balance is properly entrusted to Congress rather than to this Court.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

NOEL J. FRANCISCO
Solicitor General
CHAD A. READLER
Acting Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
JONATHAN Y. ELLIS
Assistant to the Solicitor General
MARK R. FREEMAN
DENNIS FAN
Attorneys

SARANG VIJAY DAMLE
General Counsel and Associate Register of Copyrights
REGAN A. SMITH
Deputy General Counsel
JASON E. SLOAN
Attorney Advisor
United States Copyright Office

MAY 2018

APPENDIX A

United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington DC 20559-6000 · www.copyright.gov

Apr. 4, 2016

William Brown
922 Honeytree Lane, Apt. A
Wellington, FL 33414

Correspondence ID: 1-1I3Z4PR

RE: Group Registration . . . "Fourth Estate Public Benefit Corporation News Articles" Published January 1, 2016 to February 29, 2016—updated hourly.

Dear Mr. Brown:

We received your application, deposit, and payment to register your copyright claim. We are writing because the check you sent in payment of the filing fee was rejected by your bank as an uncollectible item.

If you wish register this claim, you must provide a new filing **fee.** In **addition,** the Office charges **$30.00** to service an uncollectible check. The full amount due is **$115.00.** You may send a check or money order with the accompanying reply sheet. Alternatively, you may pay the amount by credit card. See instructions on the reply sheet.

It is recommended that you respond as quickly as possible to establish an early effective date of registration. The effective date of registration for claims to copyright is established upon receipt of an application, deposit, **and valid filing fee.**

If we have not received your payment or credit card information within **45 days** of the date of this letter, we will cancel your registration. After that time, in order to register, you will have to file an entirely new claim, consisting of an application, deposit, and valid filing fee. If you have questions, please call 202-707-8443.

Sincerely,

Accounts Section
Receipt Analysis & Control Division
202-707-8443

Enclosure:
Copy of remittance
Reply Sheet
SL-4

APPENDIX B

United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington DC 20559-6000 · www.copyright.gov

Aug. 04, 2017

William Brown
922 Honeytree Lane, Apt A
Wellington, FL 33414

Correspondence ID: 1-2M4Y45H

RE: *Group registration of an automated database entitled "Fourth Estate Public Benefit Corporation News Articles", published January 1, 2016 to February 29, 2016—updated hourly* (1-3223995975)

Dear William Brown:

We are writing to refuse registration for *Group registration of an automated database entitled "Fourth Estate Public Benefit Corporation News Articles", published January 1, 2016 to February 29, 2016—updated hourly* ("the work") because this submission does not meet the legal or formal requirements for registration under the group database option or any other application option currently available.

Procedural History

Fourth Estate Public Benefit Corporation ("Fourth Estate") submitted this application, which was received on or about March 7, 2016. Due to Fourth Estate's

initial submission of an uncollectable check, the $85.00 filing fee was not received until April 11, 2016.

The receipt of a completed application, the appropriate fee, and an acceptable deposit can establish an effective date of registration (EDR) for purposes of title 17, section 410(d). But the establishment of that date is contingent on the issuance of a certificate of registration following the requisite examination for copyrightability and the legal and formal requirements of title 17, section 410(a). If the Office refuses registration, after determining compliance with the requirements of section 410(a), a court of competent jurisdiction may later find the work to be copyrightable and rely on the filing date as the EDR for purposes of title 17, section 412. 17 USC § 410(d).

In this case, not only did the uncollectable check delay the examination of this work and remove the claim from the U.S. Copyright Office's ordinary workflow, it also changed what would have been the effective date of registration, if the claim were ultimately registered, to the date when the proper fee was received by the Office.

Discussion

You have submitted multiple articles for registration with this application. As a general rule, a registration covers an individual work, and an applicant must submit a separate application, filing fee, and deposit copy for each work that is submitted for registration. In some cases, an applicant may register several works together on one application if one of the following limited exceptions applies: registering multiple works as a collective work, as an unpublished collection, as a "unit of

publication," or using one of several group registration options. For an in-depth discussion on the options for registering multiple works, see *Compendium of U.S. Copyright Office Practices*, Third Edition Chapter 1100.

In this case, it appears you have submitted these works for registration under the group database option. For purposes of copyright registration, a database is defined as a compilation of digital information comprised of data, information, abstracts, images, maps, music, sound recordings, video, other digitized material, or references to a particular subject or subjects. In all cases, the content of a database must be arranged in a systematic manner, and it must be accessed solely by means of an integrated information retrieval program or system with the following characteristics:

- A query function must be the sole means of accessing the contents of the database.
- The information retrieval program or system must yield a subset of the content, or it must organize the content based on the parameters specified in each query.

When seeking registration for a database or group registration of periodic revisions to a database, the applicant must deposit identifying portions of the updated content, with 50 representative pages marked to disclose the new material added on one representative publication date, along with a copy of the copyright notice (if any). In addition, an application for a group registration must include a descriptive statement containing specific information identified in the Office's regulations. *See* 37 CFR § 202.20(c)(2)(vii)(D).

For registration purposes, a database must be a copyrightable compilation, which is defined in the statute as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 USC 101 (definition of "compilation"). A database containing component works is considered a collective work, which is defined in the statute as a type of compilation. 17 USC 101 (definition of "collective work"), ("The term compilation includes collective works.") As such, the principal question in an application for registration of a database or group registration of periodic revisions to a database is whether there is sufficient creative selection, coordination, and/or arrangement of the elements to qualify as an original work of authorship. A database containing component works must demonstrate creative selection, coordination, and/or arrangement of the component works to be registrable as a copyrightable database. The copyrightability of component elements contained within a database will not suffice to demonstrate that a database is copyrightable or that multiple elements or works may be registered together in one application. Where sufficient creativity in the selection, coordination, and/or arrangement of elements is not demonstrated in the deposit material, the application for registration must be refused.

In this regard, the group database registration option is different from the Office's other group registration options. When the Office issues a registration for a group of published photographs or contributions to periodicals, the registration covers each individual on a separate basis and the group as a whole is not consid-

ered a compilation, a collective work, or a derivative work. 37 CFR 202.4(m); *Compendium* § 1104.4.

By contrast, the group database option covers new derivative versions of the selection, coordination, or arrangement of elements within the database. In essence, each update with the group is registered as a derivative compilation and/or derivative collective work. *Compendium* § 1104.4.

The critical copyrightable element in a compilation or collective work is not the copyrightability of individual elements, but rather the sufficiency of creative authorship in the selection, coordination, and/or arrangement of elements or works, such that the work as a whole qualifies as an original work of authorship in accordance with the principles of the statute and the decision in *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

The works you seek to register are multiple, separately published textual contributions. Although the application does not provide a year of completion or a date of first publication, the title space states that the contributions were published from January 1, 2015 through February 29, 2016 and that updates occur "hourly." The application describes the nature of authorship as "new matter: new text & revisions" and states that the work was not previously registered. The deposit material consists of separate articles, with publication dates ranging from January 1, 2016 through January 4, 2016.

The individual news articles submitted as the deposit material were submitted separately, and were selected and arranged in a manner that utterly lacks originality: in chronological order. As submitted, these articles

do not reveal any selection, coordination, and/or arrangement to support a claim to copyright in a compilation. Further, the registration materials do not demonstrate that these individual articles are even a part of a database. Instead, the articles appear to be from a news website. The *Compendium of U.S. Copyright Office Practices* clarifies the significant distinction between databases and websites for registration purposes. *Compendium* § 1002.6. Finally, Fourth Estate's application claims only in new text and revisions, and does not include a claim in selection, coordination, and/or arrangement. Therefore, as there is no original selection, coordination, and/or arrangement authorship evident in the registration materials, this submission is not eligible for registration under the group database and registration, as a compilation generally, or as a collective work. As a result, this claim must be refused.

In addition to the reasons discussed above, it is important to note that this application is deficient in meeting the formal requirements of the group database option in a number of other ways. Namely, Fourth Estate has not submitted the required Descriptive Statement; the application does not provide a representative publication date; and it lacks a limitation of the claim statement that would be necessary in relation to the application's references to "new matter" and "revised text" in the authorship statement. Were these the only defects in the application for registration, the application could be cured through correspondence and a submission of the omitted required information. However, in light of the inability for the work to qualify under the group database option, and the fact that the work does not qualify as a compilation or collective work, an at-

tempt to cure the application as submitted would be futile.

In order to register the articles contained within this claim, separate applications for each article must be submitted to the Copyright Office together with the proper application and proper fee. If the Office receives all of the required elements in proper form, it will examine the applications and the deposits to determine whether the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of title 17 have been met. If there is a need for expedited examination of such new applications, you may request special handling during the electronic application process or in writing with a paper application, explaining the basis for your need for expedited examination, together with payment of the required fee for this service.

This letter is for your information only. No reply is required. Should you choose to request administrative reconsideration of this decision, please follow the instructions on the enclosed reply sheet.

Sincerely,

Elizabeth Stringer
Supervisor
Literary Division
U.S. Copyright Office

Enclosures:
Reply Sheet

No. 17-571

IN THE
Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURDEN,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

BRIEF FOR PETITIONER

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN INTELLECTUAL PROPERTY LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
GRACE W. KNOFCZYNSKI
KELLOGG, HANSEN, TODD, FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

August 27, 2018

QUESTION PRESENTED

Section 411(a) of the Copyright Act provides (with qualifications) that "no civil action for infringement of [a] copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). The question presented is:

Whether "registration of [a] copyright claim has been made" within the meaning of § 411(a) when the copyright holder delivers the required application, deposit, and fee to the Copyright Office, as the Fifth and Ninth Circuits have held, or only once the Copyright Office acts on that application, as the Tenth Circuit and, in the decision below, the Eleventh Circuit have held.

PARTIES TO THE PROCEEDINGS

Petitioner Fourth Estate Public Benefit Corporation was the plaintiff and the appellant in the proceedings below.

Respondents Wall-Street.com, LLC and Jerrold D. Burden were the defendants and the appellees in the proceedings below.

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, petitioner Fourth Estate Public Benefit Corporation states that it is a public benefit corporation that has not issued any stock.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

PARTIES TO THE PROCEEDINGS ii

RULE 29.6 STATEMENT iii

TABLE OF AUTHORITIES vi

INTRODUCTION 1

OPINIONS BELOW 3

JURISDICTION 3

STATUTORY PROVISIONS INVOLVED 3

STATEMENT 3

A. Statutory Background 3

B. Factual Background 15

C. Proceedings Below 16

SUMMARY OF ARGUMENT 18

ARGUMENT 21

I. THE STATUTORY TEXT MAKES CLEAR THAT THE COPYRIGHT OWNER MAKES REGISTRATION FOR PURPOSES OF § 411(a) BY COMPLYING WITH THE STATUTE'S REQUIREMENTS 21

A. The Statute Employs the Phrase "Make Registration" and Its Variants To Refer to the Actions of the Copyright Owner 21

B. The Portion of § 411(a) Addressing the Consequences of Refusal of Registration Further Supports the Conclusion That "Registration . . . Has Been Made" Refers to the Action of the Copyright Owner 29

II. THE HISTORY OF § 411(a) FURTHER DEMONSTRATES THAT A COPYRIGHT OWNER MAY INSTITUTE A CIVIL ACTION FOR INFRINGEMENT ONCE STATUTORY REQUIREMENTS ARE COMPLIED WITH 32

III. THE STATUTORY SCHEME OF RIGHTS AND REMEDIES FAVORS ALLOWING SUITS TO PROCEED ONCE THE COPYRIGHT OWNER HAS COMPLIED WITH REQUIRED FORMALITIES 36

CONCLUSION 43

TABLE OF AUTHORITIES

Page

CASES

Almendarez-Torres v. United States, 523 U.S. 224 (1998) 27

American Broad. Co. v. Aereo, Inc., 134 S. Ct. 2498 (2014) 20, 32, 34, 35

Barber v. Thomas, 560 U.S. 474 (2010) 28

CBOCS W., Inc. v. Humphries, 553 U.S. 442 (2008) 34

Cosmetic Ideas, Inc. v. IAC/Interactivecorp., 606 F.3d 612 (9th Cir. 2010) 41

Dollar Sav. Bank v. United States, 86 U.S. (19 Wall.) 227 (1874) 30

Dowling v. United States, 473 U.S. 207 (1985)..... 37

Exxon Mobil Corp. v. Allapattah Servs., Inc., 545 U.S. 546 (2005) 36

FDA v. Brown & Williamson Tobacco Corp., 529 U.S. 120 (2000) 36

Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) 34

Feltner v. Columbia Pictures Television, Inc., 523 U.S. 340 (1998) 19, 23, 28

Golan v. Holder, 565 U.S. 302 (2012)..... 10, 22, 29, 38

Harper & Row, Publ'ers, Inc. v. Nation Enters., 471 U.S. 539 (1985) 3, 22, 37, 38

Kirtsaeng v. John Wiley & Sons, Inc., 568 U.S. 519 (2013) 18

La Resolana Architects, PA v. Clay Realtors Angel Fire, 416 F.3d 1195 (10th Cir. 2005) 39

Liteky v. United States, 510 U.S. 540 (1994) 30

Lumiere v. Pathe Exch., Inc., 275 F. 428 (2d Cir. 1921) 7, 8

Microsoft Corp. v. i4i Ltd. P'ship, 564 U.S. 91 (2011) 40

Powerex Corp. v. Reliant Energy Servs., Inc., 551 U.S. 224 (2007) 22, 23

Reed Elsevier, Inc. v. Muchnick, 559 U.S. 154 (2010) 11, 22, 29, 34, 38

Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970) 8, 33

Star Athletica, L.L.C. v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017) 21

Syntek Semiconductor Co. v. Microchip Tech. Inc., 307 F.3d 775 (9th Cir. 2002) 41

Taniguchi v. Kan Pac. Saipan, Ltd., 566 U.S. 560 (2012) 29

Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co., 260 F.2d 637 (2d Cir. 1958), ... 7, 8, 29-30, 33, 34, 35, 38

Washingtonian Publ'g Co. v. Pearson, 306 U.S. 30 (1939) 2, 5, 6, 7, 20, 37, 38

Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834)..... 4

White-Smith Music Publ'g Co. v. Goff, 187 F. 247 (1st Cir. 1911) 7, 33

STATUTES AND REGULATIONS

Act of May 31, 1790, ch. 15, 1 Stat. 124 4

§ 3, 1 Stat. 125 4

§ 4, 1 Stat. 125 4

Act of Apr. 29, 1802, ch. 36, § 1, 2 Stat. 171, 171 4

Artists' Rights and Theft Prevention Act of 2005, Pub. L. No. 109-9, tit. I, § 104(b), 119 Stat. 218, 222 10

Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 9(b)(1), 102 Stat. 2853, 2859 10

Copyright Act of 1909, ch. 320, 35 Stat. 1075 ..... 5, 6, 8, 26, 32

§ 13, 35 Stat. 1078 26

Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 ..... 5, 7, 8, 18, 20, 23, 26, 27, 29, 32, 34

§ 101:

90 Stat. 2583 ..... 10, 23

90 Stat. 2593 27

§ 110, 90 Stat. 2600, *reprinted in* 17 U.S.C. § 407 note 26

Copyright Act (17 U.S.C.) ..... *passim*

17 U.S.C. § 2 (1970) 5

17 U.S.C. § 10 (1970) 5

17 U.S.C. § 11 (1970) 5

17 U.S.C. § 12 (1970) 5

17 U.S.C. § 13 (1970) 5, 7, 8, 20, 32, 33, 34

17 U.S.C. § 14 (1970) 26
17 U.S.C. § 102(a) 2, 3, 37, 41
17 U.S.C. § 106 3
17 U.S.C. § 205(a) 27
17 U.S.C. § 205(c) 25, 26
17 U.S.C. § 405(b) 25
17 U.S.C. § 406(a) 25
17 U.S.C. § 406(a)(1) 25
17 U.S.C. § 407 9
17 U.S.C. § 407(d) 7
17 U.S.C. § 408 ..... 1, 9, 22, 25
17 U.S.C. § 408(a) 1, 2, 9, 17, 20, 25, 27
17 U.S.C. § 408(b) 9
17 U.S.C. § 408(c) 19
17 U.S.C. § 408(c)(3) 24
17 U.S.C. § 408(e) 19, 42
17 U.S.C. § 409 ..... 9, 25, 26
17 U.S.C. § 410 25
17 U.S.C. § 410(a) 1, 9, 17, 19, 28
17 U.S.C. § 410(b) 9, 17, 28
17 U.S.C. § 410(c) 11, 39, 40
17 U.S.C. § 410(d) 2, 9, 17, 21, 25, 38
17 U.S.C. § 411 ..... 1, 21
17 U.S.C. § 411(a) 1, 2, 9, 10, 16, 18, 19, 20, 21, 22, 23, 27, 29, 31, 32, 36, 37, 40

17 U.S.C. § 411(b) 18, 23

17 U.S.C. § 411(c) 18, 22, 24

17 U.S.C. § 411(c)(2) 19, 22

17 U.S.C. § 412 ..... 1, 11, 19, 23, 26, 38

17 U.S.C. § 412(2) 11, 19, 23, 24

17 U.S.C. § 504 24

17 U.S.C. § 505 24

17 U.S.C. § 508(a) 39

17 U.S.C. § 708 28

17 U.S.C. § 708(a) 27

17 U.S.C. § 708(a)(1) 27

17 U.S.C. § 708(a)(2) 27

Copyright Renewal Act of 1992, Pub. L. No. 102-307, tit. I, § 102(b)(2), 106 Stat. 264, 266 29

Digital Millennium Copyright Act, Pub. L. No. 105-304, § 102(d), 112 Stat. 2860, 2863 (1998) 10

Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. No. 110-403, § 101(a), 122 Stat. 4256, 4257 10

28 U.S.C. § 1254(1) 3

28 U.S.C. § 1367 36

37 C.F.R.:

§ 202.5 9

§ 202.16(b) 43

LEGISLATIVE MATERIALS

H.R. Rep. No. 90-83 (1967) 31

H.R. Rep. No. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659 ..... 23, 24, 31, 33

Statement of Maria A. Pallante, U.S. Register of Copyrights, Before the Subcommittee on Legislative Branch Appropriations, U.S. Senate, Fiscal 2016 Budget Request (Mar. 17, 2015), *available at* https://www.appropriations.senate.gov/imo/media/doc/hearings/031715%20LOC%20Register%20of%20Copyrights%20Testimony%20-%20Leg Branch.pdf 11-12, 16

ADMINISTRATIVE MATERIALS

Comments of Science Fiction and Fantasy Writers of America, Inc., et al., *Group Registration of Unpublished Works*, Copyright Office Docket No. 2017-15 (filed Nov. 13, 2017), *available at* https://www.regulations.gov/document?D=COLC-2017-0009-0076 12

Comments of the National Press Photographers Ass'n, *Copyright Office Fees*, Copyright Office Docket No. 2012-1 (filed May 14, 2012), *available at* https://www.copyright.gov/docs/newfees/comments/05142012/ 12-13

Copyright Office Fees, 83 Fed. Reg. 24,054 (May 24, 2018) 15

Joint Comments of American Society of Media Photographers and Professional Photographers of America, *Copyright Office Fees*, Copyright Office Docket No. 2012-1 (filed May 14, 2012), *available at* https://www.copyright.gov/docs/newfees/comments/05142012/ 13

Policy Decision: Revised Special Handling Procedures, 56 Fed. Reg. 37,528 (Aug. 7, 1991) 14

Policy Decision Announcing Fee for Special Handling of Applications for Copyright Registration, 47 Fed. Reg. 19,254 (May 4, 1982) 14

Registration Nos. (searchable at https://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?DB=local&PAGE=First):

TX0006595981 (Apr. 30, 2007) 16

TX0006595982 (Apr. 30, 2007) 16

TX0006596887 (June 25, 2007) 16

U.S. Copyright Office:

Annual Report of the Register of Copyrights (2009), *available at* https://www.copyright.gov/reports/annual/2009/ar2009.pdf 12

Annual Report of the Register of Copyrights (2011), *available at* https://www.copyright.gov/reports/annual/2011/ar2011.pdf 12

Compendium of U.S. Copyright Office Practices (3d ed. 2017), https://www.copyright.gov/comp3/docs/compendium.pdf 14

Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law (Comm. Print 1961), *available at* https://www.copyright.gov/history/other_reports.html 35

Copyright Law Revision – Part 6: Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill (Comm. Print 1965), *available at* https://babel.hathitrust.org/cgi/pt?id=mdp.39015030337722;view=1up;seq=151 ..... 23, 35

Fiscal 2017 Annual Report (2017), *available at* https://www.copyright.gov/reports/annual/2017/ar2017.pdf 12, 13

Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (Aug. 1958), *reprinted in Copyright Law Revision: Studies Prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary*, 86th Cong. (Comm. Print 1960), *available at* https://www.copyright.gov/history/studies/ 4

"Preregister Your Work," https://www.copyright.gov/prereg/ (last visited Aug. 23, 2018) 42

"Registration Processing Times," https://www.copyright.gov/registration/docs/processing-times-faqs.pdf 12

OTHER MATERIALS

Robert Brauneis, *Properly Funding the Copyright Office: The Case for Significantly Differentiated Fees*, GW Law School Public Law and Legal Theory Paper No. 2017-58 (2017), *available at* https://ssrn.com/abstract=2997192 ..... 13, 14

Copyright Alliance, "Copyright Registration," https://copyrightalliance.org/ca_faq_post/can-you-please-explain-why-the-timeline-for-receiving-a-certificate-of-registration-has-gone-from-three-months-to-eight-months/ (last visited Aug. 21, 2018) 13-14

Arthur Fisher, U.S. Register of Copyrights, "The Copyright Office and the Examination of Claims to Copyright," *in 1953 Copyright Problems Analyzed* 11 (Theodore R. Kupferman ed.) 42-43

2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2013) 36, 40, 41

INTRODUCTION

The Copyright Act requires, before a civil action for infringement is brought, that "registration of the copyright claim . . . be[] made in accordance with this title." 17 U.S.C. § 411(a). Read together with the statute as a whole, that language is best understood to mean that, before bringing suit, the copyright owner must comply with the statutory formalities required for registration – that is, the owner must "deliver[] to the Copyright Office the deposit [of copies of the work] specified" in § 408, "together with the application and fee specified by sections 409 and 708." *Id.* § 408(a). It does not require the completion of the potentially far longer process – frequently taking months or years – through which the Register of Copyrights, "after examination, . . . determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met," and thus "register[s] the claim." *Id.* § 410(a).

The Copyright Act, including in the provisions most directly addressing the significance of registration in litigation, consistently employs the phrase "make registration" and its passive-voice counterparts such as "registration has been made" to refer to *the copyright owner's* compliance with the statutory registration requirement, not the determination by the Copyright Office that all formalities have been satisfied. That is true of other subsections of § 411 itself, and of a related provision – § 412 – that requires copyright owners to make registration within three months of first publication of a work as a condition of obtaining statutory damages and attorney's fees.

Just as important, petitioner's construction comports with the statute's rejection of formalities – which all prior federal statutes had required to some degree – as a condition of statutory copyright protection. The Act grants a copyright owner exclusive rights in a work as soon as it is fixed in a tangible medium of expression, *see id.* § 102(a), and "registration is not a condition of copyright protection," *id.* § 408(a). To be sure, before a copyright owner can sue to enforce those rights, the copyright owner must register the claim with the Copyright Office. But once the copyright owner has submitted the required application, deposit, and fee, that requirement is vindicated. That is confirmed by the fact that, in cases where the Register refuses to register the claim, the copyright owner may sue nevertheless; it is likewise confirmed by the fact that the statute, in § 410(d), gives courts the power to determine, in the first instance, whether the copyright owner complied with the statutory prerequisites for registration.

A contrary reading of § 411(a) would make the Register a gatekeeper to the courthouse, allowing bureaucratic delays concerning such matters as classification to prevent a copyright owner from promptly enjoining infringement that may significantly undermine the value of its property. As this Court has noted, "[w]ithout right of vindication a copyright is valueless." *Washingtonian Publ'g Co. v. Pearson*, 306 U.S. 30, 40 (1939). There is nothing in the structure or history of the Copyright Act to suggest that the Register's determination – or, in this case, the 16-month-long absence of any such determination – should be given such out-sized importance in the statutory scheme.

OPINIONS BELOW

The opinion of the court of appeals (App. 1a-10a) is reported at 856 F.3d 1338. The order of the district court granting respondents' motion to dismiss (App. 11a-14a) is not reported (but is available at 2016 WL 9045625).

JURISDICTION

The court of appeals entered its judgment on May 18, 2017. On August 7, 2017, Justice Thomas extended the time for filing a certiorari petition to and including October 13, 2017, App. 36a; the petition was filed on that date and granted on June 28, 2018, 138 S. Ct. 2707. The jurisdiction of this Court rests on 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Relevant provisions of the Copyright Act (17 U.S.C.) are reproduced at App. 23a-35a.

STATEMENT

A. Statutory Background

The Copyright Act protects "original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated." 17 U.S.C. § 102(a). As soon as a work is created, the copyright owner holds exclusive rights "to do and to authorize" others to do certain things with the work. *Id.* § 106; *see Harper & Row, Publ'ers, Inc. v. Nation Enters.*, 471 U.S. 539, 546-47 (1985). Accordingly, unlike useful inventions – which are protected by exclusive rights only after a patent application has been approved by the Patent and Trademark Office and a patent issued – original works of authorship are protected by virtue of their creation, not by an administrative agency's affirmative grant.

1. The Copyright Act also contains provisions for registration of copyrights. The statutory registration requirement dates to the original copyright statute, but its nature has changed substantially over time. *See generally* Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (Aug. 1958) ("Kaplan, *Registration*") (reviewing history).[1] The first copyright statute, adopted by the First Congress in 1790, made registration a prerequisite for any statutory right. *See Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 662 (1834). Copyright protection extended to domestic "map[s], chart[s], [and] book[s]"; and "no person" would be entitled to the protection "unless he shall before publication deposit a printed copy of the title . . . in the clerk's office of the district court." Act of May 31, 1790, ch. 15, § 3, 1 Stat. 124, 125. The clerk was "directed and required to record the same forthwith." *Id.* The "author or proprietor" was also required to publish a copy of the district court record in a newspaper "for the space of four weeks." *Id.* After publication, it was required that a copy of the work be delivered to the Secretary of State, "to be preserved." *Id.* § 4. In 1802, Congress added a provision requiring publication of copyright notice in the work itself. Act of Apr. 29, 1802, ch. 36, § 1, 2 Stat. 171, 171.

Although the details changed, these basic requirements – publications with notice, registration, and deposit – remained in place for more than a century. *See* Kaplan, *Registration* at 15 ("[T]he old pattern

---

[1] *Reprinted in Copyright Law Revision: Studies Prepared for the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary*, 86th Cong. (Comm. Print 1960), *available at* https://www.copyright.gov/history/studies/.

was unbroken: securing copyright depended on compliance, and exact compliance, with formalities – notice, registration, and deposit."); *Washingtonian Publ'g*, 306 U.S. at 37.

2. The Copyright Act of 1909 ("1909 Act") – which remained in force (with amendments) until the current Copyright Act of 1976 ("1976 Act") came into effect – abolished the requirement of registration as a condition of copyright. Instead, the statute (1) provided that, in the case of unpublished works, the author could enforce common-law rights (under state, not federal, law), *see* 17 U.S.C. § 2 (1970); (2) established that statutory copyright in published works could be secured "by publication thereof with the notice of copyright required by this title," *id.* § 10; and (3) allowed statutory copyright to be obtained for works, "of which copies are not reproduced for sale," by deposit of the work, *id.* § 12. Registration could still be obtained for published works, by "complying with the provisions" of the statute, including the requirement for "deposit of copies" as set forth in § 13. *Id.* § 11. In the case of works published with notice of copyright, furthermore, the statute required that two copies of the work be "promptly deposited" in the Copyright Office. *Id.* § 13. Although the 1909 Act (unlike prior legislation) did not require registration as a condition of copyright, it did provide that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with." *Id.*

Two interpretative issues arose concerning the deposit and registration requirements contained in § 13. The first was whether a copyright owner's

failure to deposit copies *promptly* could bar an action for infringement. In *Washingtonian Publishing*, this Court answered that question in the negative. In that case, the petitioner had published an issue of a monthly magazine with the required copyright notice; 14 months later, copies were first deposited and a certificate of registration issued. 306 U.S. at 33-34. The defendant argued that failure to make prompt deposit defeated the copyright owner's right to bring an action "because of infringement prior in date to a tardy deposit." *Id.* at 35-36.

This Court disagreed. It noted that the 1909 Act "was intended definitely to grant valuable, enforceable rights to authors, publishers, etc., without burdensome requirements." *Id.* at 36. Although "[u]nder the old Act deposit of the work was essential to the existence of copyright," that "requirement caused serious difficulties and unfortunate losses." *Id.* at 37. The new statute therefore made publication with notice all that was necessary to secure a copyright in a published work. Although the statute also required prompt deposit, allowing failure to comply with that requirement to defeat the copyright owner's cause of action "would not square with the words actually used in the statute, would cause conflict with its general purpose, and in practice produce unfortunate consequences." *Id.* at 39. "Petitioner's claim of copyright came to fruition immediately upon publication. Without further notice it was good against all the world. Its value depended upon the possibility of enforcement." *Id.*[2]

---

[2] The Court noted if the Register "finds undue delay" he could "require deposit of copies"; failure to comply would subject the copyright owner to a fine, a penalty "adequate . . . to enforce

A second question arose as to whether a copyright owner could bring suit if the copyright owner had complied with the requirements of § 13 but the Register had not granted registration. The first court to address this issue said yes: in *White-Smith Music Publishing Co. v. Goff*, 187 F. 247 (1st Cir. 1911), the plaintiff (a music publisher) claimed a statutory extension of copyright, applied for registration, and was refused. The court, while ruling against the plaintiff on the merits, held that it could sue because "it fully complied with the requirements of law, and is entitled to maintain this suit if it had any statutory right to the extension." *Id.* at 247.

A subsequent decision of the Second Circuit, however, suggested a different view. In that case, the plaintiff published photographs and obtained certificates of registration, but "[t]he trouble [wa]s that the certificates of registration [we]re for photographs not to be reproduced for sale, no date of publication being stated." *Lumiere v. Pathe Exch., Inc.*, 275 F. 428, 430 (2d Cir. 1921). The court held that, because "[d]eposit of copies and registration is each a condition precedent of the right to maintain an action for infringement," the suit had to be dismissed without prejudice. *Id.*

These conflicting views persisted until the 1976 Act was adopted. In *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958), the question was whether the plaintiff, which had sought copyright registration for a watch-

---

contributions of desirable books to the Library [of Congress]." *Washingtonian Publ'g*, 306 U.S. at 40-41; *cf.* 17 U.S.C. § 407(d) (maintaining fines for failure to comply with current deposit requirements); *infra* note 4.

face design, could sue despite the refusal of registration by the Register. A divided Second Circuit, in an opinion by Judge Learned Hand (who had been the district judge in *Lumiere*), said no: the court held that the 1909 Copyright Act "forbade any action for infringement of the copyright when the Register of Copyrights had refused" registration. *Id.* at 639. Instead, the copyright owner would first have to seek mandamus to correct the allegedly unlawful refusal to grant registration. *Id.* at 640.[3] By contrast, in *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970), the court reached the opposite conclusion, finding that, when "plaintiff placed the revised applications in the mail on July 27, 1966, it had done everything required of it under the copyright law with respect to the deposit of copies and registration and could therefore, on that day 'maintain' that action." *Id.* at 1108-09.

3. In the 1976 Act, Congress retained provisions for registration, while making clear that the copyright owner's compliance with the registration requirement – not the grant of registration by the Register – is what is required to initiate a suit for infringement.

The copyright owner "may obtain registration of the copyright claim" by depositing a copy (or, in the

---

[3] Judge Clark dissented. He found that § 13 "[q]uite obviously . . . puts the condition of complying with the law, including the deposit of copies, upon the copyright owner before he sues." *Vacheron*, 260 F.2d at 645 (Clark, C.J., dissenting). He rejected the proposition that the plaintiff would have to wait until the Register "performed his statutory duties" to sue, noting that to "read this serious prohibition into the single word 'registration'" was "belied by both the immediate context and the general statutory scheme of copyright." *Id.*

case of published works, two copies) of the work, along with "the prescribed application and fee" with the Copyright Office. 17 U.S.C. § 408(a), (b); *see also id.* § 409 (describing required elements of the application).[4]

The Register of Copyrights is required to conduct an examination, and, if the Register determines that "the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met," the Register "shall register" the claim and issue a "certificate of registration." *Id.* § 410(a). The "effective date of a copyright registration" is not the date of issuance of the certificate but is instead "the day on which an application, deposit, and fee, which are later determined . . . to be acceptable for registration, have all been received in the Copyright Office." *Id.* § 410(d).

If, on the other hand, the Register determines that "the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason," the Register "shall refuse registration" and notify the applicant of the reasons for refusal. *Id.* § 410(b).[5]

The new statute also maintains the requirement that a copyright owner seek registration before filing suit for infringement. Section 411(a) provides that

---

[4] The statute also retained a requirement for the deposit of published works for the Library of Congress. *See* 17 U.S.C. § 407. The copies so deposited "may be used to satisfy the deposit provisions" of § 408. *Id.* § 408(b).

[5] Copyright Office regulations provide for internal administrative review of an examiner's decision to refuse registration – a procedure referred to as "reconsideration." *See* 37 C.F.R. § 202.5.

"no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." *Id.* § 411(a).[6] The statute makes clear, however, that, whether registration is granted or refused, the copyright owner may initiate suit as long as "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form." *Id.* In any case where "registration has been refused," the plaintiff is required to serve a notice of the suit, "with a copy of the complaint," on the Register of Copyrights. *Id.* Once the Register is served, she has 60 days to intervene "with respect to the issue of registrability of the copyright claim." *Id.* The litigation may proceed irrespective of the Register's participation. *See id.*

A certificate of registration obtained before or promptly after publication confers certain litigation

---

[6] As adopted in 1976, this provision read "no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title." Pub. L. No. 94-553, § 101, 90 Stat. 2541, 2583. The limitation to United States works was added as part of the Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 9(b)(1), 102 Stat. 2853, 2859. *See also* Digital Millennium Copyright Act, Pub. L. No. 105-304, § 102(d), 112 Stat. 2860, 2863 (1998) (modifying language); *see generally Golan v. Holder*, 565 U.S. 302, 306-14 (2012). The statutory provisions governing preregistration, and the reference to preregistration in § 411(a), were added in 2005. *See* Artists' Rights and Theft Prevention Act of 2005, Pub. L. No. 109-9, tit. I, § 104(b), 119 Stat. 218, 222. The limitation to "civil" actions was added in 2008. *See* Prioritizing Resources and Organization for Intellectual Property Act of 2008, Pub. L. No. 110-403, § 101(a), 122 Stat. 4256, 4257.

advantages. In particular, if a plaintiff has a certificate of a registration "made before or within five years after first publication of the work," the certificate "shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate"; the "evidentiary weight to be accorded" a certificate granted thereafter is left to the court's discretion. *Id.* § 410(c).

The requirement that a copyright owner comply with the prerequisites for registration before bringing suit is not the only statutory inducement to registration. *See Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 158 n.1 (2010) (noting that the Act "establish[es] remedial incentives to encourage copyright holders to register their works"). Section 412 provides (with enumerated exceptions) that "no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for" any infringement of a work "commenced . . . before the effective date of its registration." 17 U.S.C. § 412. In the case of published works, however, the statute provides a grace period, allowing such damages if "registration is made within three months after the first publication of the work." *Id.* § 412(2).

4. Commentators and the Copyright Office itself have recognized that the Office "has been experiencing an upward trend in the backlog of claims and average processing time for applications [for registration]."[7] In its 2009 annual report, the Office reported

---

[7] Statement of Maria A. Pallante, U.S. Register of Copyrights, Before the Subcommittee on Legislative Branch Appropriations, U.S. Senate, Fiscal 2016 Budget Request at 4 (Mar. 17, 2015) ("Pallante Statement"), *available at* https://www.appropriations.senate.gov/imo/media/doc/hearings/031715%20LOC%20Register%

that its average processing time for claims had increased from 82 days in 2005 to 309 days in 2009.[8] In its most recent annual report, the Office reported that it had received nearly 540,000 claims for registration in fiscal year 2017 and ended the year with "more than 335,000 claims on hand in the system," including "more than 55,000" that "required more information from applicants."[9] Those who deal with the Office regularly report that long delays both in registration and in responding to correspondence are common.[10] The Office refused registration on "nearly

---

20of%20Copyrights%20Testimony%20-%20LegBranch.pdf; *see also* U.S. Copyright Office, "Registration Processing Times" (reporting average processing times of 7-16 months for registration applications), https://www.copyright.gov/registration/docs/processing-times-faqs.pdf.

[8] U.S. Copyright Office, *Annual Report of the Register of Copyrights* 47 (2009), *available at* https://www.copyright.gov/reports/annual/2009/ar2009.pdf. In its 2011 annual report, the Office reported that processing times had gotten shorter while noting that, as a result of the need for paper submissions and "because some claims require the Office to further correspond with the applicant, the Office always has categories of work that take longer to process," something that it considers a "routine part of the Office's business operations." U.S. Copyright Office, *Annual Report of the Register of Copyrights* 21-22 & n.2 (2011), *available at* https://www.copyright.gov/reports/annual/2011/ar2011.pdf.

[9] U.S. Copyright Office, *Fiscal 2017 Annual Report* 4 (2017) ("*2017 Annual Report*"), *available at* https://www.copyright.gov/reports/annual/2017/ar2017.pdf.

[10] *See* Comments of Science Fiction and Fantasy Writers of America, Inc., et al., at 3, *Group Registration of Unpublished Works*, Copyright Office Docket No. 2017-15 (filed Nov. 13, 2017) (noting "mean delay of well over a year between application and issuance of a certificate"), *available at* https://www.regulations.gov/document?D=COLC-2017-0009-0076; Comments

18,000 claims," about 3% of claims processed.[11] It is not clear what percentage of those rejections involved questions of copyrightable subject matter, but the very small number of requests for administrative review following a rejection – in Fiscal 2017, only 361 such requests involving 429 claims were made – may indicate that many rejections are for "legal or procedural" reasons other than copyrightability.[12]

The backlog in applications is due in no small part to the fact that, "[b]ecause the Office depends on Congress to appropriate taxpayer dollars to fund over a third of its budget, and depends on its parent agency, the Library of Congress, to request those appropriations, it is chronically short of funds."[13]

---

of the National Press Photographers Ass'n at 12, *Copyright Office Fees*, Copyright Office Docket No. 2012-1 (filed May 14, 2012) ("The current registration process takes too long and creates a burden for registrants."), *available at* https://www.copyright.gov/docs/newfees/comments/05142012/; Joint Comments of American Society of Media Photographers and Professional Photographers of America at 9, *Copyright Office Fees*, Copyright Office Docket No. 2012-1 (filed May 14, 2012) (reporting batch registration held "for almost a year without notifying [the registrant]"), *available at* https://www.copyright.gov/docs/newfees/comments/05142012/.

[11] *2017 Annual Report* at 4.

[12] *Id.*

[13] Robert Brauneis, *Properly Funding the Copyright Office: The Case for Significantly Differentiated Fees*, GW Law School Public Law and Legal Theory Paper No. 2017-58, at 1-2 (2017) ("Brauneis, *Properly Funding the Copyright Office*") (footnote omitted), *available at* https://ssrn.com/abstract=2997192; *see also* Copyright Alliance, "Copyright Registration" (explanation for increased processing times by U.S. Copyright Office official), https://copyrightalliance.org/ca_faq_post/can-you-please-explain-why-the-timeline-for-receiving-a-certificate-of-registration-has-

Not only has this resulted in serious delays in registration, but it has also led the Office to adopt a practice of "accepting some registration applications with radically incomplete authorship information"; more generally, because of the reduction in information recorded by the Office, "a large number of records in the electronic catalog" of registrations "have very thin information, . . . in some cases mak[ing] it more difficult to identify the work that has been registered."[14]

To "reduce the length of time required to process an application for registration of a claim to copyright," the Copyright Office established, several decades ago, a procedure known as "special handling," which is "granted at the discretion of the Register of Copyrights in a limited number of cases as a service to copyright registrants who have compelling reasons for the expedited issuance of a certificate of registration." Policy Decision Announcing Fee for Special Handling of Applications for Copyright Registration, 47 Fed. Reg. 19,254, 19,254 (May 4, 1982). In 1982, for the first time, the Register established a fee for this service while retaining the discretion to reject requests to provide it, *see id.* at 19,254-55, a discretion it retains today, *see* Policy Decision: Revised Special Handling Procedures, 56 Fed. Reg. 37,528, 37,529 (Aug. 7, 1991); U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 623.2 (3d ed. 2017), *available at* https://www.copyright.gov/comp3/docs/compendium.pdf. In those cases where the Register decides to provide special handling, the additional

---

gone-from-three-months-to-eight-months/ (last visited Aug. 21, 2018).

[14] Brauneis, *Properly Funding the Copyright Office* at 7-8.

charge for each application is $800, a fee that the Register has proposed to increase to $1,000. *See* Copyright Office Fees, 83 Fed. Reg. 24,054, 24,060 (May 24, 2018).

B. Factual Background

1. Fourth Estate "is an independent news organization" whose journalists produce "high quality, timely, accurate and compelling journalism." App. 15a-16a (Compl. ¶¶ 1-2). Fourth Estate owns the copyrights in those journalists' works and licenses them to a cloud-based news organization called AHN Feed Syndicate; AHN Feed Syndicate, in turn, licenses them to others. App. 16a, 18a (*id.* ¶¶ 2, 4, 14-15). Fourth Estate retains the right to sue for copyright infringement. App. 16a (*id.* ¶ 2).

This case concerns one of AHN Feed Syndicate's former licensees, Wall-Street.com, LLC ("Wall-Street"). Wall-Street secured a license to put some of Fourth Estate's works on the Internet. App. 18a (*id.* ¶ 17). Under that license, if Wall-Street canceled its account with AHN Feed Syndicate, Wall-Street was to "stop display of all Feed Syndicate provided content and permanently take down, remove and/or delete all cached, saved, archived, stored or data-based content or data." *Id.* (*id.* ¶ 18). Wall-Street canceled its account but continued to copy and distribute 244 of Fourth Estate's works. App. 18a-19a (*id.* ¶¶ 15, 19); *see* Compl. Ex. 1, ECF 1-2.

2. In March 2016, Fourth Estate sued Wall-Street, seeking an injunction and damages. App. 21a-22a (Compl. at 7). Before it did so, it filed its application for registration with the Copyright Office; it did not wait for the Office to act on that application. App. 18a (*id.* ¶ 14).

In its brief on the petition in this case, the government represented to the Court that it sent a letter rejecting petitioner's group application on August 4, 2017, approximately 16 months after the application was complete. *See* U.S. Inv. Br. App. 3a-4a.[15] The rejection letter (which is not in the record) casts no doubt on the copyrightability or registrability of the works at issue in the underlying suit. Instead, the letter faults petitioner for submitting several news articles for group registration as a database; "[i]n order to register the articles contained within this claim, separate applications for each article must be submitted to the Copyright Office." *Id.* at 9a. Petitioner had not previously had any reason to think the Office would take that position: AHN Media Corp., predecessor to AHN Feed Syndicate, had previously and successfully made group registration for databases containing the same type of material at issue here.[16]

C. Proceedings Below

Wall-Street moved to dismiss the complaint, arguing that § 411(a) bars Fourth Estate from suing until after the Register of Copyrights acts on its application. The district court granted the motion. App. 13a.

Recognizing that this case "require[d] [it] to decide an issue that has divided the circuits," App. 1a, the

---

[15] Such a delay is not unusual: in 2015, the Register informed Congress that the "average processing time" for paper applications (like petitioner's) was 13.5 months. Pallante Statement at 4.

[16] *See, e.g.*, Registration Nos. TX0006595981 (Apr. 30, 2007), TX0006595982 (Apr. 30, 2007), TX0006596887 (June 25, 2007) (searchable at https://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?DB=local&PAGE=First).

Eleventh Circuit held that the text of the Copyright Act required dismissal – aligning itself with the Tenth Circuit and expressly rejecting the contrary view of the Fifth Circuit and the Ninth Circuit. App. 4a-6a. The court stated that the Act "defines registration as a process that requires action by both the copyright owner and the Copyright Office." App. 6a. The court held that the use of the phrase "after examination" in § 410(a) – which describes the procedure that the Register must follow in registering a claim – "makes explicit that an application alone is insufficient for registration." *Id.* Furthermore, § 410(b) authorizes the Register to "refuse registration"; the court believed that, if "registration occurred as soon as an application was filed, then the Register of Copyrights would have no power to 'refuse registration.'" App. 7a (quoting 17 U.S.C. § 410(b)).

The court rejected Fourth Estate's contrary arguments based on other provisions of the statute. The court read § 408(a) – which states that a copyright owner "may obtain registration of the copyright claim by delivering" the required materials to the Register, 17 U.S.C. § 408(a) – to say nothing about when registration occurs, but only about "the conditions a copyright owner must satisfy to obtain registration." App. 7a. It likewise found it insignificant that § 410(d) provides that the effective date of registration is the date the application is complete, rather than the date the Copyright Office acts on an application. In the court's view, that section supports its rule because "registration occurs only after the Register of Copyrights deems an application 'to be acceptable.'" App. 8a (quoting 17 U.S.C. § 410(d)).

The court also acknowledged the harsh result that its rule, together with the statute of limitations,

can bring about: "an owner who files an application late in the statute of limitations period risks losing the right to enforce his copyright in an infringement action because of the time needed to review an application." *Id.* "But," in the court's view, "this potential loss encourages an owner to register his copyright soon after he obtains the copyright and before infringement occurs." *Id.* The court also refused to consider the Copyright Act's legislative history and animating policy, instead finding the language that other courts of appeals had interpreted differently to be "unambiguous." App. 9a.

SUMMARY OF ARGUMENT

The text of the Copyright Act, particularly when read in light of its history, makes clear that the registration requirement in § 411(a) imposes an obligation on the copyright owner to file for registration before initiating suit; it does not require any particular action by the Register. That interpretation, moreover, comports with the overall statutory structure and purpose and avoids the serious disadvantages of the rule adopted by the court below.

I.A. The phrase "registration has been made" and related constructions are used consistently in the 1976 Copyright Act to connote the action of a copyright owner in submitting the required deposit, fee, and application to obtain registration. *See Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 536 (2013) (noting that "we normally presume" that a statutory phrase "carr[ies] the same meaning when [it] appear[s] in different but related sections"). Section 411(c) – which was originally codified as § 411(b) – permits an action for infringement of the copyright in "a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission," to be initiated if, among other require-

ments, "*the copyright owner . . . makes registration* for the work . . . within three months after its first transmission." 17 U.S.C. § 411(c)(2) (emphasis added). The construction "copyright owner . . . makes registration" parallels the passive-voice construction "registration . . . has been made," confirming that, while the Copyright Office "register[s] [a] claim," *id.* § 410(a), the copyright owner "makes registration."

Section 412 likewise supports petitioner's reading. That provision precludes the "award of statutory damages or of attorney's fees" for any "infringement . . . commenced . . . before the effective date of its registration unless" – in the case of published works – "such *registration is made* within three months after the first publication." *Id.* § 412(2) (emphasis added). The evident purpose of this provision – to provide a safe-harbor for a copyright owner who complies with the registration requirement promptly after publication – makes it implausible to suggest that it puts the diligent copyright owner at the mercy of bureaucratic delay by the Copyright Office. *Cf. Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 346 (1998) (construing statutory term in light of context of related provisions). Additional provisions of the statute likewise use the phrase in a context that clearly refers to the action of the copyright owner, not the Copyright Office. *See* 17 U.S.C. § 408(c), (e).

B. The second sentence of § 411(a) – which applies "[i]n any case . . . where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused" – demonstrates only that the single word "registration" can *also*, in context, refer to the action of the Register in refusing (or granting) registration. That is not surprising: the statute provides no special definition of "registration"

and the ordinary meaning of "registration" has this flexibility built in. On a correct reading, this provision reinforces the conclusion that the phrase "registration . . . has been made" means that registration has been made by the copyright owner.

II. The history of § 411(a) reinforces this textual analysis. When the 1976 Act was adopted, courts were divided with respect to whether the Register's failure to grant registration could block a copyright owner from suing for infringement; the statute now makes clear that it cannot. Given that Congress wanted to avoid that result, it makes little sense to claim that Congress intended to give the Copyright Office the power to block suit through bureaucratic delay. *Cf. American Broad. Co. v. Aereo, Inc.*, 134 S. Ct. 2498, 2507 (2014) (refusing to credit construction that would permit result that Congress legislated to avoid). Moreover, the statute not only provides that a copyright owner may sue in "any case" where the Register refuses registration but also alters the language of the prior statute – its reference to "deposit of copies *and* registration of such work," 17 U.S.C. § 13 (1970) (emphasis added) – that had been cited in support of the conclusion that action by the Register was required before a suit could be filed.

III. Granting the Register the power to delay a copyright owner from suing to prevent ongoing infringement also would be inconsistent with the scheme of rights and remedies that the Copyright Act creates. The statute expressly states that "registration is not a condition of copyright protection." 17 U.S.C. § 408(a). Yet as this Court recognized in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939), without a right of enforcement, a copyright provides hardly any protection at all. *See id.* at 39 (the value of a copyright "depend[s] upon the possi-

bility of enforcement"). Any claim that a decision by the Register should always be obtained before litigation is allowed to proceed founders on the express statutory recognition that courts, not just the Register, have the authority to determine that the requirements for registration have been complied with. *See* 17 U.S.C. § 410(d).

ARGUMENT

I. THE STATUTORY TEXT MAKES CLEAR THAT THE COPYRIGHT OWNER MAKES REGISTRATION FOR PURPOSES OF § 411(a) BY COMPLYING WITH THE STATUTE'S REQUIREMENTS

The text of § 411 and surrounding provisions make clear that the phrase "registration . . . has been made" in § 411(a) refers to the actions of the copyright owner in submitting the deposit, application, and fee required for registration, not to a later determination by the Register.

A. The Statute Employs the Phrase "Make Registration" and Its Variants To Refer to the Actions of the Copyright Owner

Careful attention to the statutory text demonstrates that the phrase "make registration" and its passive-voice counterpart "registration has been made" is used in the Copyright Act to refer to the action of the copyright owner and not to the action of the Copyright Office. *See Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) ("[I]nterpretation of a phrase of uncertain reach is not confined to a single sentence when the text of the whole statute gives instruction as to its meaning.") (alteration in original). It is a "standard principle of statutory construction . . . that identical words and phrases within the same statute should normally be

given the same meaning." *Powerex Corp. v. Reliant Energy Servs., Inc.*, 551 U.S. 224, 232 (2007). That principle supports petitioner here.

1. *First*, within § 411(a) itself, the phrase "registration of the copyright claim has been made *in accordance with this title*" (emphasis added) more naturally refers to the owner's actions, because the owner's right to sue turns on whether the owner's actions (not the Copyright Office's) "complied with the relevant statutory . . . registration procedures." *Harper & Row, Publ'ers, Inc. v. Nation Enters.*, 471 U.S. 539, 547-48 (1985) (citing § 408, which addresses procedures that copyright owners must follow to "obtain registration"); *see also Golan v. Holder*, 565 U.S. 302, 314 n.11 (2012) ("The Copyright Act retains . . . incentives for *authors to register* their works") (emphasis added); *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 171 (2010) (Ginsburg, J., concurring in part and concurring in the judgment) (describing § 411(a) as "instruct[ing] *authors to register* their copyrights before commencing suit for infringement") (emphasis added).

Second, § 411(c), which applies to works consisting of "sounds, images, or both, the first fixation of which is made simultaneously with transmission," allows a copyright owner to institute an action for infringement if (among other requirements) "*the copyright owner . . . makes registration* for the work, if required by subsection (a), within three months after its first transmission." 17 U.S.C. § 411(c)(2) (emphasis added). This active-voice construction, with "the copyright owner" as the subject, implies that the passive-voice construction "registration . . . has been made" likewise refers to the action of the copyright owner. That inference is particularly strong because § 411(c)

was originally codified as § 411(b), in immediate juxtaposition to § 411(a). *See* 90 Stat. 2583. In such circumstances, the "maxim" favoring consistent construction "is doubly appropriate." *Powerex*, 551 U.S. at 232.[17]

Third, in § 412, the statute uses the phrase "registration is made" in a context that makes clear that it refers to the action of the copyright holder. 17 U.S.C. § 412(2); *cf. Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 346 (1998) (interpreting statutory term in light of its use in context of related provisions). Section 412 specifies (with certain statutory exceptions) that "no award of statutory damages or of attorney's fees . . . shall be made for . . . any infringement of copyright commenced after first

---

[17] The explanation of § 411(a) in the House Report accompanying the 1976 Act likewise indicates that the language of § 411(a) refers to the action of the copyright owner, not the Register:

> The first sentence of section 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted. Under the bill, as under the law now in effect, *a copyright owner* who has not *registered his claim* can have a valid cause of action against someone who has infringed his copyright, but he cannot enforce his rights in the courts until *he has made registration*.

H.R. Rep. No. 94-1476, at 157 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5773 (Comm. on the Judiciary) (emphases added). *See also Copyright Law Revision – Part 6: Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill* 124 (Comm. Print 1965) ("*1965 Supplementary Report*") ("[T]he owner of an unregistered copyright . . . *must register* his claim before he can enforce his rights in the courts.") (emphasis added), *available at* https://babel.hathitrust.org/cgi/pt?id=mdp.39015030337722;view=1up;seq=151.

publication of the work and before the effective date of its registration, *unless such registration is made* within three months after the first publication of the work." 17 U.S.C. § 412(2) (emphasis added). This provision creates a grace period within which a copyright owner may register a claim in a published work without losing the valuable remedies provided in § 504 and § 505.[18] It would make no sense for the three-month deadline to apply to action by the Copyright Office (which may be delayed due to no fault of the copyright owner); rather, as with § 411(c), this provision requires *copyright owners* to make registration within three months (even though the Copyright Office may – and usually does – act later).

Fourth, other provisions of the Act use variants of the phrase "make registration" in the same way. Thus, § 408(c)(3) notes that, "[a]s an alternative to separate renewal registrations under [§ 304(a)], a single renewal registration *may be made* for a group of works by the same individual author, all first published as contributions to periodicals, . . . *upon the filing* of a single application and fee" under certain conditions. 17 U.S.C. § 408(c)(3) (emphases

---

[18] *See* H.R. Rep. No. 94-1476, at 158, *reprinted in* 1976 U.S.C.C.A.N. 5774:

> As an exception, however, the clause provides a grace period of three months after publication during which registration can be made without loss of remedies; full remedies could be recovered for any infringement begun during the three months after publication if registration is made before that period has ended. This exception is needed to take care of newsworthy or suddenly popular works which may be infringed almost as soon as they are published, before the copyright owner has had a reasonable opportunity to register his claim.

added). Thus, registration is again "made . . . by the . . . author"; and it is also "made . . . upon . . . filing," not upon approval by the Register. Likewise, § 405(b) protects certain innocent infringers for acts of infringement committed "before receiving actual notice that registration for the work has been made *under section 408*." 17 U.S.C. § 405(b) (emphasis added). Section 408 describes how the *copyright owner* "may obtain registration" – namely, "by delivering to the Copyright Office the deposit specified by [§ 408], together with the application and fee specified by sections 409 and 708." 17 U.S.C. § 408(a). It does not describe the Register's decision to register a claim, which is addressed in § 410.[19]

---

[19] The use of the phrase in § 406(a)(1) and § 409 does not shed light on its meaning. The former provision – which addresses the consequences of an error in a copyright notice on copies distributed before March 1, 1989 – states that an error in a copyright notice (1) does not affect "validity and ownership of the copyright" but (2) does provide a "complete defense" to "any person who innocently begins an undertaking that infringes the copyright" if the person "proves that he or she was misled by the notice and began the undertaking in good faith under a purported transfer or license from the person named" in the copyright notice. 17 U.S.C. § 406(a). That defense is unavailable, however, if "registration for the work had been made in the name of the owner of copyright" or a document showing transfer of ownership has been recorded. *Id.*; *see infra* pp. 26-27 (discussing § 205(c)). The government has argued that, because this is a "constructive notice" provision, U.S. Inv. Br. 21, it would make no sense to deprive an infringer of the defense before registration is granted and recorded. But because the "effective date of a copyright registration," 17 U.S.C. § 410(d), is the date that the copyright owner files the application and required copies and fees, it is possible under either competing reading of the statute that the infringer would lose the defense as of that date. That result is not surprising: the statute similarly limits awards "of statutory damages or of attorney's fees"

Fifth, § 110 of the 1976 Act – which preserves the penalties established by § 13 of the 1909 Act for failure to make required deposit of works published with notice before the effective date of the 1976 Act, *see* 35 Stat. 1078, codified as amended at 17 U.S.C. § 14 (1970) – provides that "any deposit and registration made after that [effective] date in response to a demand under that section shall be made in accordance with" the provisions of the new Act. 90 Stat. 2600, *reprinted in* 17 U.S.C. § 407 note. It is the copyright owner, not the Copyright Office, who makes a deposit and who responds to "a demand" by the Register. Accordingly, it is also the copyright owner who makes registration under § 110.

Sixth, § 205(c) provides that recordation "gives all persons constructive notice of the facts stated in the recorded document" "only if" "(1) the document, or material attached to it, specifically identifies the work to which it pertains so that, after the document is indexed by the Register of Copyrights, it would be revealed by a reasonable search under the title or registration number of the work"; and "(2) registration has been made for the work." 17 U.S.C. § 205(c). In light of its purposes, this provision likewise suggests that the phrase "registration has been made" refers to the action of the copyright owner rather than to the action of the Copyright Office.

Suppose that (1) an author took out a loan against the value of the author's copyright in a work; (2) the

---

for infringement of unregistered works but expressly authorizes them for infringement after the "effective date" of registration. *Id.* § 412.

Section 409 refers to a situation where registration has *not* been made – which could refer equally to registration by the copyright owner or the Copyright Office.

lender had a security interest in the copyright; (3) the author had applied for registration; but (4) the Copyright Office had not yet issued a registration certificate. Under petitioner's reading of the phrase "registration has been made," the lender gains protection against a subsequent transferee of the copyright by recording the lien in the manner prescribed in § 205(a) as long as the author has made registration of the work by sending the required application, copies, and fee – whether or not the Copyright Office has yet issued a certificate of registration. Under respondents' reading, the lender remains at risk until the Copyright Office acts, even though the lien documents were on file with the Office and could have been found by searching "under the title . . . of the work." That odd and counterintuitive result is another reason to understand the "making" of registration, here and elsewhere in the statute, as the action of the copyright owner.

Finally, it is true that § 708(a) refers to fees that may be charged "on filing each application under section 408 for registration . . . , including the issuance of a certificate of registration if registration is made." *Id.* § 708(a)(1); *see also id.* § 708(a)(2). In this single provision, "registration is made" is used to mean "registration is granted by the Copyright Office." But, as enacted, the 1976 Act did not include this phrase: it simply provided that the fee for registration would "includ[e] the issuance of a certificate of registration." 90 Stat. 2593. The phrase "if registration is made" was added only in 1982 and thus sheds little light on the proper construction of the related phrase in § 411(a). *See Almendarez-Torres v. United States*, 523 U.S. 224, 237 (1998) (finding the use of a disputed statutory term in "later enacted laws" to be

"beside the point" because, among other things, those laws "d[id] not reflect any direct focus by Congress upon the meaning of the earlier enacted provisions"). And that is particularly so because § 708 appears in a separate chapter addressing fees and not in a closely related provision addressing the procedural or litigation consequences of registration.

2. The premise of the Eleventh Circuit's decision – that "registration" in the statute uniformly refers to the action of the Register when she registers a copyright claim – is thus incorrect. To be sure, the word "registration" is sometimes used in the statute to refer to the action of the Copyright Office – for example, § 410(a) directs the Register to "register" a claim when legal and formal requirements have been met, and § 410(b) directs the Register to "refuse registration" when such requirements are not met. But the observation that registration *can* be used in a context that refers to the action of the Copyright Office does not mean that it *cannot* refer, in appropriate context, to the action of the copyright holder in applying for registration. *See Barber v. Thomas*, 560 U.S. 474, 484 (2010) (noting that some statutory terms "can [be] easily use[d] in different ways without risk of confusion"); *cf. Feltner*, 523 U.S. at 356 (Scalia, J., concurring in the judgment) (noting that the word "court" can mean either the judge alone or both the judge and the jury).

As a matter of ordinary language, there is nothing paradoxical about this, because the word "registration" has substantial flexibility built in. A college student may register for classes (and thus complete registration) yet not get into a particular course (and thus be denied registration). Indeed, this Court has repeatedly referred to a copyright owner "regis-

tering" a claim. *See, e.g., Golan*, 565 U.S. at 314 n.11; *Reed Elsevier*, 559 U.S. at 157. Furthermore, the statute contains no definition that would cut back on the ordinary meaning of "registration."[20]

To determine how the statute uses the word "registration" in a particular provision of the Copyright Act, it is thus necessary to look to the specific context of the use. Here, the most important textual evidence is its use in the phrase "registration has been made," which, as shown above, the statute consistently employs to refer to the action of the copyright owner, not the Register.

B. The Portion of § 411(a) Addressing the Consequences of Refusal of Registration Further Supports the Conclusion That "Registration . . . Has Been Made" Refers to the Action of the Copyright Owner

The second sentence of § 411(a) clarifies that the Register's refusal to register a claim does not bar an action for infringement: so long as "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form . . . , the applicant is entitled to institute a civil action for infringement." 17 U.S.C. § 411(a). This provision reversed the result the Second Circuit reached in *Vacheron & Constantin-Le Coultre Watch-*

---

[20] Although the statute now contains a definition of the word, it was not included in the 1976 Act, offers no elaboration on the meaning of the term, and was added only in 1992 to clarify that registration referred to both "the original" and "the renewed and extended term of copyright" provided for in that Act. Copyright Renewal Act of 1992, Pub. L. No. 102-307, tit. I, § 102(b)(2), 106 Stat. 264, 266; *cf. Taniguchi v. Kan Pac. Saipan, Ltd.*, 566 U.S. 560, 566 (2012) ("When a term goes undefined in a statute, we give the term its ordinary meaning.").

es, Inc. v. Benrus Watch Co., 260 F.2d 637 (2d Cir. 1958) – as discussed further below – by making clear that the Register's determination that a claim is not registrable does not preclude an action to enforce it.

The specific wording of this provision, moreover, is consistent with the conclusion that "registration has been made" refers to the copyright owner's compliance with statutory requirements, not the decision to register the claim. Otherwise, the two sentences would contradict each other – that is, the second sentence would mean that a suit for infringement may be instituted even though registration had *not* been made. Statutes should be read to avoid, not create, such contradictions. *See Liteky v. United States*, 510 U.S. 540, 552 (1994) (rejecting reading that would cause statute "to contradict itself").

The use of the word "however" in the second sentence does not show that an internal contradiction was intended. *Cf. Dollar Sav. Bank v. United States*, 86 U.S. (19 Wall.) 227, 236 (1874) (rejecting as "inadmissible" a "broad construction of [a] proviso" that would "make[] it plainly repugnant to the body of the act"). The "however" clause can and should be read as a signal that, if the Copyright Office refuses registration, an additional requirement is imposed – notice to the Office. It need not (and therefore should not) be read to state that a civil action may be instituted even though registration has never been "made" at all. Put another way, cases where "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused" constitute a subset of those cases where "registration . . . has been made" that are subject to an additional procedural requirement.

Respondent argues that the use of the word "institute" in the second sentence of § 411(a) implies that the refusal to register must take place before the suit is filed; if refusal must come before a suit is filed, so too must approval. But it is no stretch to read the second sentence of § 411(a) to say that if the copyright owner has complied with the registration requirement a suit may be instituted, and that if a refusal comes (before or after the suit is initiated) notice must be served on the Register.[21] In particular, the statute does not say that notice must be served on the Register before the suit begins: on the contrary, there is no time limit on service, and the fact that a copy of the complaint (not the prospective complaint) must be served indicates that the suit will have begun when the Copyright Office is notified.

In any event, even if the second sentence is read to address how to initiate a suit *after* refusal, and not what to do in a suit already initiated when a refusal comes, it still does not preclude a suit when the copyright owner has complied with the registration requirement but the Register has not acted one way or another. It makes sense to clarify the point that even affirmative rejection of an application does not

---

[21] That this is a reasonable reading of the provision is supported by the language of the House Report accompanying the legislation, which states that, "[u]nder section [4]11, a rejected claimant who has properly applied for registration may *maintain* an infringement suit if notice of it is served on the Register." H.R. Rep. No. 94-1476, at 157, *reprinted in* 1976 U.S.C.C.A.N. 5773 (emphasis added). *See also* H.R. Rep. No. 90-83, at 125 (1967) ("[A] rejected claimant who has properly applied for registration may *maintain* an infringement suit if he serves notice of it on the Register of Copyrights.") (emphasis added).

preclude a copyright owner from alleging that "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form," despite the Register's determination to the contrary. That such an action may proceed supports the conclusion that the Register's failure to act cannot bar a suit either.

II. THE HISTORY OF § 411(a) FURTHER DEMONSTRATES THAT A COPYRIGHT OWNER MAY INSTITUTE A CIVIL ACTION FOR INFRINGEMENT ONCE STATUTORY REQUIREMENTS ARE COMPLIED WITH

At the time of the adoption of the 1976 Act, the courts of appeals had articulated two interpretations of the registration requirement contained in the 1909 Act. One interpretation held that, so long as the copyright owner had complied with statutory formalities, a suit could proceed; the other, that approval by the Register was required. In expressly rejecting the latter view, the statute is most reasonably read to adopt the former. That is particularly clear because the reading adopted by the court below perpetuates the practical defects of the interpretation that the statute rejects. *See American Broad. Co. v. Aereo, Inc.*, 134 S. Ct. 2498, 2505-06 (2014).

1. The first sentence of § 411(a) corresponds to the last sentence of § 13 of the previous statute, which provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with." 17 U.S.C. § 13

(1970).[22] Like the current statute, this requirement was phrased in the passive voice, and, like the present statute, it gave rise to conflicting interpretations with respect to whether compliance with the requirements of the statute referred to the actions of the copyright owner or required action by the Register as well.

On the one hand, the First and Ninth Circuits understood that the registration requirement was satisfied so long as the copyright owner had "complied with the requirements of law." *White-Smith Music Publ'g Co. v. Goff*, 187 F. 247, 247 (1st Cir. 1911). As the Ninth Circuit explained, once "plaintiff placed the revised applications in the mail . . . , it had done everything required of it under the copyright law with respect to the deposit of copies and registration and could therefore, *on that day* 'maintain' that action." *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1108-09 (9th Cir. 1970) (emphasis added). The same view was also expressed in a dissenting opinion by Judge Clark, who insisted that § 13 "[q]uite obviously . . . puts the condition of complying with the law . . . upon the copyright owner before he sues." *Vacheron*, 260 F.2d at 645 (Clark, C.J., dissenting).

On the other hand, the Second Circuit had held that it was not enough for the copyright owner to comply with statutory requirements; registration by the Register was required. Thus the court of appeals read § 13 to "forb[id] any action . . . when the

---

[22] *See* H.R. Rep. No. 94-1476, at 157, *reprinted in* 1976 U.S.C.C.A.N. 5773 ("The first sentence of section 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted.").

Register of Copyrights had refused" the registration. *Id.* at 639 (majority).

The statute rejects the result reached by the Second Circuit, which indicates approval of the understanding of the First and Ninth Circuits (and Judge Clark) that the registration requirement is satisfied once the *copyright owner* has complied with the statute. *See Reed Elsevier*, 559 U.S. at 163-65 (recounting history); *Aereo*, 134 S. Ct. at 2504-05 (relying on intent to overrule result of prior cases to construe scope of provision); *cf. CBOCS W., Inc. v. Humphries*, 553 U.S. 442, 454 (2008) ("After all, the 1991 amendments themselves make clear that Congress intended to supersede the result in *Patterson* [*v. McLean Credit Union*, 491 U.S. 164 (1989)] and embrace pre-*Patterson* law.").

Moreover, the statute eliminates the language in § 13 that the Second Circuit had relied on in reaching its conclusion. The court reasoned that because § 13 barred an action "until the provisions of this [Act] with respect to the deposit of copies *and* registration of such work shall have been complied with" – and because the copyright owner had to deposit copies as part of obtaining registration – the separate statutory reference to registration must refer to the action of the Register. *See Vacheron*, 260 F.2d at 640-41. The 1976 Act avoids any such (mistaken) inference by limiting the requirement to making "registration" – and eliminating the separate reference to "deposit." *Cf. Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 356 (1991) (change in language of successor provision provided clarification of existing law). This provides further evidence that the statute does not require action by the Register before a suit can proceed.

2. This conclusion is reinforced because the interpretation adopted by the court of appeals recreates the very problem to which critics of the *Vacheron* rule objected. *See Aereo*, 134 S. Ct. at 2505-07. By requiring a copyright owner to obtain a certificate of registration before bringing suit, the *Vacheron* rule led to potentially lengthy delays while a copyright owner pursued mandamus to compel the Register to register a claim. *See* 260 F.2d at 640; *id.* at 644-45 (Clark, C.J., dissenting). Statements in the many studies and reports prepared in the course of the revision of the copyright laws repeatedly reflect dissatisfaction with this state of affairs. For example, a report of the Register called the result in *Vacheron* "unfortunate." *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law* 75 (Comm. Print 1961), *available at* https://www.copyright.gov/history/other_reports.html. "If the infringement continues, the delay involved in proceeding first against the Register may aggravate the injury. And two successive actions – usually in different jurisdictions – may be an expensive burden." *Id.*; *see also id.* at vi-vii ("[F]ailure to register should not forfeit the copyright. However, *application* for registration would still be a prerequisite to bringing an infringement suit.") (emphasis added).[23]

---

[23] *1965 Supplementary Report* at 124 ("The bill also follows the *Report*'s recommendation that the law as interpreted in *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958), be changed to permit a claimant whose application has been refused to maintain a suit against an infringer 'if the Register is notified and permitted to become a party to the suit.'").

The rule adopted by the court below risks "aggravat[ing] the injury" of the copyright holder in the same way. In a case where the copyright owner filed for registration and the Register fails to register it – either without explanation or following the copyright holder's response to correspondence from the Office – the copyright holder will be unable to bring suit without first (in an extreme case) seeking judicial relief to compel action. It makes no sense to adopt a reading of the registration requirement that recreates the very defect the statute was modified to avoid. *Cf. Exxon Mobil Corp. v. Allapattah Servs., Inc.*, 545 U.S. 546, 565 (2005) (rejecting an interpretation of 28 U.S.C. § 1367 that "would mean that § 1367 left the *Finley* [*v. United States*, 490 U.S. 545 (1989)] result undisturbed" because "all concede that one purpose of § 1367 was to change the result reached in *Finley*").

III. THE STATUTORY SCHEME OF RIGHTS AND REMEDIES FAVORS ALLOWING SUITS TO PROCEED ONCE THE COPYRIGHT OWNER HAS COMPLIED WITH REQUIRED FORMALITIES

The Copyright Act's scheme of rights and remedies further supports the conclusion that § 411(a) does not permit the Register to prevent an infringement suit by failing to act on an application for registration submitted in accordance with the Act's requirements. *See FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 133 (2000) (noting that "[a] court must . . . interpret [a] statute as a symmetrical and coherent regulatory scheme and fit, if possible, all parts into an harmonious whole") (citation omitted); *see also* 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][3][b][ii] (2013) ("Indeed, some

courts that follow the [Eleventh Circuit's] approach concede that it yields an inefficient and peculiar result.").

First, making the Copyright Office the gatekeeper to enforcement of copyrights is inconsistent with the rest of the Copyright Act, which makes clear that a copyright owner's statutory rights do not depend on administrative action. The Act grants a copyright owner exclusive rights in a work as soon as it is fixed in a tangible medium of expression. *See* 17 U.S.C. § 102(a); *Harper & Row*, 471 U.S. at 546-47. Those rights are not granted by the Copyright Office (or even by virtue of compliance with formalities like publication with notice); they, instead, come about by virtue of the creation and fixation of the work.

Moreover, the statute expressly provides that the "registration" that a copyright owner "may obtain" is "not a condition of copyright protection." 17 U.S.C. § 408(a). Yet, as this Court pointed out in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939), in the absence of any possible enforcement action, a copyright hardly provides any protection at all: "[w]ithout right of vindication a copyright is valueless." *Id.* at 40; *see also Dowling v. United States*, 473 U.S. 207, 221 (1985) ("Congress [has] chiefly relied on an array of civil remedies to provide copyright holders protection against infringement"). It would be paradoxical to say that a requirement that can render a patent "valueless" – even temporarily – is "not a condition of copyright protection."

On a proper reading of § 411(a), there is no tension between the registration requirement and the permissive nature of registration: the copyright owner is always protected because it can always satisfy the purely procedural requirement of making registration

before suing. *Cf. Harper & Row*, 471 U.S. at 547-48 (explaining that copyright holders protected themselves by "compl[ying] with the relevant statutory notice and registration procedures"). Indeed, as Judge Clark argued in dissent in *Vacheron*, though *Washingtonian Publishing* "is not explicit on our present issue, its holding and discussion certainly tend in the same direction." 260 F.2d at 646 (Clark, C.J., dissenting).

Second, although the Copyright Act strongly encourages registration by limiting statutory remedies for infringement commenced before the effective date of registration, *see* 17 U.S.C. § 412; *Golan*, 565 U.S. at 314 n.11, what matters is the date when the copyright owner complies with the statutory requirements, not the date when the Register acts. Thus, § 410(d) defines the "effective date of a copyright registration" as "the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. § 410(d). It would be strange to conclude that "registration . . . has been made" for purposes of beginning a suit only months or years *after* the "effective date of . . . registration" for purposes of determining the remedies available in that same suit. Consistent with all this, the statute makes clear that whether the copyright owner has complied with the requirements for registration may be determined in litigation by the court. *See Reed Elsevier*, 559 U.S. at 163-64. Not only will that ensure that a copyright owner whose application for registration has been refused may still obtain relief, but it will also ensure that any

issue of registrability can be litigated, if necessary, while an application is pending.

Third, it is not the case, as the court below thought, that allowing litigation to be instituted after the copyright holder has registered the claim (but before the Copyright Office has acted) would deprive the Register of "power to 'refuse registration.'" App. 7a. Whatever the status of any litigation commenced in federal court, the Register will be able to act in due course on the application submitted to the Copyright Office. Nor is it correct that "an applicant could obtain the advantage" of a presumption of validity "upon application" only to lose it if the Register denied the application. *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1205 (10th Cir. 2005). The presumption of validity depends on a "*certificate* of a registration," not registration. 17 U.S.C. § 410(c) (emphasis added). Accordingly, if the Copyright Office has not registered the claim and issued a certificate of registration, the copyright holder gains no evidentiary advantage from having made registration.

It is likewise not the case (as the government has asserted in the past) that allowing litigation to proceed while registration is pending will deprive the Copyright Office of its right to intervene in litigation in cases where registration is refused: if an application is refused, notice would be required, and the government could choose to intervene at that point.[24]

---

[24] Furthermore, the Register will have prompt notice of pending copyright litigation, allowing it to expedite review of any claims at issue in a civil action. *See* 17 U.S.C. § 508(a) ("Within one month after the filing of any action under this title, the clerks of the courts of the United States shall send

Absent unreasonable delay in examination, there is no risk that the government will lose its chance to participate at a meaningful time – and the possibility of such unreasonable delay is an argument in favor of petitioner's reading of the statute.

As noted, litigation may proceed irrespective of the view of the Copyright Office, and the determination of the Copyright Office constitutes "prima facie" evidence only in cases where it *grants* a certification of registration, 17 U.S.C. § 410(c).[25] As the leading treatise has pointed out, in most cases, even if litigation begins before the Copyright Office has granted or refused registration, such action can be expected during the course of litigation, giving the court the benefit of the Register's views. *See* 2 *Nimmer on Copyright* § 7.16[B][3][b][ii]. Just as important, in any case where a claim's eligibility for copyright protection presents a substantial issue, a court can use the ordinary tools of litigation management – including the doctrine of primary jurisdiction – to give the Copyright Office the first crack at determining whether the subject matter of the work is

---

written notification to the Register of Copyrights setting forth, as far as is shown by the papers filed in the court, the names and addresses of the parties and the title, author, and registration number of each work involved in the action."). (The reference to "registration number" does not assist respondents: the provision requires information only "as far as is shown by the papers," and there is no dispute that, in cases anticipated under § 411(a) where registration has been refused, no registration number will be available.)

[25] By contrast, after the Patent and Trademark Office has issued a patent, a litigant must present "clear and convincing" evidence to overcome the presumption that the patent is valid. *See generally Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91 (2011).

copyrightable. *Cf. Syntek Semiconductor Co. v. Microchip Tech. Inc.*, 307 F.3d 775, 781 (9th Cir. 2002) (similar). Given the breadth of copyright law's protections, *see* 17 U.S.C. § 102(a), the Office typically grants the overwhelming majority of applications. *See* 2 *Nimmer on Copyright* § 7.16[B][3][b][ii]. There is no reason to believe that substantial issues of copyrightability will arise often – and no such defense has been asserted in this case.[26]

Fourth, requiring action by the Copyright Office before a suit can be filed creates significant practical problems. For one thing, by barring a copyright owner from seeking the injunctive relief to which the Copyright Act entitles the copyright owner until the Copyright Office acts, the rule requires the copyright owner to endure the ongoing theft of intellectual property rights the copyright owner already possesses – to the benefit of the infringer. *See Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 620 (9th Cir. 2010). As noted, this is the very problem that § 411(a) was drafted to avoid. *See supra* pp. 32-36. For another thing, if the Act's statute of limitations elapses before the Office acts on the application, the copyright owner may forever lose any ability to enforce the very rights the Act grants. *See Cosmetic Ideas*, 606 F.3d at 620.

Fifth, it is no answer to these objections to point out that the Copyright Office has instituted

---

[26] The government's invitation brief suggests that there may be a dispute about the classification of the works for which registration was sought as well as about the timing of payment. A copyright owner that intends to sue has every incentive to avoid such disputes by taking care to submit a deposit, application, and fee that meets requirements for registration.

a procedure that allows copyright owners to obtain faster processing of registrations.[27] The cost of special handling is, at present, $800 per work; for a copyright holder pursuing relief for infringement of multiple works, those fees can rapidly amount to tens if not hundreds of thousands of dollars. Furthermore, special handling is discretionary and provides no guarantee that a particular registration will be resolved by any deadline. And there is no reason to suppose that Congress maintained the registration requirement for the purpose of increasing the fees the Copyright Office might impose.

If the Copyright Office were better funded and more efficient and routinely provided service within days of filing – as was once the case[28] – it is true

---

[27] Preregistration under § 408(e) – a procedure that came into existence only in 2005 – does not address this problem either. As the Copyright Office warns, "[f]or the vast majority of works, preregistration is not useful." U.S. Copyright Office, "Preregister Your Work," https://www.copyright.gov/prereg/ (last visited Aug. 23, 2018). The procedure is available only for a subset of unpublished works and would not have been available for the news articles at issue here. *See* 37 C.F.R. § 202.16(b). Moreover, preregistration does not eliminate the need for registration; it simply permits a copyright owner to sue before registration, conditional on making registration within the required time. *See* U.S. Copyright Office, "Preregister Your Work" ("A person who has preregistered a work is required, in order to preserve the legal benefits of preregistration, to register such work within one month after the copyright owner becomes aware of infringement and no later than three months after first publication. If full registration is not made within the prescribed time period, a court must dismiss an action for copyright infringement that occurred before or within the first two months after first publication.").

[28] *See* Arthur Fisher, U.S. Register of Copyrights, "The Copyright Office and the Examination of Claims to Copyright,"

that the question presented would be of lesser importance. But the answer to that question would remain the same.

CONCLUSION

The judgment of the court of appeals should be reversed.

---

in 1953 Copyright Problems Analyzed 11, 15 (Theodore R. Kupferman ed.):

> In recent years, the Copyright Office has emphasized currency of operation. We like the pleasant reaction we get when claimants receive certificates of registration very soon after their applications are submitted. Sometimes we feel that we would like to operate the way a bank does and balance our books at the end of each day's business, or as some modern merchandising houses do and dispose of all our mail within 24 hours of its receipt.

Respectfully submitted,

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN
INTELLECTUAL PROPERTY
LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

August 27, 2018

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
GRACE W. KNOPCZYNSKI
KELLOGG, HANSEN, TODD,
FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

No. 17-571

In the Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE RESPONDENTS

DAVID A. GELLER
1221 S. 21st Avenue
Hollywood, FL 33020

PETER K. STRIS
Counsel of Record
BRENDAN S. MAHER
ELIZABETH BRANNEN
RACHANA A. PATHAK
DOUGLAS D. GEYSER
VICTOR O'CONNELL
JOHN STOKES
STRIS & MAHER LLP
725 S. Figueroa Street
Suite 1830
Los Angeles, CA 90017
(213) 995-6800
peter.stris@strismaher.com

Counsel for Respondents

QUESTION PRESENTED

Section 411(a) of the Copyright Act limits the circumstances under which a copyright owner may initiate an infringement action. In particular:

> [N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.

17 U.S.C. 411(a).

In this case, petitioner sued respondents after petitioner applied for registration of its copyright claim but before the Copyright Office "regist[ered]" the claim or "refused" registration. The question presented is:

Whether a copyright-infringement suit may be "instituted" before "registration of the copyright claim has been made" or "refused" by the Copyright Office.

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, respondent Wall-Street.com, LLC certifies that it has no parent company and that no publicly held company owns 10% or more of its stock.

TABLE OF CONTENTS

Page

Question presented I
Rule 29.6 statement II
Introduction 1
Statement 2
A. Statutory background 2
B. Procedural history 12
Summary of argument 14
Argument 18
I. The Copyright Act clearly requires the Register of Copyrights to approve or refuse a claim before an infringement suit may be brought 18
A. The unambiguous text of Section 411(a) forecloses petitioner's application approach 19
B. Many other provisions in the Act foreclose petitioner's application approach 25
C. Petitioner's reliance on the phrase "makes registration" is misplaced 29
D. Petitioner's scavenger hunt through the Act is unavailing at every turn 32
II. The history of Section 411(a)'s enactment confirms that the Register must approve or refuse a claim before suit may be brought 38
III. If petitioner wants the law changed or more funding for the Copyright Office, it should address Congress or the Copyright Office, not this Court 42
Conclusion 52

TABLE OF AUTHORITIES

Cases:

Ali v. *Fed. Bureau of Prisons*,
552 U.S. 214 (2008) 43
Clark v. *Martinez*,
543 U.S. 371 (2005) 27
Clark v. *Rameker*,
134 S. Ct. 2242 (2014) 25
Cosmetic Ideas, Inc. v. *IAC/Interactivecorp*,
606 F.3d 612 (9th Cir. 2010) 13
Duncan v. *Walker*,
533 U.S. 167 (2001) 26
EMI Christian Music Grp., Inc. v. *MP3tunes, LLC*,
844 F.3d 79 (2d Cir. 2016) 35
Freeman v. *Quicken Loans, Inc.*,
132 S. Ct. 2034 (2012) 19
Hall v. *United States*,
566 U.S. 506 (2012) 23
Henson v. *Santander Consumer USA Inc.*,
137 S. Ct. 1718 (2017) 43
Inhale, Inc. v. *Starbuzz Tobacco, Inc.*,
755 F.3d 1038 (9th Cir. 2014) 25
Janus Capital Grp., Inc. v. *First Derivative Traders*,
564 U.S. 135 (2011) 30
Kregos v. *Assoc. Press*,
795 F. Supp. 1325 (S.D.N.Y. 1992) 50
La Resolana Architects, PA v. *Clay Realtors Angel Fire*,
416 F.3d 1195 (10th Cir. 2005), abrogated in part on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010) 12, 26
Lawrence v. *Florida*,
549 U.S. 327 (2007) 37
Life Techs. Corp. v. *Promega Corp.*,
137 S. Ct. 734 (2017) 19

Cases—Continued:

Merit Mgmt. Grp., LP v. *FTI Consulting, Inc.*,
138 S. Ct. 883 (2018) 21
Mohasco Corp. v. *Silver*,
447 U.S. 807 (1980) 44
N.L.R.B. v. *SW Gen., Inc.*,
137 S. Ct. 929 (2017) 38
Olem Shoe Corp. v. *Wash. Shoe Corp.*,
591 F. App'x 873 (11th Cir. 2015) 25
Petrella v. *Metro-Goldwyn-Mayer, Inc.*,
134 S. Ct. 1962 (2014) 51
Positive Black Talk Inc. v. *Cash Money Records Inc.*,
394 F.3d 357 (5th Cir. 2004) 13
Puerto Rico v. *Franklin Cal. Tax-Free Trust*,
136 S. Ct. 1938 (2016) 18, 19
Reed Elsevieri Inc. v. *Muchnick*,
559 U.S. 154 (2010) ..... *passim*
Reves v. *Ernst & Young*,
507 U.S. 170 (1993) 30
Skidmore v. *Swift & Co.*,
323 U.S. 134 (1944) 25, 35
Star Athletica, LLC v. *Varsity Brands, Inc.*,
137 S. Ct. 1002 (2017) 19, 25, 35
TRW Inc. v. *Andrews*,
534 U.S. 19 (2001) 26
Vacheron & Constantin Le Coultre Watches, Inc. v. *Benrus Watch Co.*,
260 F.2d 637 (2d Cir. 1958) ..... *passim*
Varsity Brands, Inc. v. *Star Athletica, LLC*,
799 F.3d 468 (6th Cir. 2015) 35
W. Va. Univ. Hosps., Inc. v. *Casey*,
499 U.S. 83 (1991) 44

Statutes:

17 U.S.C. 102 3
17 U.S.C. 106 3

Statutes—Continued:

17 U.S.C. 205 ..... 28, 37
17 U.S.C. 405 36
17 U.S.C. 406 29
17 U.S.C. 407 37
17 U.S.C. 408 ..... *passim*
17 U.S.C. 409 ..... 3, 15, 20, 28
17 U.S.C. 410 ..... *passim*
17 U.S.C. 411 ..... *passim*
17 U.S.C. 412 ..... 7, 29, 32, 33
17 U.S.C. 504 7
17 U.S.C. 505 7
17 U.S.C. 705 28
17 U.S.C. 708 31
28 U.S.C. 1914 46
Artists' Rights and Theft Prevention Act of 2005, Pub. L. No. 109-9, 119 Stat. 218 8
Copyright Act of 1970, 17 U.S.C. 13 39
Copyright Act of 1976, 17 U.S.C. 101 ..... 2, 8
Pub. L. No. 100-568, 102 Stat. 2853 12

Other Authorities:

37 C.F.R. 202.16 26
46 Fed. Reg. 28,846 (May 29, 1981) 35, 36
Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (1958) 5, 9, 41, 49
Black's Law Dictionary (revised 4th ed. 1968) 14, 19, 31, 34
Caruthers Berger, *Study No. 18: Authority of the Register of Copyrights to Reject Applications for Registration* (1959) ..... *passim*
Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law (Comm. Print 1961) 3

Other Authorities—Continued:

Dotan Oliar & Nicholas Matich, *Copyright Preregistration: Evidence and Lessons from the First Seven Years, 2005-2012*, 55 Ariz. L. Rev. 1073 (2013) 8
Dotan Oliar, Nathaniel Pattison & K. Ross Powell, *Copyright Registrations: Who, What, When, Where, and Why*, 92 Tex. L. Rev. 2211 (2014) 6
H.R. Rep. No. 388, 103d Cong., 1st Sess. (1993) ... 12, 24, 49
H.R. Rep. No. 609, 100th Cong., 2d Sess. (1988) 45
H.R. Rep. No. 1476, 94th Cong., 2d Sess. (1976) ..... *passim*
H.R. Rep. No. 7083, 59th Cong., 2d Sess. (1907) 5
Hearing on Oversight of the U.S. Copyright Office Before the Subcommittee on Courts, Intellectual Property, and the Internet, Committee on the Judiciary U.S. House of Representatives, 113th Cong. 4
Preregistration of Certain Unpublished Copyright Claims, 70 Fed. Reg. 42,286 (July 22, 2005) 8, 27, 49
S. Rep. No. 352, 100th Cong., 2d Sess. (1988) ..... *passim*
S. Rep. No. 473, 94th Cong., 1st Sess. (1975) 16
U.S. Copyright Office, *Annual Report of the Register of Copyrights* (1991) 4
U.S. Copyright Office, *Annual Report of the Register of Copyrights* (2009) 5
U.S. Copyright Office, *Annual Report of the Register of Copyrights* (2011) 5
U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* (3d ed. 2017) 24
U.S. Copyright Office, *Fees*, https://www.copyright.gov/about/fees.html 2

Other Authorities—Continued:

U.S. Copyright Office, *Fiscal 2017 Annual Report* 6
U.S. Copyright Office, *Forms*, https://www.copyright.gov/forms/ 3
U.S. Copyright Office, *General Guide to the Copyright Act of 1976* (1977) 25
U.S. Copyright Office, *Preregister Your Work*, https://www.copyright.gov/prereg/ 8
U.S. Copyright Office, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf 5
U.S. Gov't Accountability Office, *Improving Productivity In Copyright Registration* (1982) 4, 35
U.S. Judicial Conference, *District Court Miscellaneous Fee Schedule* (2016) 47
Webster's Third New International Dictionary (1971) 19, 31
William F. Patry, *Patry on Copyright* (2017) 24, 51

In the Supreme Court of the United States

No. 17-571

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE RESPONDENTS

In Section 411(a) of the Copyright Act, Congress imposed a simple administrative prerequisite for filing a copyright-infringement suit: an action may be instituted only once "registration * * * has been made" or "registration has been refused." 17 U.S.C. 411(a). That is it—registration or refusal. An *application* for registration is obviously neither. This case accordingly begins and ends with the plain text.

Petitioner's quixotic effort to argue otherwise would require this Court to jettison that text. Petitioner says that "registration" has nothing to do with the Register; instead, a copyright owner alone makes registration merely by filing an application. But petitioner's effort to

equate "registration" with "an application for registration" defies ordinary meaning and would render superfluous multiple provisions in the Copyright Act.

When a statute's language is as clear as Section 411(a), no plumbing of Congressional intent or searching of the Congressional record is necessary—but here the harmony between text, history, and policy is satisfying. Congress's choice to condition the right to sue upon the administrative finality of registration or refusal was no mistake; it was the result of two decades of formal study of copyright reform. Ultimately, Congress was choosing between making copyright registration mandatory, making it permissive, or eliminating a public registration system entirely. It chose the middle ground, with a nudge: making registration permissive but encouraging promptness.

Petitioner wants a different regime—one narrowly focused on making life as easy as possible for copyright plaintiffs. But its policy arguments amount to an insistence that Congress simply cannot have meant what it said. It did, and for good reason. Petitioner's myopic policy preferences fail to account for the systemic benefits of registration. And upon inspection, its parade of horribles is mere tilting at windmills. In the end, only Congress is suited to resolve the policy tradeoffs inherent in *any* system of copyright registration. And it decided an application alone could not unlock the courthouse doors.

STATEMENT

A. Statutory Background

1. The Copyright Act of 1976, 17 U.S.C. 101 *et seq.*, comprises the most recent wholesale revision of U.S. copyright law. It embodies the heady idea that a carefully balanced system of copyright sanctions and incentives can promote creation, growth, and advancement of our civil

society. Put another way, the copyright laws exist to benefit the public at large: "As reflected in the Constitution, the ultimate purpose of copyright legislation is to foster the growth of learning and culture for the public welfare, and the grant of exclusive rights to authors for a limited time is a means to that end." *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law* 5 (Comm. Print 1961) ("1961 Report").

a. Under the Copyright Act, copyright owners have certain "exclusive rights" in "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. 102, 106. "Registration is not a condition of copyright protection," 17 U.S.C. 410(a), but Congress provided multiple incentives to encourage creators to promptly apply.

To that end, the Act specifically addresses both the application process and the standards for the Register to use in making registration determinations:

Section 409, titled "Application for copyright registration," provides that "[t]he application for copyright registration shall be made on a form prescribed by the Register of Copyrights." The basic application forms are available on the Copyright Office website. See U.S. Copyright Office, *Forms*, https://www.copyright.gov/forms/. The forms request routine information such as the author's name and title of the work. None of the five basic forms exceeds two pages. Fees for basic registrations range from $35-$85, depending on the type of work and form of application (*i.e.*, paper vs. online). See U.S. Copyright Office, *Fees*, https://www.copyright.gov/about/fees.html.

Section 410, titled "Registration of claim and issuance of certificate," governs the Register's registration decision. The Register must "register the claim" if, "after examination, the Register of Copyrights determines that * * * the material deposited constitutes copyrightable

subject matter and that the other legal and formal requirements of this title have been met." 17 U.S.C. 410(a). The Register must "refuse registration" if she "determines that * * * the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason." 17 U.S.C. 410(b).[1]

b. The time it takes for the Copyright Office to process a claim has fluctuated over the years, varying with factors like new technology and staffing cuts (or additions). At the time Congress drafted the Copyright Act, processing times were considerably shorter—no more than a few weeks for claims not involving correspondence. U.S. Gov't Accountability Office, *Improving Productivity In Copyright Registration* 3 (1982) ("GAO Report") (ranging from 1-2 weeks in 1957 to 5-6 weeks in 1981).

The Copyright Office occasionally has sought fee increases to cope with increased workloads. For example, the Office cut processing times for routine claims in half (from 12 weeks to 6) using extra funding from the Copyright Fees and Technical Amendments Act of 1989. U.S. Copyright Office, *Annual Report of the Register of Copyrights* 1 (1991).

And in 2014, the Register testified to Congress that "[t]he registration program has been decimated by budget cuts and early retirement packages and has forty-eight vacancies out of a staff of 180 experts. * * * The pendency time for processing registration claims is a source of constant concern." *Hearing on Oversight of the U.S. Copyright Office Before the Subcommittee on*

---

[1] "The effective date of a copyright registration" is not the date of approval but rather the date that the "application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. 410(d).

Courts, Intellectual Property, and the Internet, Committee on the Judiciary U.S. House of Representatives, 113th Cong. 9 (2014) (Statement of Maria A. Pallante, Register of Copyrights and Director of the U.S. Copyright Office).[2]

Given chronic understaffing and budget cuts, processing times are far longer today than when the Act was passed. See U.S. Copyright Office, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf. But the Copyright Office offers expedited processing through which an author may obtain registration within a matter of days (typically five) in exchange for an additional fee. See U.S. Copyright Office, *Special Handling: (Circular 10)* 2 (2017).

c. Congress wanted to encourage registration for good reason. Registration provides multiple benefits to copyright owners, the public, and the copyright system, including the litigation process. See, *e.g.*, S. Rep. No. 352, 100th Cong., 2d Sess. 19 (1988); H.R. Rep. No. 7083, 59th Cong., 2d Sess. 8 (1907) (registration operates "[f]or the protection of the public itself").

Among other benefits, registration increases information available to the public, allows the Copyright Office to enforce other requirements of copyright law, gives authors a permanent record of their claims, expands the Library of Congress's collection of works, weeds out improper claims, and assists courts should litigation arise. See, *e.g.*, 1961 Report at 72-73; Benjamin Kaplan, *Study*

---

[2] Petitioner highlights the average 309-day processing time from 2009. Br. 11-12. This cherry-picked statistic misleads through omission—that figure jumped from 81 days in 2007 due to a "steep learning curve following implementation of reengineered processes and new information technology systems." U.S. Copyright Office, *Annual Report of the Register of Copyrights* 47 (2009). By 2011, it had fallen back to 94 days. See U.S. Copyright Office, *Annual Report of the Register of Copyrights* 21 (2011).

No. 17: The Registration of Copyright 41-45 (1958) (the "Kaplan Study"); Dotan Oliar, Nathaniel Pattison & K. Ross Powell, *Copyright Registrations: Who, What, When, Where, and Why*, 92 Tex. L. Rev. 2211, 2216-2220 (2014) (discussing market-based advantages for authors to obtain registration). Because the registration process requires a deposit of the work, it supplies the Library of Congress with a substantial body of original works. *E.g.*, U.S. Copyright Office, *Fiscal 2017 Annual Report* 10 ("The Office forwarded more than 658,045 copies of works with a value of almost $41 million to the Library's collections in fiscal 2017.").

In Congress's view, early registration is important: "To be most useful and reliable as a source of information, registration should be made shortly after the first public dissemination of the work." 1961 Report at 74.

d. Although "registration is not a condition of copyright protection" (17 U.S.C. 410(a)), Congress provided multiple incentives for copyright owners to seek registration as early as possible. *E.g.*, S. Rep. No. 100-352 at 23. Most directly, Congress forbade suit to invoke the Act's remedies until "registration" "has been made" or "has been refused":

> [N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability

> of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue.

17 U.S.C. 411(a). "A certificate of registration satisfies the requirements" of Section 411. 17 U.S.C. 411(b)(1).

A copyright owner who promptly seeks registration also gains additional potential remedies in an infringement lawsuit. Although statutory damages and attorney's fees are generally recoverable (see 17 U.S.C. 504, 505), they are disallowed for infringement before the "effective date" of registration. 17 U.S.C. 412. And the certificate of registration "constitute[s] prima facie evidence of the validity of the copyright and of the facts stated in the certificate" if the certificate is "made before or within five years after first publication of the work." 17 U.S.C. 410(c).

e. Although Congress created a variety of strong incentives to promptly seek registration, it also concluded that in some circumstances the burdens of pre-suit registration outweigh the benefits. And in those circumstances, carefully weighing the tradeoffs, Congress expressly softened the registration prerequisite.

First, the 1976 Act included a provision to address live broadcasts—where it is simply impracticable to make registration, and thereby engage the Act's protections, before transmission. See 17 U.S.C. 411(c). Under that provision, a copyright owner may sue without registration if she (1) notifies the infringer of the broadcast and of her "intention to secure copyright in the work"; and (2) "makes registration for the work * * * within three months after its first transmission." *Id.* This accommodation allows an injunction "to prevent the unauthorized use of the material included in the 'live' transmission." H.R. Rep. No. 94-1476 at 157.

Second, in 2005, Congress added a "preregistration" process to increase protection for "class[es] of works that the Register determines ha[ve] had a history of infringement" before publication. See 17 U.S.C. 408(f); Artists' Rights and Theft Prevention Act of 2005, Pub. L. No. 109-9, Tit. I, § 104(b), 119 Stat. 218, 222. Currently, the classes of works eligible for preregistration are: motion pictures, sound recordings, musical compositions, literary works, computer programs, and advertising or marketing photographs. See U.S. Copyright Office, *Preregister Your Work*, https://www.copyright.gov/prereg/.

Preregistration represented a compromise between representatives of record companies and motion picture studios, who wanted to eliminate entirely "the registration requirement in cases of pre-release infringement," and the Copyright Office, which resisted any weakening of the registration prerequisite. *Preregistration of Certain Unpublished Copyright Claims*, 70 Fed. Reg. 42,286, 42,286 (July 22, 2005); see, *e.g.*, Dotan Oliar & Nicholas Matich, *Copyright Preregistration: Evidence and Lessons from the First Seven Years, 2005-2012*, 55 Ariz. L. Rev. 1073, 1084-1086 (2013).

2. The Copyright Act of 1976 represented a hard-fought, wholesale revision of the copyright laws, and culminated from two decades of study. See H.R. Rep. No. 94-1476 at 47-48. Among other topics, registration alternatives were specifically—and heavily—studied. See, *e.g.*, Kaplan Study; Caruthers Berger, *Study No. 18: Authority of the Register of Copyrights to Reject Applications for Registration* (1959) (the "Berger Study"). As the enacted text shows, Congress ultimately retained a permissive

registration system, but one that encouraged copyright owners to seek registration as soon as possible.[3]

a. The Kaplan Study provided an overview of our country's copyright-law history and exhaustively surveyed the alternative registration schemes of other countries, including countries without "any official registration or recordation." Kaplan Study at 60; see also *id.* at 40 (policymakers must "ask what are the benefits and countervailing disadvantages or demerits of a registration scheme on the present American lines").

It concluded by raising several policy questions that would need to be resolved (*id.* at 64) and remarking that because the United States was likely to retain optional registration, "there will be particular need" to provide "incentives and sanctions * * * to bring about the desired registration." *Id.* at 65.

The Berger Study expressly addressed the effect of registration and its refusal. Berger Study at 94-98. It discussed the "unsettled question" "whether a claimant who has fulfilled the procedural requirements (deposit, application, and fee) for registration but has been refused registration on the ground that the copyright claim is invalid, must first secure registration by a mandamus action against the Register before he can maintain a suit for infringement; or whether he may sue for infringement without registration and have the validity of his claim determined in that suit." *Id.* at 97.

The Berger Study noted that the Register's refusal has value for the public and courts: it "serves to inform applicants and the public of the scope of the copyright law" and assists "courts insofar as they give weight to the

---

[3] These studies were two of many that Congress funded to address "most of the major substantive issues in copyright revision." H.R. Rep. No. 94-1476 at 1.

probative value of registration and the interpretation of the law by the Copyright Office." *Id.* at 95. The study therefore concluded by framing one of the main questions for debate as: "Should registration, *or application therefor*, be a prerequisite to an action for infringement?" *Id.* at 98 (emphasis added).

b. Building on these studies, the Copyright Office reported recommendations to Congress. See 1961 Report at iii-iv. Regarding the broad question whether registration should be mandatory or optional, the Office suggested a compromise under which "registration should not be required to sustain a copyright * * * , but that strong inducements to make registration within a reasonable time should be provided." *Id.* at 73. Regarding "[r]egistration as a prerequisite to suit," the Office recommended retaining "the requirement of registration" because "the registration process identifies unfounded claims and assists the courts in establishing presumptive facts and applying the law." *Id.* at 75.

But the Office also recommended "one important modification" (*ibid.*)—the Office endorsed a system in which either registration *or refusal* was sufficient to permit suit. Specifically, the Office recommended a partial reversal of Judge Learned Hand's ruling in *Vacheron & Constantin Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958). *Vacheron* held that the prior law required "acceptance by the Register" before suit could be filed. 260 F.2d at 641. Thus, according to *Vacheron*, the law prohibited suit "when the Register of Copyrights had refused" the claim. *Id.* at 639. The copyright owner instead had to first seek mandamus to reverse the Register's refusal.

The Office agreed with Judge Hand that the current law required acceptance by the Register before suit, but it described *Vacheron* as "unfortunate" for requiring a

copyright owner to first seek mandamus while infringement might "continue[]." 1961 Report at 75. Accordingly, "[w]here a claimant has deposited the required copies, application, and fee, and registration has been refused, * * * he should be entitled to maintain a suit against an infringer." *Ibid.*

c. Congress followed the Office's recommendations. As the House and Senate Committee Reports explain, the first sentence of the revised Section 411(a) "restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted." H.R. Rep. No. 94-1476 at 157. The second and third sentences, however, "alter the present law as interpreted in *Vacheron*" to permit suit by "a rejected claimant who has properly applied for registration" so that she may challenge the registration issue as part of the infringement suit and without mandamus. *Ibid.*

The enacted text accordingly makes Congress's ultimate choice clear. Faced with three basic options—mandatory registration, no registration system at all, or optional registration with inducements—Congress settled on the middle ground, making registration permissive but providing incentives to seek registration as early as possible, including making registration a prerequisite to suit.

3. Since 1976, Congress has repeatedly considered weakening the registration system, but each time it has retained registration as a prerequisite to suit.

First, the Berne Convention Implementation Act of 1988 amended the copyright laws to enable the United States to adhere to the Berne Convention for the Protection of Literary and Artistic Works, an international copyright-relations treaty. S. Rep. No. 100-352 at 2. The Berne Convention requires the elimination of copyright "formalities" for foreign authors. S. Rep. No. 100-352 at 11. The committee report extensively discussed whether

Section 411(a)'s registration prerequisite imposed an impermissible formality, along with reviewing the costs and benefits of such a prerequisite. *Id.* at 11-26. Congress ultimately exempted foreign authors—hence the limitation in Section 411(a) to "United States works." Pub. L. No. 100-568, § 9(b)(1), 102 Stat. 2853, 2859. But, conspicuously, Congress maintained the requirement for U.S. authors.

Second, the Copyright Reform Act of 1993 would have eliminated the registration requirement entirely, replacing it with a requirement to "submit[] an application for registration." H.R. Rep. No. 388, 103d Cong., 1st Sess. 4 (1993). This amendment "intended to eliminate the last significant vestiges of the formality-based approach to United States copyright law." *Id.* at 9. It was not enacted.

Third, as noted above, in 2005 Congress enacted the preregistration system as a compromise to placate some copyright owners who advocated eliminating the registration prerequisite.

B. Procedural History

1. Petitioner Fourth Estate is an independent news organization that licenses its journalism to other outlets. Pet. App. 15a-16a. Petitioner alleges that Wall-Street.com obtained a license to distribute petitioner's work, but then continued distributing that work after the license expired. *Id.* at 16a. Petitioner sued Wall-Street.com for copyright infringement "immediately" after filing an application for copyright registration with the Copyright Office. *Id.* at 18a. Because the Register had not yet acted on petitioner's application, the district court dismissed the suit under Section 411(a). *Id.* at 13a.

2. A unanimous Eleventh Circuit panel affirmed, joining the Tenth Circuit in requiring the Register to act on a copyright holder's application before suit may be filed. See *La Resolana Architects, PA* v. *Clay Realtors Angel*

Fire, 416 F.3d 1195, 1197 (10th Cir. 2005), abrogated in part on other grounds by *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154 (2010); but see *Cosmetic Ideas, Inc.* v. *IAC/Interactivecorp*, 606 F.3d 612 (9th Cir. 2010) (adopting the application approach); *Positive Black Talk Inc.* v. *Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004) (same), abrogated in part on other grounds by *Reed Elsevier*, 559 U.S. 154.

The Eleventh Circuit held that "the text of the Copyright Act makes clear that the registration approach * * * is correct." Pet. App. 6a. The court reasoned that the "Copyright Act defines registration as a process that requires action by both the copyright owner and the Copyright Office." *Ibid.* The application approach, in contrast, renders meaningless numerous provisions detailing the Register's role in this process. Because the court found the Act's plain language unambiguous, it declined to consider petitioner's policy and legislative history arguments.

3. After the Eleventh Circuit's mandate had issued, the Register refused registration of the articles that respondents had allegedly infringed, explaining that petitioner's "submission does not meet the legal or formal requirements for registration under * * * any * * * application option currently available." U.S. Br. App. 3a. Petitioner had submitted the articles for registration as a "group database."[4] But because there was "no original selection, coordination, and/or arrangement authorship evident in the registration materials," petitioner's "submission is not eligible for registration [as a] group database,

---

[4] According to petitioner, it typically seeks "group registration for databases containing the same type of material at issue here" (Br. 16), rather than seeking registration of the underlying articles as works of original, copyrightable journalism.

* * * as a compilation generally, or as a collective work." U.S. Br. App. 8a.

SUMMARY OF ARGUMENT

This case involves a simple question of statutory interpretation. When Congress provided that a copyright-infringement suit may not "be instituted until * * * registration of the copyright claim has been made" (17 U.S.C. 411(a)), did Congress mean that *applying for* registration was the same thing as *making* registration? As the text, structure, history, and purpose of Section 411(a) all make obvious, it did not.

I.1. This Court's analysis can and should begin and end with the text of Section 411(a). That provision does not say a claimant may file an infringement action upon applying for registration. It says she may do so only once "registration * * * has been made" or "registration has been refused." 17 U.S.C. 411(a). It takes no special powers of divination to understand the meaning of these sentences: the Register's approval or disapproval is needed before suit may be brought.

That is confirmed by the ordinary meaning of "registration"—*i.e.*, "recording" or "inserting in an official register." *Black's Law Dictionary* 1449 (revised 4th ed. 1968). A claim cannot be inserted in an official register without the Register's approval. Nor can anyone but the Register refuse to insert a claim in an official register.

If the text of Section 411(a) weren't enough, the structure of the Act likewise makes clear that action by the Register is necessary before suit may be filed. It is beyond dispute that the process of copyright registration is outlined in the three provisions immediately preceding Section 411(a). First, Section 408 says a copyright owner "may obtain registration of the claim by delivering [an ap-

plication and supporting materials] to the Copyright Office." Next, Section 409, titled "Application for copyright registration," sets out the material to be included in the application. And finally, Section 410, titled "Registration of claim and issuance of certificate," explains the circumstances under which "the Register shall register the claim" (17 U.S.C. 410(a)) and the circumstances under which "the Register shall refuse registration" (17 U.S.C. 410(b)).

The two possible outcomes under Section 410—registration or refusal—map perfectly onto the requirements of Section 411(a). It is unquestionably "the *Register*" who "shall register" or "refuse registration" under Section 410. 17 U.S.C. 410 (emphasis added). So too in Section 411(a); the Register's role in registering or refusing a claim does not somehow vanish from one provision to the next.

In short, to resolve this case, the Court need only read the words of the statute and give them their ordinary, common-sense meaning. Doing so permits one result: "registration" requires registration, not just application.

2. Petitioner's approach takes this simple exercise and tortures it. Rather than reading the words of Section 411(a) and giving them their natural meaning, petitioner bends over backwards to read "make registration" to mean "apply for" registration.

Petitioner does so based on a search through the Copyright Act that seems to look everywhere but Section 411(a) itself. Indeed, other than a single sentence at the outset of its argument (Br. 22), petitioner analyzes no fewer than *seven* other provisions of the Copyright Act before turning to Section 411(a)'s text (Br. 22-29). And at no point in its brief does petitioner even quote the two operative sentences of Section 411(a) together. This attempt to direct the Court's attention everywhere *but* Section

411(a) is little wonder: the ordinary meaning of that provision precludes petitioner's wishful reading.

But it is not just ordinary meaning that petitioner's approach offends; the application approach would also render numerous provisions of the Copyright Act—including part of Section 411(a) itself—meaningless. To give just one example: if petitioner were correct that "making" registration is the same as "delivering the deposit, application, and fee required for registration," then the second sentence of Section 411(a) would effectively read: "In any case, however, where *registration has been made* and *registration has been refused*, [suit may be filed]." In other words, under petitioner's approach, the statute descends into incoherence and contradiction.

II. The history of the Copyright Act confirms respondents' common-sense interpretation. In passing the 1976 revision, Congress exhaustively considered *whether* to make registration a prerequisite to suit, but it never questioned what that requirement entails. Congress expressly recognized, for example, that Judge Hand's decision in *Vacheron*, 260 F.2d at 640-641 (holding that "acceptance by the Register" was a prerequisite to suit), articulated the background law upon which it was legislating.

Although Congress partially abrogated *Vacheron* by permitting suit if the Register refuses registration, it explained that "[u]nder the bill, *as under the law now in effect*, a copyright owner who has not registered his claim * * * cannot enforce his rights in the courts." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 157 (1976) (emphasis added); S. Rep. No. 473, 94th Cong., 1st Sess. 139 (1975); see also H.R. Rep. No. 1476 at 157 (recognizing that "[t]he second and third sentences of [S]ection 411(a) would alter the present law as interpreted in *Vacheron*" by permitting the claimant to file suit after the Register refuses regis-

tration, rather than having to first mandamus the Register). The Act's history thus confirms that Congress required action by the Register—not mere application—before suit may be filed.

III. At bottom, petitioner is attacking Congress's policy judgment of how to balance the various incentives surrounding registration. Although petitioner tries to cram its argument into a statutory-interpretation framework, its true aim is a significant policy change—the relaxation of the registration requirement. But Congress exhaustively considered, over the course of two decades, the various intricacies of a registration system, and it plainly made *registration*, not an application for registration, a prerequisite to suit. In the policymakers' considered judgment, that prerequisite was the better way to encourage copyright owners to seek registration as early as possible.

Tellingly, the driving force behind petitioner's position is the length of time it takes the Register to process copyright claims. But, as petitioner effectively concedes (Br. 42 & n.28), processing times were substantially shorter when Congress passed Section 411(a). Although lack of funding and an increased workload have since increased those times, the meaning of statutory text does not change with the vagaries of congressional funding.

Petitioner wishes it could file suit before obtaining registration and that the Copyright Office were more efficient. Those may be reasonable desires, but they have nothing to do with the meaning of the words that Congress selected. Section 411(a) demands that a copyright owner await the Copyright Office's decision before filing suit. If circumstances have changed such that the burden on copyright owners of awaiting registration now outweighs the benefit to the public of a robust registration system, Congress can rewrite the law. This Court's task, however, is different: it must apply the law that Congress

has already written. Under that standard, the court of appeals' judgment should be affirmed.

ARGUMENT

I. THE COPYRIGHT ACT CLEARLY REQUIRES THE REGISTER OF COPYRIGHTS TO APPROVE OR REFUSE A CLAIM BEFORE AN INFRINGEMENT SUIT MAY BE BROUGHT

This Court begins any statutory interpretation case with the relevant enacted text. See, *e.g.*, *Puerto Rico* v. *Franklin Cal. Tax-Free Trust*, 136 S. Ct. 1938, 1946 (2016). To be sure: petitioner pays lip service to that axiom, beginning its argument by asserting that "the phrase 'registration . . . has been made' in § 411(a) refers to the actions of the copyright owner in submitting the deposit, application, and fee required for registration, not to a later determination by the Register." Br. 21. Tellingly, however, petitioner fails to quote the two operative sentences of Section 411(a) together *at any point* in its 11-page statutory analysis. See Br. 21-32. Those sentences provide:

> [N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights.

17 U.S.C. 411(a).

Petitioner shuns that text for good reason. The relevant phrase ("registration of the copyright claim has been

made in accordance with this title") has an obvious, common-sense meaning: the recording of a copyright by the Register after examining a properly filed application. The application approach urged by petitioner reflects a policy preferred by some stakeholders—such as its *amici*. But, as the text of the Copyright Act makes clear, it is a policy that was *rejected* by Congress.

A. The Unambiguous Text Of Section 411(a) Forecloses Petitioner's Application Approach.

When analyzing statutory text, this Court gives "each word its 'ordinary, contemporary, common meaning.'" *Star Athletica, LLC* v. *Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (citation omitted). When the "'language is plain,'" "that 'is also where the inquiry should end.'" *Franklin Cal.*, 136 S. Ct. at 1946 (citation omitted).

1. a. Begin with the ordinary meaning of the term "registration." Cf. *Life Techs. Corp.* v. *Promega Corp.*, 137 S. Ct. 734, 739 (2017) (using dictionary definitions to determine "ordinary meaning" of undefined term in the Patent Act). That word connotes official action by the government and thus requires registration *by the Register*.

At the time of the Copyright Act's enactment, "registration" meant "[r]ecording" or "inserting in an official register." *Black's Law Dictionary* 1449 (revised 4th ed. 1968); see also, *e.g.*, *Webster's Third New International Dictionary* 1912 (1971) ("an act or the fact of registering"; "something registered"). Only the Register can "record[]" the claim or "insert[]" it "in an official register." The copyright owner's application represents one, earlier step in the process. But registration cannot actually be "made" until the Register approves. See, *e.g.*, *Freeman* v. *Quicken Loans, Inc.*, 132 S. Ct. 2034, 2042 (2012) ("[I]t is normal usage that, in the absence of contrary indication, governs our interpretation of texts.").

b. The second sentence of Section 411(a) removes any conceivable doubt about the meaning of the first. It provides that where the application has been delivered and "registration has been refused, the applicant is entitled to institute" suit. 17 U.S.C. 411(a).

As this Court has explained, this second sentence of Section 411(a) permits suits "involving *unregistered* works * * * where the holder attempted to register the work and registration was refused." *Reed Elsevier*, 559 U.S. at 165 (emphasis added). The second sentence thus constitutes an exception to the registration prerequisite—not, as petitioner contends, "a subset of those cases where "'registration * * * has been made'" (Br. 30). See S. Rep. No. 100-352 at 13-14 & n.2 ("Section 411(a) contains an *exception* in the case of a work as to which the copyright proprietor has *sought* to register a claim, but the Copyright Office has refused to issue a certificate of registration." (emphases added)). The second sentence of Section 411(a) also provides critical context for the first. Petitioner cannot but concede that it is the Register who "refuses" registration. It is thus only natural that it is the Register who "makes" registration as well. One way or another, the Register must act before suit may be filed.

c. That common-sense interpretation is reinforced by the requirement that registration be made "in accordance with this title." 17 U.S.C. 411(a). For a valid registration, Title 17 demands actions not only by the copyright owner but also by the Copyright Office.

The process of copyright registration is set forth in the three consecutive provisions immediately preceding Section 411(a). First, Section 408 says a copyright owner "may obtain registration of the claim by delivering [an application and supporting materials] to the Copyright Office." Next, Section 409, titled "Application for copyright registration," sets out the material to be included on "[t]he

application for copyright registration." And finally, Section 410, titled "Registration of claim and issuance of certificate," explains the circumstances under which "the Register shall register the claim" (17 U.S.C. 410(a)) and those circumstances under which "the Register shall refuse registration" (17 U.S.C. 410(b)). See *Merit Mgmt. Grp., LP* v. *FTI Consulting, Inc.*, 138 S. Ct. 883, 893 (2018) ("Although section headings cannot limit the plain meaning of a statutory text, 'they supply cues' as to what Congress intended" (citations omitted)).

The two possible outcomes under Section 410 map directly onto Section 411(a). It is unquestionably "the Register" who "shall register" or "refuse registration" under Section 410. 17 U.S.C. 410. That does not somehow change in Section 411(a), the very next provision. Thus, while suit is permissible regardless of how the Register acts—*the Register must act.*[5]

2. Petitioner makes a clever but specious attempt to reconcile the second sentence of Section 411(a) with its application approach. See Br. 29-32. According to petitioner, "registration" is "made" in the first sentence of Section 411(a) upon delivery of the application materials. If "registration" is subsequently "refused," petitioner argues, the second sentence demands only that the plaintiff notify the Copyright Office of the infringement suit. Br. 30. In other words, the second sentence merely "imposes" "an additional requirement" where the Register ultimately refuses registration. *Ibid.* Petitioner's reading is indefensible.

---

[5] Petitioner argues (at 22) that the caveat "in accordance with this title" "turns on" solely *the copyright owner's* "compli[ance]" with the Copyright Act. But registration requires more than the owner's actions; it does not occur until the Register approves and "register[s] the claim." 17 U.S.C. 410(a). Petitioner has no basis for excising Section 410 fr m "this title."

a. As an initial matter, petitioner's proposed reading of the phrase "registration has been made" in the first sentence of Section 411(a) would render the second sentence incoherent. In petitioner's view, the phrase "registration has been made" in the first sentence has the same meaning as the phrase "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form" in the second. Br. i. The two phrases should accordingly be interchangeable. But substituting "registration has been made" into the second sentence of Section 411(a) would render that sentence incomprehensible:

> In any case, however, where ~~the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form~~ *registration has been made* and registration has been refused, the applicant is entitled to institute a civil action for infringement.

It hardly bears noting that registration cannot be both made *and* refused. Petitioner's reading would accordingly make Section 411(a) internally incoherent.

Petitioner's view also creates a second contradiction: registration could only ever be "refused" *after* it had already been "made." Registration, in petitioner's view, is "made" upon application, and application by necessity occurs before refusal. But how can registration be refused once it has been made?

b. Petitioner can avoid this conundrum only by assigning two different meanings to the word "registration" in Section 411(a)'s first and second sentences. In the first sentence, "registration" would connote actions of the copyright owner alone, yet in the second sentence petitioner concedes that "registration" involves the Register, who "shall refuse registration" when "the material deposited does not constitute copyrightable subject matter or * * *

the claim is invalid for any other reason." 17 U.S.C. 410(b). The Court should not interpret "registration" in consecutive sentences, linked by the word "however," to both include *and* exclude the Register's actions. See *Hall* v. *United States*, 566 U.S. 506, 519 (2012). Petitioner cannot untangle this knot by equating "registration" with the "deliver[y] [of] the required application, deposit, and fee" (Br. i) because the Register is not refusing that delivery; she is determining that the copyright claim represented by that application is invalid. 17 U.S.C. 410(b).

c. Petitioner's approach would also render the second sentence of Section 411(a) superfluous. If an application entitles a copyright owner to sue under the first sentence, then the owner has the right to sue regardless of the Register's action. There would be no need to provide an "entitle[ment] to institute" suit should the Register later "refuse" registration.

Petitioner's interpretation of Section 411(a) therefore violates the full panoply of cardinal principles of statutory construction—that statutory language should be read for coherence, not incoherence; that identical words should carry identical meanings, not different ones; and that statutes should be read to give effect to all provisions, not render them superfluous. These principles should hold particular force in interpreting *consecutive*, *linked* sentences appearing in the *same* provision. And petitioner's approach offends them all.[6]

---

[6] On top of these fatal defects, petitioner's reading of Section 411(a) suffers still another critical flaw—it defies the ordinary meaning of the second sentence's language. The text contemplates that the sequence of events entails first the refusal of registration, *then* filing suit: "where * * * registration *has been refused*, the applicant is entitled to *institute* a civil action for infringement." 17 U.S.C. 411(a)

3. At the end of the day, the best reading of the statute is the obvious one: suit may not be "instituted" until the Register has "made" or "refused" registration. And that, indeed, is how this Court, Congress, and the Copyright Office have *all* interpreted Section 411(a). For example:

This Court characterized the second sentence of Section 411(a) as involving "*unregistered*" claims and allowing suit "where the holder *attempted* to register the work and registration was refused." *Reed Elsevier*, 559 U.S. at 165 (emphases added).

Congressional committee reports have similarly observed: "until the Register of Copyrights has determined that" the claim should be registered, "judicial enforcement of the claim to copyright cannot be obtained." S. Rep. No. 100-352 at 14; see also H.R. Rep. No. 103-388 at 11 (describing Section 411(a) as a "requirement that a registration or refusal to register be obtained from the Copyright Office before an action for infringement be obtained").

And the considered view of the Copyright Office is that "[t]he mere submission of an application to the U.S. Copyright Office does not amount to a registration." U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 625.5 (3d ed. 2017) (the "Compendium"); see

---

(emphasis added). A copyright owner thus may not institute suit before refusal. See 5 William F. Patry, *Patry on Copyright* § 17:78 (2017) (observing that the Copyright Act of 1976 "changed [the operative verb from] 'maintained' to 'instituted' in order to make as clear as possible" that the Register's action must come before suit is filed).

Petitioner nonetheless maintains that refusal can come before or after suit begins, because petitioner sees "no time limit on service of the complaint." Br. 31. That is a non-sequitur. The question of when service must be made to comply with Section 411(a)'s second sentence is distinct from—and entirely unrelated to—the question of whether the Register's refusal must come before suit is instituted.

also, *e.g.*, U.S. Copyright Office, *General Guide to the Copyright Act of 1976* 11:9 (1977) ("The new law also provides that a *rejected* claimant who has properly applied for registration may *bring* an infringement suit if he serves notice on the Register, thus allowing the Register to intervene in on the issue of registrability." (emphases added)), https://www.copyright.gov/reports/guide-to-copyright.pdf; cf., *e.g.*, *Inhale, Inc.* v. *Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041-1042 (9th Cir. 2014) (according deference to the Compendium under *Skidmore* v. *Swift & Co.*, 323 U.S. 134 (1944)); *Olem Shoe Corp.* v. *Wash. Shoe Corp.*, 591 F. App'x 873, 882 n.10 (11th Cir. 2015) (same).

Those sources take Congress to mean what it says. An application for registration is not registration, and registration is not made until the Register registers the claim. Petitioner's contrary view can be squared neither with these sources nor with the text of Section 411(a).

B. Many Other Provisions In The Act Foreclose Petitioner's Application Approach.

Even if petitioner's view could somehow be reconciled with Section 411(a), other parts of the Copyright Act preclude petitioner's effort to interpret "registration" to mean "application for registration." See *Star Athletica*, 137 S. Ct. at 1010.

1. Petitioner's approach would impermissibly eviscerate multiple provisions in the Copyright Act. See, *e.g.*, *Clark* v. *Rameker*, 134 S. Ct. 2242, 2248 (2014) ("[A] statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous." (citation omitted)).

Section 411(b), for example, provides that "[a] certificate of registration satisfies the requirements of this section." 17 U.S.C. 411(b). If an application for registration suffices to satisfy Section 411(a), there would be no reason

for Section 411(b)'s existence. Anytime the Register issued a certificate of registration, the application would have already satisfied Section 411(a). Constructions that create this type of surplusage should be avoided. See, *e.g.*, *La Resolana*, 416 F.3d at 1203 (application approach would make the examination requirement meaningless).[7]

So, too, would petitioner's view render unnecessary the relation-back provision of 17 U.S.C. 410(d). Because seeking registration does not constitute registration, Section 410(d) establishes that "[t]he effective date of a copyright registration" is not the date that registration is "determined * * * to be acceptable for registration," but "the day on which an application, deposit, and fee" is "received in the Copyright office." 17 U.S.C. 410(d). Were registration complete upon application, Section 410(d) would be pointless.

Finally, Section 408(f)'s preregistration system would have little "practical effect" under petitioner's approach. *TRW Inc.* v. *Andrews*, 534 U.S. 19, 29 (2001) (asking whether party's interpretation "would in practical effect render [an] exception entirely superfluous in all but the most unusual circumstances"); see *id.* at 31. Preregistration allows authors of certain works to pursue judicial remedies before their works have been registered. 17 U.S.C. 408(f); 37 C.F.R. 202.16. But if a copyright owner need not wait for the Register to act, the owner would rarely, if ever, need to avail herself of preregistration; she would simply apply for regular registration, then immediately sue.

---

[7] It is no answer that this provision does not become superfluous because the certificate would provide proof that the owner delivered the application material to the Copyright Office. The owner would use the certificate in vanishingly few situations, and the Court avoids interpretations that render provisions "insignificant, [even] if not wholly superfluous." *Duncan* v. *Walker*, 533 U.S. 167, 174 (2001).

Notably, the preregistration system resulted from some copyright owners urging Congress to "remove the registration requirement in cases of pre-release infringement." *Preregistration of Certain Unpublished Copyright Claims*, 70 Fed. Reg. 42,286, 42,286 (July 22, 2005); see *id.* ("Copyright owners persuaded Congress that the existing rules making registration a prerequisite for suit for infringement * * * are unduly burdensome on plaintiffs seeking relief against pre-release infringement in civil suits for copyright."). Congress instead developed preregistration to alleviate these concerns. Petitioner, by contrast, would interpret Section 411(a) to go much further and allow suit merely on filing an application.[8]

2. Petitioner's approach also fails to recognize that Congress knew how to specify *applying* for registration when it wanted to. Indeed, multiple provisions in the Copyright Act distinguish between registration and the application therefor.

For example, Section 408(a) provides that a copyright owner "may obtain registration" "by delivering" the application, deposit, and fee. 17 U.S.C. 408(a). One "obtains" something from someone else. If registration were made upon "deliver[y]" of the application, deposit, and fee, there would be no further "registration" to obtain.

And Section 408(f) *expressly* distinguishes between registration and application for registration. A person who files an infringement action under Section 408(f) must "appl[y] for registration of the work" within

---

[8] Petitioner's view would create an additional strange result. If "registration" is "made" when an author applies for registration, then "preregistration" must be "made" when an author applies for preregistration, because "made" cannot mean two things "at the same time." *Clark* v. *Martinez*, 543 U.S. 371, 378 (2005). But keying preregistration to delivery of the preregistration application would undermine the Register's preregistration determination.

"3 months after first publication." 17 U.S.C. 408(f)(3) (emphasis added). Moreover, if petitioner's interpretation of Section 411(a) is correct, then either "registration" means two different things in these provisions, or Section 408(f)(3) reads absurdly as requiring an "application for application for registration."

The same is true of the last clause in 17 U.S.C. 409: "If an application is submitted for the renewed and extended term provided for in section 304(a)(3)(A) and an original term registration has not been made, the Register may request information with respect to the existence, ownership, or duration of the copyright for the original term." Cf. H.R. Rep. No. 94-1476 at 156 ("The various clauses of section 409, which specify the information to be included in *an application for copyright registration*, are intended to give the Register of Copyrights authority to elicit all of the information needed to *examine the application and to make a meaningful record of registration*." (emphases added)).

3. Finally, petitioner's approach would make nonsense of the Copyright Act's constructive-notice provisions, which plainly contemplate the Register's actions as part of "registration" being "made."

In 17 U.S.C. 205, Congress imposed constructive notice for transfers of copyright ownership recorded in the Copyright Office, provided certain conditions are met. 17 U.S.C. 205(a), (c). One of those conditions is that "registration has been made for the work." 17 U.S.C. 205(c). Without registration *by the Copyright Office*, providing for constructive notice would make no sense—there is no good reason to charge a person with constructive notice as of the day a copyright owner delivers application materials, when that person would have no reason to know that such delivery had occurred. Cf. 17 U.S.C. 705 (requiring

the Register to "open to public inspection" "records of deposits, registrations, recordations").

17 U.S.C. 406 gives infringers a "complete defense" to infringement in certain circumstances where the infringer "was misled by the copyright notice," 17 U.S.C. 406(a), but that defense is unavailable if the infringing conduct began before "registration for the work had been made," 17 U.S.C. 406(a)(1). Again, it makes no sense to undercut the defense based on the occurrence of an event—delivery of application materials—that the innocent infringer had no reason to know.[9]

C. Petitioner's Reliance On The Phrase "Makes Registration" Is Misplaced

There can be little doubt that the Register registers copyright claims. Petitioner's approach eschews this obvious meaning in favor of a scavenger hunt through the Copyright Act, searching for language that it thinks is ambiguous enough to obfuscate the issue. But this is ultimately an exercise in hiding the ball.

Petitioner indeed obscures the very position for which it is advocating, laboring mightily to avoid calling it the "application" approach, even though that is the common nomenclature. See, *e.g.*, ABA Br. 3; Int'l Trademark Ass'n Br. 7; Copyright Alliance Br. 3-4. Petitioner, unlike some

---

[9] Petitioner responds that the defense disappears upon delivery under either the application approach or the registration approach because, petitioner claims, the petitioner loses the defense as of "the 'effective date of a copyright registration.'" Br. 25 (quoting 17 U.S.C. 410(d)). Petitioner again strays from the text. Unlike some provisions that sensibly incorporate the effective date under Section 410(d), Section 406(a)(1) instead pegs its operation exactly to when registration is made—and for good reason, given the logic of constructive notice. Compare, *e.g.*, 17 U.S.C. 412 (allowing statutory damages backdated to "the effective date"); *infra* at 32-33.

of its *amici*, likely recognizes the jarring disconnect between equating "registration" with "application."

But attempt to equate them it does. Petitioner seizes on the phrase "make registration" (and its passive-voice counterpart), which petitioner says "refer to the action of the copyright owner and not to the action of the Copyright Office." Br. 21. That contention flouts the ordinary meaning of that phrase and misconstrues the provisions in which it is used.

1. Petitioner's position rests on the idea that there is a material difference between the phrase "make registration" and the term "register." Petitioner again runs headlong into the words' plain meaning.

The term "make registration" is essentially equivalent to the verb "register": "When 'make' is paired with a noun expressing the action of a verb, the resulting phrase is 'approximately equivalent in sense' to that verb." *Janus Capital Grp., Inc.* v. *First Derivative Traders*, 564 U.S. 135, 142 (2011) (quoting 6 Oxford English Dictionary 66 (def. 59) (1933)); cf. *Reves* v. *Ernst & Young*, 507 U.S. 170, 177 (1993) (where statute used same word twice as a noun and a verb, explaining that "it seems reasonable to give each use a similar construction").

Yet petitioner concedes that "the Copyright Office 'register[s] [a] claim.'" Br. 19 (quoting 17 U.S.C. 410(a)) (alterations in original). "Make registration" accordingly has no special meaning. The Register, naturally, plays a necessary part in registering claims; so, too, does she play a necessary part in making registration.

2. To the extent that "make registration" (or its variants) in any part of the statute incorporates actions of the copyright owner, that does not mean the Register plays no part.

Registration is not "made" until the claim is formally recorded or inserted. Again, the ordinary meaning of

"make" shows why: "To cause to exist" or "To form, fashion, or produce; to do, perform, or execute." *Black's Law Dictionary* 1107; see, *e.g.*, *Webster's Third New International Dictionary* 1363 (1971) (defining "make" as "to cause to exist, occur, or appear: to bring to pass" or "to cause to be or become" or "to carry out (an action indicated or implied by the object)").

A claimant has not "produced" registration or "caused it to exist" until the Register registers the claim. Cf. *Webster's Third New International Dictionary* 1912 (1971) (defining "register" as "to make or *secure* an official entry of in a register" (emphasis added)).

Given the ordinary meaning of these words, it is unsurprising that petitioner's purported distinction between "make registration" and "registration" fails on its own terms. For instance, as discussed above, the constructive-notice provisions of 17 U.S.C. 205 and 406 use variants of "make registration" that *necessarily* incorporate the Register's actions. And as petitioner itself recognizes, in 17 U.S.C. 708(a), the phrase "'registration is made' is used to mean 'registration is granted by the Copyright Office.'" Br. 27.

The bulk of petitioner's brief is therefore devoted to proving a proposition that does not matter, namely, that the statute or some other source refers to the copyright owner registering a claim. The "flexibility" in the word "registration" (Br. 28) reflects only that it can take different entities as subjects in a sentence. But under that word's ordinary meaning and as it is used throughout the Act, it necessarily includes the Register's approval.

These principles demonstrate why petitioner's university class-registration hypothetical (Br. 28) is ill-conceived. True enough, a student might fill out the registration form online and tell a friend that she "registered" for classes; but if she receives a notice from the university

registrar informing her that she did not get into a course, the student would not still tell the friend that she "registered" for that class. Rather, she would say she had *tried* to register. Registration is not "complete" (Br. 28) until accepted. This Court spoke in similar terms in *Reed Elsevier*, explaining that Section 411(a) allows suit "where the holder *attempted to register* the work and registration was refused." 559 U.S. at 165 (emphasis added). If delivering the application *accomplished* registration, there would be more than a mere "attempt[]" to register.

D. Petitioner's Scavenger Hunt Through The Act Is Unavailing At Every Turn

Petitioner nonetheless attempts to justify its strained "make"-means-"apply for" reading by scouring the Act for provisions purportedly restricting "registration" being "made" to the copyright owner's acts alone. But as respondents detail below, petitioner flouts the plain text of those provisions in each and every instance. Indeed, however many provisions petitioner asks this Court to wade through—however far from Section 411(a) petitioner strays—it simply cannot avoid the plain meaning of Section 411(a)'s text.

1. Petitioner first cites 17 U.S.C. 412, which allows statutory damages if "registration is made within three months after the first publication of the work." Petitioner argues that Section 412 must refer solely to an application because the Register's action "may be delayed due to no fault of the copyright owner." Br. 24.

Petitioner misreads the statute, which conditions statutory damages on "the effective date of [the work's] registration": Statutory damages are unavailable for "any infringement of copyright commenced after first publication of the work and before the *effective date of its registration*, unless *such registration* is made within three months after the first publication of the work." 17 U.S.C.

412(2) (emphases added). The modifier "such" shows that the statute is referring to registration with an "effective date" "within three months after first publication." *Ibid.* And under Section 410, the "effective date" is keyed to the copyright owner's actions, not the Register's. Petitioner's complaint about respondents' reading interfering with this "grace period" (Br. 24)—because the Register might wait more than three months to act—thus rings hollow.[10]

In any event, petitioner's argument about Section 412 is another that fails on its own terms. The only reason petitioner offers for Section 412 to support its interpretation is that "the Copyright Office may—and usually does—act later" than the three-month window. Br. 24. But at the time of the Copyright Act's enactment, the Copyright Office usually acted within that window. See *supra* at 4; *infra* at 48. How quickly petitioner's argument about Section 412 would disintegrate if the Copyright Office, with the help of more funding, had maintained its historic efficiency. Cf., *e.g.*, Br. 42 & n.28; *supra* at 4 (noting that additional staff members, added via a copyright fee increase authorized by Congress, spurred the Office to cut processing time for routine claims from 12 weeks to 6).

Petitioner's Section 412 argument is thus emblematic of the fundamental flaw in its position: the meaning of words don't change based on congressional funding. Yet petitioner's primary attack on the registration approach is that it cannot be squared with the delay in processing claims. If the Office is not as quick as it once was, that is a concern for Congress—not this Court.

---

[10] Even petitioner does not think its argument holds water. Elsewhere petitioner admits that Section 412 "expressly authorizes [statutory damages] for infringement after the 'effective date' of registration." Pet. 25 n.19 (emphasis added). Any delay from the Register is thus irrelevant under petitioner's own view.

2. Petitioner next discusses Section 411(c), which allows copyright owners to obtain pre-broadcast injunctions against potential infringement of live broadcasts, but requires "the copyright owner" to "make[] registration for the work * * * within three months after its first transmission." 17 U.S.C. 411(c)(2).[11]

Petitioner emphasizes that Section 411(c)(2) uses the "active-voice construction[] with 'the copyright owner' as the subject." Br. 22. Petitioner infers from that grammatical construct that registration results from the copyright owner's acts alone. But that conclusion does not follow. As discussed *supra* at 30-31, registration is not "made"—*i.e.*, secured—until the Register has "insert[ed]" the claim "in [the] official register." *Black's Law Dictionary* 1449 (revised 4th ed. 1968); see, *e.g.*, 17 U.S.C. 410. Petitioner's contrary view again contravenes the ordinary meaning of these words.[12]

The exceptional nature of Section 411(c)'s remedies shows there is good reason that Congress insisted that the Register act and thereby complete registration. Section 411(c) "deals with the special situation presented by

---

[11] The relevant text of Section 411(c):

> In the case of a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission, the copyright owner may, either before or after such fixation takes place, institute an action for infringement * * * if * * * the copyright owner—
>
> (1) serves notice upon the infringer * * *; and
>
> (2) makes registration for the work, if required by subsection (a), within three months after its first transmission.

17 U.S.C. 411(c).

[12] Section 411(c) likely makes the copyright owner the subject for ease of drafting—"copyright owner" is the subject for both (c)(1) and (2), and the action in subsection (2), "serv[ing] notice on the infringer," can truly only be done by the owner. See 17 U.S.C. 411(c).

works that are being transmitted 'live' at the same time they are being fixed in tangible form for the first time" and thus allows the copyright owner to obtain an injunction "to prevent the unauthorized use of the material included in the 'live' transmission." H.R. Rep. No. 94-1476, at 157; see 46 Fed. Reg. 28,846 (May 29, 1981).

Given that special situation, Section 411(c) creates a narrow but powerful *exception* to the registration prerequisite—permitting a claimant to seek injunctive relief under the Act without first obtaining registration, so long as registration is later completed within three months of transmission. See *Reed Elsevier*, 559 U.S. at 165 (characterizing Section 411(c) as one "exception[]" to "§ 411(a)'s registration requirement"). And to prevent powerful stakeholders (like professional sports interests) from abusing Section 411(c), it is entirely logical that Congress desired the Register's input in such cases. Cf., *e.g.*, *EMI Christian Music Grp., Inc.* v. *MP3tunes, LLC*, 844 F.3d 79, 97 (2d Cir. 2016) (affording *Skidmore* deference to the Register's registration decisions); *Varsity Brands, Inc.* v. *Star Athletica, LLC*, 799 F.3d 468, 479 (6th Cir. 2015), aff'd sub nom. *Star Athletica, L.L.C.* v. *Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017). Although processing times have increased since 1976, Congress likely envisioned an examination period of only a few weeks. Cf. GAO Report at 3. A diligent applicant could easily secure registration within three months.

In any event, petitioner's argument fails regardless of the Copyright Office's speed. Given that the Copyright Office and all relevant stakeholders understood that the purpose of Section 411(c) was to enjoin infringement of live broadcasts (for example, the Super Bowl), no ongoing infringement suit is necessary, as an injunction at the time of broadcast adequately protects the copyright holder's interests. Thus, in the mine-run case, the copyright holder

need not seek registration at all.[13] And in the rare case where an ongoing suit is necessary, special handling on an expedited basis is of course available.

3. Petitioner doubly misinterprets Section 408(c)(3)'s provision for single registration for multiple works by the same author. Petitioner claims that "registration is again 'made . . . by the author'" (Br. 25) (alteration in original), but that ellipsis is critical—as petitioner recognizes in the same paragraph, this subsection provides that "a single renewal registration may be made for a group of *works by* the same individual author." 17 U.S.C. 408(c)(3) (emphasis added). The prepositional phrase "by the same individual author" modifies "works," not "made." The "author" is not registering anything; she is creating the work. Further, that registration is "made" "upon the filing of a single application and fee" (*ibid.*) shows only that a *single* application and fee are required despite the presence of multiple works. As with "registration" as it appears throughout the Act, the Register remains necessary for registration.

4. Petitioner also thinks 17 U.S.C. 405(b)—one of the Copyright Act's constructive-notice provisions—helps its case because that section refers to registration having "been made under Section 408," while Section 408 in turn

---

[13] That is what stakeholders themselves told the Copyright Office. For example, in response to the Register's 1981 Notice of Proposed Rulemaking regarding Section 411(c),

> [c]omments submitted on behalf of the professional sports interests * * * argued that the registration requirement is triggered only if the author or copyright owner proceeds to file an action for infringement. They indicated that they do not intend to register every work that is mentioned in [a pre-broadcast injunction], but will of course register the works if an infringement action is brought.

46 Fed. Reg. at 28,847. The Register accepted this view and thus declined to require registration anytime a copyright holder obtained a time-of-broadcast injunction. *Ibid.*

"describes how the *copyright owner* 'may obtain registration.'" Br. 25 (quoting 17 U.S.C. 408(a)). But, as discussed above, under Section 408, a copyright owner "obtain[s] registration" only once the Register approves. Before the Register acts, registration remains uncertain—the owner may *or may not* obtain registration. See 17 U.S.C. 410(a), (b).

5. Petitioner's reliance on 17 U.S.C. 205 again excludes the Copyright Office from "registration" without any textual support for doing so. Br. 26-27. This provision says that "[r]ecordation of a document * * * gives all persons constructive notice of the facts" therein if, among other things, "registration has been made for the work." 17 U.S.C. 205(c). As explained above, this provision makes sense only if "registration has been made" when the Register registers the copyright—*i.e.*, when the public would *in fact* have constructive notice of registration.

Moreover, Section 205 expressly contemplates that there may be a gap in constructive-notice protection while the Copyright Office acts—constructive notice arises only "*after* the document is indexed by the Register of Copyrights." 17 U.S.C. 205(c)(1). Petitioner's inventive, four-step hypothetical (Br. 26-27) proves nothing except that Congress could have struck a different balance in Section 205 had it considered that hypothetical and used different words to reach a different policy judgment. Cf. *Lawrence* v. *Florida*, 549 U.S. 327, 335 (2007) ("We cannot base our interpretation of the statute on an exceedingly rare inequity that Congress almost certainly was not contemplating").

6. Similarly, petitioner finds an isolated reference to "any deposit and registration made after th[e] [Copyright Act's effective] date in response to a demand under" the previous statute. 17 U.S.C. 407 note; see Br. 26. (This complicated provision preserves certain remedies from the

1909 Act while also requiring compliance with certain provisions of the 1976 Act.) Petitioner claims that registration must be "made" by the copyright owner because the "owner, not the Copyright Office" "responds to 'a demand.'" Br. 26. But, once more, that does not mean the Register has no role to play in making registration. The copyright owner responds to the demand by initiating the registration process through its application; the Register completes that process by approving, *i.e.*, making, registration.

In sum, nothing about the phrase "makes registration" excludes the Copyright Office. On the contrary, that phrase, just like the word "register" alone, necessarily incorporates the Register's official action.

II. THE HISTORY OF SECTION 411(a)'S ENACTMENT CONFIRMS THAT THE REGISTER MUST APPROVE OR REFUSE A CLAIM BEFORE SUIT MAY BE BROUGHT

The text leaves no doubt that an infringement suit may not be instituted before the Register acts. Because "[t]he text is clear," the Court "need not consider [any] extratextual evidence" of the statute's history and purpose. *N.L.R.B.* v. *SW Gen., Inc.*, 137 S. Ct. 929, 942 (2017).

The history of the Copyright Act of 1976, however, confirms respondents' understanding of the plain text. Congress expressly acted to overturn a Second Circuit holding that forced copyright owners whose registrations had been refused to first seek mandamus to reverse the registration decision before suing for infringement. In doing so, Congress made clear that the Register must act one way or another before suit may be brought.

1. Before the Copyright Act of 1976, the law provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions

of this Act with respect to the deposit of copies and registration of such work shall have been complied with." 17 U.S.C. 13 (1970). Everyone agreed that this meant the copyright owner could sue if the Register had registered the claim.

But courts disagreed about what to do where the Register had refused the claim. The problem was that Section 13 did not expressly permit suit after refusal, so a copyright owner's only recourse was to mandamus the Register. See Berger Study at 97 ("The unsettled question is whether a claimant who * * * has been refused registration on the ground that the copyright claim is invalid, must first secure registration by a mandamus action against the Register before he can maintain a suit for infringement; or whether he may sue for infringement without registration and have the validity of his claim determined in that suit.").

The seminal case, *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958) (Hand, J.), illustrates both sides of the issue. The majority read Section 13 as making "acceptance by the Register" a prerequisite to suit, so Section 13 necessarily prohibited suit "when the Register of Copyrights had refused" the claim. *Id.* at 639-641 (Hand, J.). By contrast, the dissent would have allowed suit "'although registration was refused,'" in the interest of "simple justice" for the copyright owner who otherwise needed mandamus. *Id.* at 645-646 (Clark, C.J., dissenting) (quoting *White-Smith Music. Pub. Co.* v. *Goff*, 187 F. 247, 247 (1st Cir. 1911)).

In reacting to *Vacheron* and writing Section 411(a), Congress made clear that an infringement suit may not be brought until the Register has acted. The committee report explained that "[t]he first sentence of section 411(a)

restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted." H.R. Rep. No. 94-1476 at 157. That confirms that a copyright owner may invoke the first sentence only if the Register has registered the claim. The remainder of Section 411(a) "alter[ed] the present law as interpreted in *Vacheron*." *Ibid.* Under this alteration, "a *rejected* claimant who has properly applied for registration may maintain an infringement suit if notice of it is served on the Register of Copyrights." *Ibid.* (emphasis added).

Therefore, as the enacted text reflects, the first sentence allows suit where the Register has registered the claim, while the second sentence allows suit where the Register has refused the claim, so the copyright owner need not seek mandamus. But nothing in the history suggests that a copyright owner may bring suit before the Register has *either* made or refused registration.

The Copyright Office's recommendations for the 1976 revision underscore this history. Like the committee report, the Register told Congress to retain Section 13's prohibition on suit "until the work has been registered," but to abrogate *Vacheron* to obviate the need to "proceed[] first against the Register." 1961 Report at 75-76.

The Register's reasoning for these recommendations rested on the utility of the Register's registration determination in modulating litigation. As the report explained, "the registration process identifies unfounded claims and assists the courts in establishing presumptive facts and applying the law." *Ibid.* And suit after refusal made sense because the Register would have "the opportunity to advise the court of reasons for refusing registration." *Ibid.*

In either situation, the Register's decision—up or down—is critical.[14]

The text thus reflects the terms of the debate, and Congress made its choice deliberately. It decided to make registration optional with strong incentives for registration. See, *e.g.*, Kaplan Study at 1-27, 46-65 (reviewing alternative approaches). And after considering whether "registration, or application therefor, [should] be a prerequisite to an action for infringement" (Berger Study at 98), Congress made registration, not application therefor, the prerequisite.

2. Petitioner's revisionist history omits key facts. Petitioner's discussion of *Vacheron* ignores the critical context that it addressed how to proceed in the face of the Register's *refusal* and the resulting difficulty of seeking mandamus. As this Court explained, "courts had interpreted" Section 13 "as prohibiting copyright owners who had been *refused* registration by the Register of Copyrights from suing for infringement until the owners *first* sought mandamus against the Register." *Reed Elsevier*, 559 U.S. at 164 (emphases in original). The 1976 Act changed that result by allowing suits "where the holder attempted to register the work and registration was refused." *Id.* at 165. That does not mean Congress intended that a copyright owner could sue before the Register acts.

So while petitioner is correct that "[t]he statute rejects the result reached by the Second Circuit," it is a leap of logic too far to think that Congress dispensed with the Register's action. Br. 34. The goal, unequivocally, was

---

[14] Petitioner plucks a line from the report's summary that says "application for registration would still be a prerequisite to bringing an infringement suit." 1961 Report at vi-vii. As the report disclaims, however, the summary "is necessarily oversimplified." *Id.* at v.

simply to eliminate the need to sue the Register to reverse refusal of registration.

The same misunderstanding infects petitioner's argument that respondents' interpretation "recreates the very problem to which critics of the *Vacheron* rule objected." Br. 35. The *Vacheron* "problem" resulted from copyright owners having no recourse but mandamus where the Register refused registration—*Vacheron* was "unfortunate" only due to "the delay involved in proceeding first against the Register." 1961 Report at 75. The 1976 Act easily and directly solved that issue. But the "studies and reports" (Br. 35) also emphasized the importance of the information gleaned from the registration process, "which assists the courts in establishing presumptive facts and applying the law." 1961 Report at 75; see Berger Study at 97-98. Allowing suit before the Register has acted at all, as petitioner urges, would unacceptably undercut the registration system.

In truth, petitioner's argument is a dressed-up policy complaint about the consequences of the Copyright Office's delay. Petitioner is unhappy that processing times have increased. Br. 36. But as discussed below, that is a funding problem, not an interpretive one. The text and history make clear that Section 411(a) demands the Register's action as a prerequisite to suit. If petitioner wants an application to suffice, Congress must change the law.

III. IF PETITIONER WANTS THE LAW CHANGED OR MORE FUNDING FOR THE COPYRIGHT OFFICE, IT SHOULD ADDRESS CONGRESS OR THE COPYRIGHT OFFICE, NOT THIS COURT

The details of a copyright-registration system—including whether a registration system should exist at all—pose knotty policy questions for lawmakers, issues so contentious and layered that Congress studied them for over two decades before passing the Copyright Act of

1976. And Congress has continued to tweak the Act over the years in response to stakeholder concerns.

On the broad question of the wisdom of a public registration system, Congress opted for permissive registration. On the narrow question at issue here, Congress made registration (or refusal) a prerequisite to judicially enforcing copyright protection. Those two questions are not independent—because Congress made registration optional, it needed to attach strong incentives for authors to seek registration as near as possible to publication. The registration approach thus reflects the sensible compromise between advocates for a strong registration system and those for no registration system, whereas petitioner's application approach would remove a significant registration incentive that underpins Congress's compromise.

Petitioner and *amici* essentially attack Congress's policy choice. They strenuously argue that the application approach better comports with the Copyright Act's purpose and avoids a host of supposed practical problems that infected the prior law. Br. 35-43. To be sure, there were reasonable arguments for Congress to pick an application approach or to eliminate the registration system entirely, and petitioner has done an excellent job covering that side of the debate. But that side lost—in 1976, and also in 1988, 1993, and 2005.

And it should lose in this Court, too, for the current text makes Congress's judgment clear. As the Court has repeatedly reminded litigants, "We are not at liberty to rewrite the statute to reflect a meaning we deem more desirable. Instead, we must give effect to the text Congress enacted * * * ." *Ali* v. *Fed. Bureau of Prisons*, 552 U.S. 214, 228 (2008); see also, *e.g.*, *Henson* v. *Santander Consumer USA Inc.*, 137 S. Ct. 1718, 1725 (2017) ("[W]e will not presume with petitioners that any result consistent with their account of the statute's overarching goal must

be the law but will presume more modestly instead 'that [the] legislature says * * * what it means and means * * * what it says.'" (citation omitted) (alterations in original)); *W. Va. Univ. Hosps., Inc.* v. *Casey*, 499 U.S. 83, 98 (1991) ("[t]he best evidence of [Congress's] purpose is the statutory text").

Indeed, as detailed below, petitioner's "practical problems" (Br. 41) are overstated precisely because the political branches considered them and implemented concessions to alleviate these issues while maintaining a robust registration system. Petitioner and its *amici* obviously wish Congress had chosen differently, but the merits and demerits of a registration system and the consequences of securing (or failing to secure) registration are policy questions for Congress, not the Court. "[I]n light of the tempestuous legislative proceedings that produced the Act," "[t]he present language was clearly the result of a compromise. It is [the Court's] task to give effect to the statute as enacted." *Mohasco Corp.* v. *Silver*, 447 U.S. 807, 818-819 (1980). Petitioner and *amici* should submit their briefs to Congress; here, their arguments fail.

1. The reason petitioner's position came up short in Congress is that it would weaken the registration system and thereby harm the public, even though it might benefit authors. Copyright law does not serve only content creators; far from it, its primary concern is public welfare, and even an author's copyright monopoly "is a means to that [public-service] end." 1961 Report at 5.

As discussed, registration bestows multiple benefits, and forbidding suit until the Register registers (or refuses) the claim vindicates Congress's goal in encouraging registration. Moreover, *early* registration is key: "To be most useful and reliable as a source of information, registration should be made shortly after the first public dissemination of the work." 1961 Report at 74.

The application approach fails to similarly spur registration. It incentivizes copyright owners to wait to seek registration until litigation is imminent. That is suboptimal because the default state of the world is one in which copyright infringement and litigation do not occur. By contrast, respondents' registration approach gives copyright owners one more reason to seek approval of their claims as soon as possible—because they will not know whether they'll ever need to sue for infringement, they must obtain registration as soon as possible to be ready for that later possibility.

What's more, unlike the application approach, the registration approach promotes the benefits of registration that are particular to (potential) litigation, namely, weeding out frivolous claims and shaping issues that must be litigated in any given case. See, *e.g.*, H.R. Rep. No. 609, 100th Cong., 2d Sess. 41-42 (1988) ("If the requirement of registration as a prerequisite to suit were eliminated, there would likely be increased difficulty in trying copyright cases."); *id.* at 41 (the registration requirement "promotes efficient litigation practices, to the benefit of the courts and the public as well as to the parties in the lawsuit"); *id.* at 42 (discussing with approval that "suits have been kept out of court by the necessity of * * * registration and by the unwillingness of potential plaintiffs * * * following the [Register's] refusal to register because of the unfavorable light in which a judge might view the refusal to register and the undesirability of having the Copyright Office intervene in opposition"); 1961 Report at 75 ("Since the registration process identifies unfounded claims and assists the courts in establishing presumptive facts and applying the law, we believe the requirement of registration before suit should be maintained.").

That petitioner's approach would still allow the Register to intervene in an ongoing action is immaterial. Br. 39-

40. Such intervention fails to vindicate Congress's desire to have the Register's input *before* suit is filed (or at the very least before litigation has proceeded too far).

On the author's side, respondents' registration approach also leaves substantial protection for copyright owners who diligently pursue their rights. In the first place, applying for registration is not difficult—it requires completing a short form and paying a small fee. In situations where even that minimal obligation might prove too burdensome, Congress and the Copyright Office have provided accommodations. As discussed, without registration, copyright owners can seek an injunction in advance of a live broadcast. See 17 U.S.C. 411(c). And for multiple categories of works, owners may "preregister" a copyright, even before first publication, in certain circumstances where the delay in obtaining registration could cause irreparable harm (for example, to prevent piracy of highly anticipated movies or musical albums). 17 U.S.C. 408(f).[15]

Additionally, an owner who cannot avail herself of those remedies can use the Copyright Office's "special handling" procedure to obtain registration quickly. See U.S. Copyright Office, *Special Handling: (Circular 10)* 2 (2017). Petitioner counters that expedited handling is impractical because the cost of expediting may be prohibitive to litigants. Br. 41-42. But the $800 special-handling fee is a pittance compared to the cost of litigating a copyright action in federal court, where the case initiation fee *alone* is $400. See 28 U.S.C. 1914(a) ("instituting any civil

---

[15] The Register has the authority to add classes of works eligible for preregistration. 17 U.S.C. 408(f)(2). If stakeholders think that the current categories are underinclusive (*e.g.*, Copyright Alliance Br. 12-13), the proper recourse is asking the Copyright Office to exercise that authority, rather than asking the Court to broadly rewrite Section 411(a).

action" requires "a filing fee of $350"); U.S. Judicial Conference, *District Court Miscellaneous Fee Schedule* (2016), https://goo.gl/mNWFhX (additional $50 "[a]dministrative fee for filing a civil action"). Thus, in the hypothetical case where waiting out the normal process would substantially jeopardize a claim, the special handling fee is at worst a marginal additional burden on the copyright holder.[16] Petitioner complains that even special handling might not "guarantee" resolution "by any deadline" (Br. 42), but there is no reason to think that it will fail an applicant who promptly seeks registration as Congress intended.[17]

As a whole, the registration process and all its permutations and exceptions represent a careful compromise between promoting registration and respecting copyright owners. Respondents' registration approach alone respects that bargain.

2. The bulk of petitioner's and *amici*'s complaints boil down to attacks on the registration system as a whole and unhappiness with the Copyright Office's efficiency. Neither objection has merit.

---

[16] Petitioner argues the expense of expediting is particularly problematic in cases involving multiple works. Pet. 42. But petitioner dramatically overstates the scale of the issue. Petitioner offers no example of this problem, and, again, the Copyright Office has forestalled such concern—in many cases, a group of works (like a musical album, an anthology of poems, or a collection of articles in a periodical) can be expedited together by paying a single fee. See U.S. Copyright Office, ***Multiple Works: (Circular 34)*** 2-4 (2017).

[17] The ABA objects that special handling is an option "only in limited circumstances" like "pending or prospective litigation." ABA Br. 26. But if litigation is neither pending nor prospective, then a copyright owner will not care whether registration is a prerequisite to litigation.

a. Throughout its brief, petitioner bemoans the consequences of the Copyright Office's delay in acting on applications. That the Copyright Office is not as efficient as it once was provides no support for petitioner's interpretation of Section 411(a).

First, Congress was obviously aware that there would be some delay between application and approval. As discussed, where that delay might substantially prejudice a copyright owner, Congress provided various tools—preregistration and immediate suit for live broadcasts—and the Copyright Office offers expedited handling. Like the copyright owners who spurred the preregistration amendments, petitioner and its *amici* might prefer a different solution, namely, eliminating the registration requirement altogether. But Congress thought it better to compromise, and that judgment cannot be overruled by the judiciary.

Second, processing times were shorter when Congress acted. See GAO Report; cf. Br. 42 & n.28. It thus made perfect sense that Congress would draft a statute that contemplated registration decisions occurring in just a few weeks at most. To the extent those times have increased, petitioner should ask the political branches for more funding. It is not for the judiciary to rewrite the law to accommodate changed circumstances.[18]

b. Petitioner and its *amici* hope the Court will do what Congress would not. They oppose registration as a matter of policy, and 'interpreting' the word "registration" to

---

[18] The last paragraph of petitioner's argument section betrays its true target, when it hypothesizes a world where "the Copyright Office were better funded and more efficient and routinely provided service within days of filing—as was once the case." Br. 42 (footnote omitted). The acknowledged change in processing times over the years confirms that this matter is for Congress, not the Court.

mean "application for registration" would move the Copyright Act closer to their core policy position. Cf., *e.g.*, Int'l Trademark Ass'n Br. 6 (arguing that Section 411(a) "should be interpreted to be consistent with Berne" by eliminating the formality of registration); ABA Br. 33-34; Authors Guild Br. 9 (lamenting that "the statutory balance has tipped away from authors in recent years"). But Congress indisputably and expressly considered that policy option and rejected it. *E.g.*, Kaplan Study at 64 ("Should the copyright law provide for an official system for registering claims to copyright?"); *ibid.* ("If the system is to be optional, how far should registration thereunder be induced by relatively mild sanctions or encouraged by special advantages: (a) Should registration (or official refusal of registration) be required in order to maintain an action for infringement?").

And since 1976, Congress has repeatedly rebuffed similar policy arguments that registration imposes a wasteful formality. *E.g.*, H.R. Rep. No. 388, 103d Cong., 1st Sess. 9-11 (1993) (arguing in favor of "eliminat[ing] the last significant vestiges of the formality-based approach to United States copyright law" for these reasons); 70 Fed. Reg. at 42,286 (recounting the legislative debate over pre-release infringement); *supra* at 11-12. If petitioner and its *amici* want a different outcome in 2018, they need to petition Congress.

3. Accordingly, petitioner's specific arguments about the Copyright Act's overall approach can be easily brushed aside.

Petitioner's objection to "making the Copyright Office the gatekeeper to enforcement of copyrights" is a veiled attack on the registration system. Br. 37. Congress indisputably distinguished between "copyright protection" and *enforcing* that protection. And the registration approach does not "render a [copyright] 'valueless'" (Br. 37)—as

even petitioner admits, if an author diligently applies for registration soon after publication, she is entitled to the full panoply of copyright remedies, including statutory damages, fees, and costs. See *supra* at 32-33 (explaining that statutory damages are available as of the "effective date" of registration).

Petitioner's worry that the statute of limitations might cause "the copyright owner [to] forever lose any ability to enforce the very rights the Act grants" (Br. 41) is hyperbole. Petitioner has not cited any case where such forfeiture has occurred. The ABA locates a single, 25-year-old decision, but it actually supports respondents' position. ABA Br. 30-31; *Kregos* v. *Assoc. Press*, 795 F. Supp. 1325 (S.D.N.Y. 1992). In *Kregos*, the copyright owner created his work in 1983 but didn't apply for registration until June 1985 (despite the Copyright Office warning that claims for that type of work "would be delayed"). *Id.* at 1328, 1331. The court declared that the plaintiff's "statute of limitations problem was itself a self-induced problem," as plaintiff had "sat on his rights for so long." *Id.* at 1331. That dilatory behavior is precisely what Congress wanted to avoid in incentivizing early registration through the registration prerequisite.

As *Kregos* exemplifies, a copyright owner risks her claim only if she waits to seek registration until long after infringement has begun. Given today's six- to eight-month application processing times, a plaintiff would have to delay seeking registration more than two years for the statute of limitations to become relevant. And in most courts

the clock begins to run only based upon discovery of infringement.[19] Moreover, again, the currently long processing times have nothing to do with the proper interpretation of the text Congress enacted in 1976.

Finally, petitioner thinks it "strange" that the "effective date" of a registration would not match the date a copyright owner can bring suit. Br. 38. But this is perfectly sensible given Congress's (again undisputed) interest in encouraging registration as early as possible after publication. Under petitioner's view, by contrast, an author might wait to apply for registration until she needs to sue. That is flatly inconsistent with incentivizing early registration. And the fact there are other such incentives (like statutory damages) is immaterial; as the Copyright Office has explained, "'the incentives to register are, in essence, a bundle. The removal of one incentive will likely result in the loss of some registrations.'" S. Rep. No. 100-352 at 20.

Congress deliberately maintained registration as a prerequisite to suit so that the public would benefit from copyright owners seeking registration promptly. Petitioner offers multiple reasons that Congress could have reasonably chosen otherwise, but those reasons are no answer for the text that Congress enacted. Petitioner's suit was properly dismissed, and the court of appeals' judgment should be affirmed.

---

[19] See 6 William F. Patry, *Patry on Copyright* § 20:19 (2017) ("The overwhelming majority of courts use discovery accrual in copyright cases."); *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 n.4 (2014) ("Although [this Court] has not passed on the question, nine Courts of Appeals have adopted * * * [this] 'discovery rule,' which starts the limitations period when 'the plaintiff discovers, or with due diligence should have discovered, the injury that forms the basis for the claim.'" (quoting *William A. Graham Co.* v. *Haughey*, 568 F.3d 425, 433 (3d Cir. 2009))); see also Pet. 5 n.5 (noting that "[t]he courts of appeals have uniformly" adopted the discovery rule).

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

DAVID A. GELLER
1221 S. 21st Avenue
Hollywood, FL 33020

PETER K. STRIS
Counsel of Record
BRENDAN S. MAHER
ELIZABETH BRANNEN
RACHANA A. PATHAK
DOUGLAS D. GEYSER
VICTOR O'CONNELL
JOHN STOKES
STRIS & MAHER LLP
725 S. Figueroa Street
Suite 1830
Los Angeles, CA 90017
(213) 995-6800
peter.stris@strismaher.com

OCTOBER 2018

No. 17-571

IN THE
Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURDEN,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

REPLY BRIEF FOR PETITIONER

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN INTELLECTUAL PROPERTY LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
GRACE W. KNOFCZYNSKI
COLLIN R. WHITE
KELLOGG, HANSEN, TODD, FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

November 13, 2018

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, petitioner Fourth Estate Public Benefit Corporation states that it is a public benefit corporation that has not issued any stock.

TABLE OF CONTENTS

Page

RULE 29.6 STATEMENT i

TABLE OF AUTHORITIES iii

ARGUMENT 3

I. "REGISTRATION" IS "MADE" FOR PURPOSES OF § 411(A) BY THE COPYRIGHT OWNER 3

A. The Statute Uses the Phrase "Make Registration" and Its Variants To Refer to Compliance with the Requirements of § 408(a) 3

B. Allowing a Copyright Owner To Sue for Infringement Once the Copyright Owner Has Complied with the Registration Requirement Comports with the Structure of § 411(a) and the Rest of the Copyright Act 11

II. THE ACT'S HISTORY CONFIRMS THAT A COPYRIGHT OWNER MAY INSTITUTE AN ACTION FOR INFRINGEMENT AFTER COMPLYING WITH STATUTORY REQUIREMENTS FOR REGISTRATION 16

III. THE COPYRIGHT ACT'S SCHEME OF RIGHTS AND REMEDIES FAVORS ALLOWING SUITS TO PROCEED ONCE THE COYPRIGHT OWNER HAS COMPLIED WITH REQUIRED FORMALITIES 19

CONCLUSION 22

TABLE OF AUTHORITIES

Page

CASES

Almendarez-Torres v. United States, 523 U.S. 224 (1998) 8

American Broad. Co. v. Aereo, Inc., 134 S. Ct. 2498 (2014) 16, 18

Brotherhood of R.R. Trainmen v. Baltimore & O.R.R. Co., 331 U.S. 519 (1947) 10

Bruesewitz v. Wyeth LLC, 562 U.S. 223 (2011) 19

Caraco Pharm. Labs., Ltd. v. Novo Nordisk A/S, 566 U.S. 399 (2012) 14

Carol Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411 (2d Cir. 1985) 21

Chan v. Korean Air Lines, Ltd., 490 U.S. 122 (1989) 4

Cosmetic Ideas, Inc. v. IAC/Interactivecorp., 606 F.3d 612 (9th Cir. 2010) 19

Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970) 2, 17

Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co., 260 F.2d 637 (2d Cir. 1958), ... 2, 16, 17, 18

Washingtonian Publ'g Co. v. Pearson, 306 U.S. 30 (1939) 12, 19

White-Smith Music Publ'g Co. v. Goff, 187 F. 247 (1st Cir. 1911) 2, 17

STATUTES AND REGULATIONS

Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 9(b)(1), 102 Stat. 2853, 2859 19

Copyright Act of 1909, ch. 320, 35 Stat. 1075 ..... 12, 16, 17

§ 13, 35 Stat. 1078 17

Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 ..... 2, 3, 7, 9, 18, 19

§ 110, 90 Stat. 2600, *reprinted in* 17 U.S.C. § 407 note 7

Copyright Act (17 U.S.C.) ..... *passim*

17 U.S.C. § 102(a) 12, 19

17 U.S.C. § 205 8

17 U.S.C. § 205(a) 8

17 U.S.C. § 205(c) 8

17 U.S.C. § 205(c)(1) 8

17 U.S.C. § 405(b) 6

17 U.S.C. § 406(a) 9

17 U.S.C. § 406(a)(1) 8

17 U.S.C. § 406(a)(2) 8

17 U.S.C. § 408 ..... 1, 3, 6, 12

17 U.S.C. § 408(a) 3, 10

17 U.S.C. § 408(b)(2) 15

17 U.S.C. § 408(c)(3) 6, 10

17 U.S.C. § 408(f) 9, 15

17 U.S.C. § 408(f)(1) 15
17 U.S.C. § 408(f)(3) 10
17 U.S.C. § 410(c) 6
17 U.S.C. § 410(d) 3, 5, 6, 11, 13, 15, 16
17 U.S.C. § 411(a) 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 13, 14, 15, 16, 17, 18, 20
17 U.S.C. § 411(b) 4, 16
17 U.S.C. § 411(c) 4, 5, 6, 11
17 U.S.C. § 412 ..... 1, 3, 4, 5, 6, 9, 11, 20
17 U.S.C. § 412(2) 5
17 U.S.C. § 508(a) 22
17 U.S.C. § 708(a) 7, 8, 9
15 U.S.C. § 1173(a)(4) 11
45 U.S.C. § 362(i) 11
37 C.F.R. § 202.16(c)(6) 15

LEGISLATIVE MATERIALS

H.R. Rep. No. 109-33. pt. 1 (2005) 10
S. 543, 91st Cong. (1969) 4
S. 644, 92nd Cong. (1971) 4

ADMINISTRATIVE MATERIALS

U.S. Copyright Office, *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law* (Comm. Print 1961), *available at* https://www.copyright.gov/history/other_reports.html 18

OTHER MATERIALS

Black's Law Dictionary (4th ed. 1951) 10, 11

Robert Kasunic, *Copyright from Inside the Box: A View from the U.S. Copyright Office*, 39 Colum. J.L. & Arts 311 (2016)..... 21

Webster's Third New International Dictionary (2002) 10, 11

Respondents and the government cannot counter textual evidence that the phrase "make registration" and its passive-voice counterparts in the Copyright Act – including in § 411(a) – denote the action of a copyright owner in submitting the application, deposit, and fee required by § 408 to "obtain registration." Accordingly, their primary argument – that the word "registration" in the first sentence of § 411(a) unambiguously requires an affirmative determination by the Copyright Office that a certificate of registration should or should not issue before a copyright owner can sue – is incorrect. On the contrary, respondents and the government, to avoid an absurd reading of § 412, eventually admit that the statute makes clear that registration is "made" *on its effective date* – but that is the date when the copyright owner complies with the requirements of § 408, not when the Register eventually grants registration. That reading is consistent with petitioner's position, not respondents'.

The remainder of § 411(a) – which preserves a copyright owner's right to sue when "registration has been refused" – does not support a different reading. The first sentence of § 411(a) requires the copyright owner to make registration before bringing an action, and the rest of the provision clarifies the consequences of the Copyright Office's refusal to register a claim. The fact that a copyright owner is expressly authorized to initiate suit after such a refusal – which the first sentence might leave in doubt – hardly supports the argument that a copyright owner may not initiate a suit after making registration in compliance with the statute when the Office has not yet acted. On the contrary, adopting respondents' construction would put the first and second sentences of § 411(a) into conflict – which petitioner's interpretation avoids.

The history of the provision supports the plain meaning of the text because respondents' interpretation recreates the very problem that the statute was designed to solve: namely, that, before any infringement action can be brought, a copyright owner might have to bring a mandamus action if the Register fails to act. That is inconsistent with the view – adopted by the First and Ninth Circuits before enactment of the 1976 Act and embodied in § 411(a) – that, once a copyright owner "place[s] the . . . application[] in the mail" and "ha[s] done everything required of it under the copyright law with respect to the deposit of copies and registration," it is entitled to bring suit. *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1108-09 (9th Cir. 1970); *see White-Smith Music Publ'g Co. v. Goff*, 187 F. 247, 247 (1st Cir. 1911); *see also Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 645 (2d Cir. 1958) (Clark, C.J., dissenting) (noting that the Act "[q]uite obviously . . . puts the condition of complying with the law . . . upon the copyright owner before he sues"). By rejecting the majority opinion in *Vacheron*, the statute is likewise properly read to reject the view that the Register should be the gatekeeper of copyright enforcement.

Arguments about underlying policy should be largely beside the point because ordinary tools of statutory interpretation yield a clear answer; in any event, such arguments likewise favor reversal. Respondents' claim that petitioner takes issue with the registration requirement or the policies underlying it is pretense: whether or not the Copyright Office has the power to block infringement suits by failing to act, copyright owners must comply with the registration requirement before suing. Statutory

incentives for prompt registration reside elsewhere, including in § 412. And the claim that the statute embodies a policy of administrative finality or exhaustion is belied by the terms and structure of the statute – including § 410(d), which puts courts' determination on equal footing with the Register's. In the real world, as *amici* attest, action by the Register not only is usually long in coming, but generally does not address the disputed issues that a court will confront. When such cases occur, courts can obtain the Register's views. Such concerns offer no justification for shielding infringers during the Copyright Office's inevitable delays, depriving copyright owners of their intellectual property in the meantime.

ARGUMENT

I. "REGISTRATION" IS "MADE" FOR PURPOSES OF § 411(a) BY THE COPYRIGHT OWNER

A. The Statute Uses the Phrase "Make Registration" and Its Variants To Refer to Compliance with the Requirements of § 408(a)

That the Copyright Act of 1976 uses the construction "make registration" and its variants to denote action by the copyright owner (and not the Copyright Office) matters for two reasons. First, it disproves respondents' claim that the word "registration" by itself resolves this case. Second, because the statute consistently uses the phrase to refer to the copyright owner's compliance with the requirements of § 408, the interpretive principle that statutory phrases should be given consistent meaning favors petitioner's construction. Pet. Br. 21-29.

1. Respondents' argument that the word "registration," by itself, indicates that a suit can be brought only after the Register acts cannot be reconciled with

either § 411(c) or § 412. Section 411(c) (which was adopted as § 411(b), adjacent to § 411(a)) provides that certain infringement actions can be brought prior to registration if "the copyright owner . . . makes registration for the work" within three months. Section 412 bars statutory damages and attorney's fees for infringement of a published work prior to registration unless "registration is made" within three months.

The first provision makes express that registration is "made" once the *copyright owner* complies with his registration obligations; the second strongly implies it. Pet. Br. 22-24. Reading the statute in this straightforward way is fatal to respondents' theory that the word "registration" provides the answer to the question presented, and respondents thus urge the Court to disregard the language of § 411(c) as a mistake – "copyright owner" is the "subject" of the sentence, they argue, for "ease of drafting." Resp. Br. 34 n.12. But if there were a conflict between the subject and the predicate of the sentence, it would have been noticed – no one would accidentally make it a condition of suit that the "copyright owner . . . grant registration" because that is not something the copyright owner does.[1] And this Court will not find a "drafting error" unless that error is "obvious" and the result it produces is "necessarily absurd," *Chan v. Korean Air Lines, Ltd.*, 490 U.S. 122, 134 (1989), which respondents have made no attempt to show.

---

[1] It would be especially inappropriate to treat the language of § 411(c) as inadvertent because that language was first introduced in 1969, seven years before the passage of the Act. *See* S. 543, 91st Cong. (1969); *see also* S. 644, 92nd Cong. (1971).

Respondents also make the unpalatable claim that, under § 411(c), even if the copyright owner complies with the registration requirement within three months, the copyright owner may be unable to maintain its suit if the Register has not acted within three months. This view (which the government rejects, *see* U.S. Br. 28) is, according to respondents, "entirely logical" because it will "prevent powerful stakeholders . . . from abusing Section 411(c)." Resp. Br. 35. That argument is practically self-refuting – it would be extraordinary for Congress to impose a three-month deadline, enforced by loss of enforcement rights, while leaving compliance with the deadline out of the copyright owner's hands.

Moreover, respondents lose their nerve in addressing § 412. Like § 411(c), § 412(2) imposes a three-month deadline for "registration [to be] made," but in this case respondents argue that registration is (as § 410(d) makes clear) "made" on its "effective date"; and the "effective date" is "keyed to the copyright owner's actions, not the Register's." Resp. Br. 33. But respondents offer no reason why what is true for § 412 is not also true for § 411(a): registration is "made" on the effective date of registration – *i.e.*, "the day on which an application, deposit, and fee . . . have all been received in the Copyright Office." 17 U.S.C. § 410(d). That reasoning supports petitioner, not respondents.

The government's effort to address these provisions leads it to the same fatal concession. The government does not contest that § 411(c) indicates that it is the copyright owner who "makes registration"; nor does it contest that § 412 makes no sense if "registration is made" on the date of the Register's action. Instead, it argues that the three-month deadlines in those provisions are of no concern because, under

§ 410(d), "no matter when the Copyright Office acts, if registration is ultimately granted, its effective date 'is the day on which an application, deposit, and fee . . . have all been received in the Copyright Office.'" U.S. Br. 28 (quoting § 410(d)). And, it says, "[a]s long as the effective date of registration falls within the three-month windows defined by Sections 411(c) and 412, the requirements of those provisions are met." *Id.* Again, if that is true for § 411(c) and § 412, so too it is true for § 411(a): registration is made on the effective date of registration, when the copyright owner has complied with § 408.[2]

2. Respondents and the government likewise cast no doubt on the conclusion that the statute elsewhere uses the construction "make registration" to refer to the copyright owner's compliance with the registration requirement. For example, § 405(b) includes the phrase "registration . . . has been made under section 408" – indicating that the copyright owner makes registration by complying with that statutory provision. The government has no answer, failing to address this provision at all. Respondents chalk this up to another drafting error – registration is not made under § 408 after all, they insist, because the Register might reject an application. Resp. Br. 37. The statute does not use the phrase in a manner consistent with respondents' argument. This is true as well of § 408(c)(3), which provides that "a single

---

[2] The statute uses the phrase in just this sense in § 410(c) as well, when it refers to a "certificate of a registration made before or within five years after first publication of the work." For this purpose, the registration must be "made" on its effective date – not on the date of the Register's action – to avoid making nonsense of the incentives for registration, which apply to the copyright owner, not the Register.

renewal registration may be made . . . upon the filing of a single application and fee" – which says in so many words that registration "may be made . . . upon the filing of the application and fee" and not upon any action by the Register. Neither respondents (at 36) nor the government (at 27) offer a response that makes sense of the text Congress adopted.

Nor can respondents reconcile their view with § 110 of the 1976 Act; the government does not even try. That provision states that "any *deposit and registration made* after [the Copyright Act's effective] date in response to a demand under" the Act's predecessor "shall be made in accordance with" the new Act – indicating that the copyright owner does both. 17 U.S.C. § 407 note; *cf. id.* § 411(a) (referring to registration "made in accordance with this title"). Respondents' only answer (at 38) is to rewrite the provision – asserting that the owner responds to the Register's "demand by initiating the registration process through its application," and "the Register completes that process by approving, *i.e.*, making, registration." That is not what the Act says. It instead indicates that, once the Register makes a demand, the copyright owner makes both the deposit and registration in response.

3. Furthermore, it is not true that the 1976 Act, as adopted, ever used the phrase "registration has been made" to denote Register's grant of an application. Respondents (at 31) and the government (at 28) rely on § 708(a), but that provision was altered in 1982 to add the language that respondents and the government cite, and it addresses fees, not the litigation-significance of registration – which petitioner pointed out (at 27-28) but the other side ignores. No one would seriously argue that the same language in

§ 411(a) meant one thing in 1978 and another thing in 1983; accordingly, § 708(a) provides no interpretive guidance. *See* Pet. Br. 27 (citing *Almendarez-Torres v. United States*, 523 U.S. 224, 237 (1998)).

The government argues (at 29) that § 205(c) *could* be read to require that registration had already been granted, but it does not dispute that § 205(c) only protects a transferee who properly records a transfer (which it can do irrespective of whether a certificate of registration has issued[3]) if the statutory phrase "registration has been made" refers to the copyright owner's compliance with the registration requirement, not the Register's administrative determination.[4] That reading of § 205 is reinforced by § 406(a)(2), which imposes liability for infringement notwithstanding good-faith reliance on a purported transfer or license from a person erroneously named in a copyright notice when "a document executed by the person named in the notice and showing the ownership of the copyright had been recorded." This means of notice is an alternative to "registration . . . made in the name of the owner of copyright," § 406(a)(1), and thus indicates that the existence of a certificate of registration is not essential to proper recordation.

Section 406(a)(1) – which charges an infringer with notice of ownership of copyright if "registration . . .

---

[3] "*Any* transfer of copyright ownership or other document pertaining to a copyright may be recorded in the Copyright Office." 17 U.S.C. § 205(a) (emphasis added).

[4] Respondents' claim (at 28) that it "would make no sense" to charge persons with notice of a properly recorded document is wrong – any person can check to see whether a transfer of a copyright has been recorded by searching "under the title . . . of the work." 17 U.S.C. § 205(c)(1).

had been made in the name of the owner of copyright" – does not point to any different reading of § 411(a). The government asserts (at 29-30) the statute's use of "had been made" rather than "has been made" implies that the reference is to the Register's action, but does not explain why. Instead, the provision refers to registration that "had been made" rather than "has been made" for reasons of syntax: it refers to an action (making registration) that must take place prior to the beginning of the "undertaking" giving rise to potential liability. And, contrary to respondents' assertion (at 29), it makes sense that a potential infringer may be charged with notice of ownership once the owner has complied with the registration requirement: § 412 creates a similar dramatic difference in the consequences of infringement, but everyone agrees that the copyright owner's remedies turn on the date of the copyright owner's compliance with the registration requirement, not the Register's action.[5]

Contrary to the government's assertion (at 20), the preregistration provision, § 408(f), does not suggest that "submission of the required materials is an action distinct from 'registration' itself." First of all, as with § 708(a), the preregistration provision was not part of the 1976 Act – it was adopted in 2005 – and it thus carries less weight in determining the meaning of § 411(a)'s original language.[6] Further,

---

[5] There is also no reason why – in connection with either § 406(a) or § 412 – the Register could not permit concerned potential infringers to search pending registration applications.

[6] For what it is worth, the House Report accompanying the 2005 legislation uses the verb "register" to refer to the copyright owner's action, not just the Register's – that is, in the sense that

the government's argument puts too much weight on the subsection heading of § 408(f)(3), which reads "[a]pplication for registration," while the text of § 408(f)(3) refers not only to the application itself but also to the fee and the deposit – that is, the materials required for making registration. It is "not . . . unusual" that a statutory heading "fails to refer to all the matters which the framers of that section wrote into the text," *Brotherhood of R.R. Trainmen v. Baltimore & O.R.R. Co.*, 331 U.S. 519, 528 (1947), and § 408(f)(3)'s heading does not outweigh Congress's textual statements that "*the owner* . . . may obtain registration . . . by delivering" a deposit, application, and fee, § 408(a) (emphasis added), and that "registration may be *made* . . . *upon* the filing of a[n] . . . application and fee," § 408(c)(3) (emphasis added).[7]

4. Dictionary definitions (discussed at Resp. Br. 30-31) do not suggest any different understanding. The meaning of "registration" includes "an act . . . of registering," and to "register" can mean either "to make or [to] secure an official entry of in a register." *Webster's Third New International Dictionary* 1912 (2002) ("*Webster's Third*"); *see also Black's Law*

---

respondents wrongly suggest is contrary to plain language. *See* H.R. Rep. No. 109-33, pt. 1, at 5 (2005) (explaining certain circumstances under which "*a copyright owner* of a preregistered work *can register his or her work* under current law") (emphases added).

[7] The government does not argue that there is any difference between what is required under § 408(f)(3) and under § 408(a) or § 408(c)(3), nor does its theory explain why Congress spelled out the elements of registration in § 408(f)(3) rather than simply referring to one of the other sections. There is no interpretive principle based on any counterfactual presumption that Congress avoids using more words when fewer words would do.

Dictionary 1449 (4th ed. 1951) ("*Black's*") (definitions of "registration" including "[r]ecording" or "enrollment");[8] Authors Guild Br. 12. To "make," moreover, can mean either "to execute in an appropriate manner," as with a will or deed; or to "carry out" or "perform" an action. *Webster's Third* 1363. Thus, the copyright owner's performance of the steps statutorily required to secure an official record of the copyright from the Register fits within the ordinary meaning of the phrase "make registration" – consistent with Congress's usage of the phrase in § 411(c) and § 412 and elsewhere; with this Court's usage in other cases about the Copyright Act, *see* Pet. Br. 22; and with other statutory usages identified by *amici*, *see* NMPA Br. 11-12 n.5 (citing 15 U.S.C. § 1173(a)(4); 45 U.S.C. § 362(i)).

B. Allowing a Copyright Owner To Sue for Infringement Once the Copyright Owner Has Complied with the Registration Requirement Comports with the Structure of § 411(a) and the Rest of the Copyright Act

The understanding that § 411(a) authorizes actions for infringement once a copyright owner has registered the work further comports with the structure of rights and remedies established by the Copyright Act. Respondents and the government offer no explanation for why, under their reading, § 410(d) would make the effective date of registration the date

---

[8] The contemporaneous edition of *Black's* further defined (at 1449) a "registrant" as "one who registers anything (*e.g.*, a trade-mark) for the purpose of securing a right or privilege granted by law on condition of such registration" – further showing that legal usage then included an owner of intellectual property as performing the act of registering that property.

on which the copyright owner complies with the requirements of § 408, yet § 411(a) would bar suits for infringement – including suits for injunctive relief to put a stop to ongoing infringement – after that effective date. They do not explain why the same provision clarifies that the same effective date applies if a court, rather than the Register, determines that the copyright owner complied with the registration requirement. *See* NMPA Br. 8. They offer no justification for rendering a copyright effectively valueless during any period of administrative delay by the Copyright Office, when the statute provides that the right to exclude exists by virtue of fixation, not compliance with any statutory formalities. 17 U.S.C. § 102(a). And they fail to confront the point – persuasively argued by *amici* – that *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939), establishes a presumption against a doubtful construction that deprives a copyright owner of its exclusive rights. *See* NMPA Br. 15-17. Nor do respondents offer any structural evidence to contradict the conclusion that the words of the statute require.

1. There is no force to the argument (Resp. Br. 20) that, because § 411(a) provides that a copyright owner *can* initiate suit after the Register has refused registration, it should be inferred that it *cannot* initiate suit if the Register has not acted. Courts applying the registration and deposit requirement of the 1909 Act divided on the question of what should happen where the Copyright Office refuses registration notwithstanding the copyright owner's compliance with the requirements of the statute. The second sentence of § 411(a) gives the answer by providing that, in any case where the copyright owner has made registration (that is, has delivered the required

application, deposit, and fee to the Copyright Office) but registration has been refused, the copyright owner may sue.

That had to be made explicit because, where the Register has refused registration, whether the copyright owner has acted "in accordance with" the statute is in doubt – the Register has found that it has not. But that does not prevent a suit from proceeding, in which, as § 410(d) provides, "a court of competent jurisdiction" ultimately determines whether the owner's submission was "acceptable for registration." Thus, the second sentence of § 411(a) is not an exception to the categorical registration requirement in the first sentence – it simply imposes an additional procedural requirement and clarifies that the Register is entitled to intervene. That is a better reading of the word "however," which does not, in ordinary language, signal contradiction. Pet. Br. 30.

The word "institute" in the second sentence of § 411(a) does not imply, as respondents suggest (at 23 n.6), that the Register's action must always come before a lawsuit begins. Rather, it mirrors the phrasing of the first sentence, which states that "no civil action for infringement . . . shall be instituted until . . . registration . . . has been made." Usually (almost always), registration is granted and the second sentence will not come into play. The second sentence addresses the unusual case where registration has been refused before the copyright owner institutes an action. That does not speak to what should happen when registration is refused *after* the suit is initiated, but § 410(d) clarifies that, in such a case, the court may find compliance with the registration requirement. Neither part of § 411(a) is offended where a copyright owner complies with the registration

requirement before instituting an action and the Register or a court later concludes that compliance was acceptable: either way, the copyright's effective date of registration comes before the action's date of institution. Respondents argue that Congress used the word "institute" to rule out the possibility of "maintaining" a suit already initiated. But there is no reason to draw that inference when the purpose of the second sentence is to describe and provide special procedures for a subclass of cases where suit *can* be instituted. *See also* Pet. Br. 31 n.21 (House Report: "a rejected claimant who has properly applied for registration may maintain an infringement suit" if notice is served).

The government argues (at 16) that Congress could have made the proper result clearer by redrafting the provision. But "the mere possibility of clearer phrasing cannot defeat the most natural reading of a statute," *Caraco Pharm. Labs., Ltd. v. Novo Nordisk A/S*, 566 U.S. 399, 416 (2012), especially where, as here, the possibility of clearer phrasing cuts both ways. The statute could have said: "no civil action for infringement of the copyright in any United States work shall be instituted until the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form." But the statute could also have said: "no civil action for infringement of the copyright in any United States work shall be instituted until the Register grants or refuses registration." These hypothetical alternatives do not clarify the meaning of "registration . . . has been made" in § 411(a).

2. Petitioner's reading does not render any provision of the Copyright Act superfluous. *Cf.* Resp. Br. 25-27; U.S. Br. 21-22.

First, the Act's preregistration regime in § 408(f) is not superfluous because it confers remedies unavailable under anyone's reading of § 411(a). Preregistration is available for a work that "is being prepared for commercial distribution" but that is as yet unfinished, § 408(f)(1), let alone unpublished. Under Copyright Office regulations, no deposit of the work (which may not yet exist) is required; instead, the copyright owner may make preregistration by submitting a description of the work. *See* 37 C.F.R. § 202.16(c)(6). As a result, the copyright owner can obtain an injunction against threatened infringement before the work is released for commercial distribution, when deposit may be difficult or impossible. *See* § 408(b)(2) (requiring, in the case of a published work, deposit of "two complete copies or phonorecords of the best edition"). Moreover, even if a record label registers a newly released song immediately and seeks expedited treatment (which the Register may not grant), unlawful copying and distribution over the Internet may have destroyed the commercial value of the song before the copyright owner can bring any action. *See* Copyright Alliance Br. 11 ("Millions of infringing copies or performances of a work can take place in days, or even minutes."). Preregistration helps avoid such results.

Second, § 410(d) is not superfluous because it clarifies that the effective date of registration is the date on which the underlying materials were properly submitted to the Register – whether the propriety of that submission is determined by the Register or, later, by a court. As no one disputes that the term "registration" *can* be read to refer to the action of the Register, eliminating potential disputes about the date serves an obvious purpose. In short, under

§ 410(d), the effective date of registration is the date that the copyright owner makes registration, not the date that the Register registers the claim. As noted above, that supports petitioner's reading of the statute, not respondents'.

Third, § 411(b) is not superfluous because it clarifies the evidentiary consequences of a certificate of registration: absent what amounts to a fraudulent application, the certificate proves that registration has been made (and entitles the owner to certain litigation advantages). The fact that, for purposes of § 411(a), "registration" is "made" by the owner's submission of the required materials does not imply anything about the evidentiary significance of a certificate.

II. THE ACT'S HISTORY CONFIRMS THAT A COPYRIGHT OWNER MAY INSTITUTE AN ACTION FOR INFRINGEMENT AFTER COMPLYING WITH STATUTORY REQUIREMENTS FOR REGISTRATION

The split of authority concerning the need for action by the Register before an infringement suit could proceed under the 1909 Act – and the statute's rejection of the view that such action was required – provides a further reason to reverse the decision under review. *See* Pet. Br. 32-36; *American Broad. Co. v. Aereo, Inc.*, 134 S. Ct. 2498, 2505-06 (2014). Respondents (at 40) and the government (at 25-26) argue that their proposed interpretation of the statute sufficiently solves the problem the majority in *Vacheron* created by eliminating the requirement for a copyright owner to seek mandamus to obtain review of the Register's refusal to register a claim. Their arguments fall short in two respects.

First, § 411(a) is inconsistent with the *rationale* of Judge Hand's opinion in *Vacheron* and consistent with the rationale of other circuits and the dissent of Judge Clark in *Vacheron*. Aside from a discussion of conflicting and inconclusive precedent, the opinion found "confirmation" for its view that the infringement action could not proceed absent affirmative action by the Register in "the text of the last sentence of § 13" of the 1909 Act, which "denies the right to sue for infringement 'until the provisions of this title with respect to *the deposit of copies and registration* of such work shall have been complied with.'" 260 F.2d at 640 (emphasis added). The court reasoned that, because this provision required "more than the mere 'deposit of copies,'" and because "the owner must submit an application and pay the required fees in order to make a deposit, we can think of no other added condition for 'registration' but acceptance by the Register." *Id.* at 640-41 (citation omitted). As the majority acknowledged (*id.* at 639), this is not how the First Circuit read the statute in *White-Smith Music Publishing*; the Ninth Circuit also rejected the reading in *Roth*.

Judge Clark was likewise unpersuaded: he noted that, where a "plaintiff has complied with the requirements put upon it," it should not be required to "assume the risk of waiting – perhaps until its right is lost by limitation or otherwise – until the Register has performed his statutory duties." *Vacheron*, 260 F.2d at 645 (Clark, C.J., dissenting) (footnote omitted). "So to conclude is to read this serious prohibition into the single word 'registration,' thus giving it a meaning which not merely is not required, but is actually belied by both the immediate context and the general statutory scheme of copy-

right." *Id.* The 1976 Act adopts Judge Clark's view: it omits the distinct requirement of compliance with the deposit requirement that had led Judge Hand to a different result. Pet. Br. 34. Respondents cannot account for this change in wording.

Second, respondents cannot dispute that their reading leaves unaddressed the very problem that Judge Clark highlighted in his dissent and that § 411(a), properly read, addresses. By requiring an affirmative action by the Register before a suit is permitted to proceed, the majority rule in *Vacheron* forced the copyright owner to "assume the risk of waiting" for the Register to act. 260 F.2d at 645 (Clark, C.J., dissenting). Commentary on the proposed revision deplored in particular the potential need for a copyright owner to bring mandamus before it could bring a civil action for infringement. *See* Pet. Br. 35. Under respondents' view, if the Copyright Office delays acting for months or years, neither registering a claim nor refusing registration – as it did here until the case was ripe for this Court's review – the copyright owner's sole remedy is, as the *Vacheron* majority held, to file for mandamus. Statutes should not be read to perpetuate the problem they were adopted to solve. *See Aereo*, 134 S. Ct. at 2505-06.

Committee reports and other commentary surrounding the adoption of the 1976 Act provide no support for respondents' view. The House Report accompanying the 1976 Act (to which respondents repeatedly refer) does not speak to the specific question presented; any clues it provides to the meaning of the statute point in petitioner's direction. *See* Pet. Br. 23 n.17, 31 n.21. The same is true of the Copyright Office's 1961 Report, which expressed the Office's

view that an "application for registration" is what is required before a copyright owner can file suit. *See id.* at 23 n.17, 35. Respondents (but not the government) cite (at 24) reports accompanying the Berne Convention Implementation Act of 1988 to suggest that a determination by the Register is a prerequisite to suit, but "[p]ost-enactment legislative history (a contradiction in terms) is not a legitimate tool of statutory interpretation." *Bruesewitz v. Wyeth LLC*, 562 U.S. 223, 242 (2011). Respondents' reliance on such statements underscores their lack of friends in the crowd of legislative materials pertinent to the 1976 Act.

III. THE COPYRIGHT ACT'S SCHEME OF RIGHTS AND REMEDIES FAVORS ALLOWING SUITS TO PROCEED ONCE THE COYPRIGHT OWNER HAS COMPLIED WITH REQUIRED FORMALITIES

Respondents do not deny that the Act grants copyright owners exclusive rights without requiring action by any agency. *See* 17 U.S.C. § 102(a). Nor do they deny what this Court made clear long before the Act was adopted: in the absence of any possible enforcement action, a copyright provides hardly any protection at all. *See Washingtonian Publ'g*, 306 U.S. at 40 ("Without right of vindication a copyright is valueless."). Yet they also do not deny that, in some cases, their reading will bar copyright owners from seeking meaningful relief for infringement. *See Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 620 (9th Cir. 2010). Respondents' effort to make that result seem less jarring is unavailing.

First, there is no merit to the claim that such disadvantages are an inevitable result of any registration requirement or are necessary to encourage early

registration. On the contrary, this case has nothing to do with whether the registration requirement is good policy, because there is no dispute that a copyright owner must register its work before suing. *See* Copyright Alliance Br. 21 (purpose of the registration rule "is fully vindicated" under petitioner's reading). Nor does it make sense to misread § 411(a) to create an incentive for early registration: § 412 already creates ample incentives for prompt registration of any published work by depriving copyright owners of statutory damages and attorney's fees if they fail to make registration within three months of publication. It would be odd for Congress to preserve these remedies for any copyright owner who makes registration within three months while depriving the same copyright owner of the ability to bring an action for an injunction to stop infringing conduct that begins before the Register acts. The statute does not direct that result.

Second, claims that requiring administrative finality will reduce the burdens of meritless copyright infringement suits give the registration process an importance in the copyright regime that is neither warranted by the statute nor consistent with actual administrative practice.[9] As explained above and in petitioner's opening brief, the determination of the Copyright Office is ultimately of limited importance to a court's determination of the scope of an author's right to exclude under the Copyright Act;

---

[9] Neither respondents nor their *amici* cite any case in which the registration requirement forestalled meritless litigation; because registration is generally granted if formalities are satisfied, their reading of the requirement will not deter determined litigants. It can, however, protect willful infringers when registration is delayed. *See* ITA Br. 19.

any question of copyright eligibility – as well as any other question concerning registrability of a claim – must be determined *de novo* by a court. The views of the Copyright Office are frequently afforded little, if any, deference. *See Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985) (district court "in as good a position as the Copyright Office to decide" question of copyrightability); ABA Br. 22 n.17 (citing cases). The idea that the Copyright Office should be permitted to determine which authors should and which authors should not be afforded a timely remedy – with such determinations depending on the vagaries of internal operations – invites injustice and threatens loss of substantial rights based on the luck of the draw.[10]

Furthermore, as those whose livelihood depends on protection of intellectual property attest, the Copyright Office process does not and was never intended to "weed out" claims on the merits. *See* ABA Br. 19-21. As the Associate Register of Copyrights recently acknowledged, "[a]s a practical matter, I really don't want deference or an evidentiary presumption to be afforded" based on the determinations of the Copyright Office. Robert Kasunic, *Copyright from Inside the Box: A View from the U.S. Copyright Office*, 39 Colum. J.L. & Arts 311, 322 (2016). The Office grants 97% of applications; those not granted often languish over questions of how to categorize works that are unquestionably copyrightable (as occurred in this case). *See* NMPA Br. 21-22 (describing delays of

---

[10] Respondents' reading creates a further paradox in that courts have held that an accused infringer may bring a declaratory-judgment action even though the copyright owner is not permitted to sue. *See* Copyright Alliance Br. 17-18.

more than three years without any administrative determination). The Copyright Office admittedly makes no meaningful review of a work's originality, and its decision to grant registration will only rarely purport to clarify the scope of any rights in a copyrightable work. Prior administrative review therefore will rarely be relevant to the question whether the defendant has invaded the copyright owner's exclusive rights.

In any such case, moreover, the Register will have the opportunity to make its views known. Under § 508(a), the Copyright Office must be promptly informed of the pendency of any infringement suit. And if a defendant raises a substantial issue of registrability implicating the Copyright Office's expertise, the courts can use the ordinary tools of litigation management to ensure that the Register can weigh in first. Pet. Br. 40-41. Accordingly, to the extent a benefit of the registration requirement is that it permits courts to take advantage of the Copyright Office's expertise, that benefit is preserved in every case, not just those filed after the Copyright Office has made its determination.

CONCLUSION

The judgment of the court of appeals should be reversed.

Respectfully submitted,

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN
INTELLECTUAL PROPERTY
LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
GRACE W. KNOPCZYNSKI
COLLIN R. WHITE
KELLOGG, HANSEN, TODD,
FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

November 13, 2018

No. 17-571

IN THE
Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURDEN,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

SUPPLEMENTAL BRIEF FOR PETITIONER

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN INTELLECTUAL PROPERTY LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
COLLIN R. WHITE
KELLOGG, HANSEN, TODD, FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

June 5, 2018

RULE 29.6 STATEMENT

Pursuant to this Court's Rule 29.6, petitioner Fourth Estate Public Benefit Corporation states that it is a public benefit corporation that has not issued any stock.

TABLE OF CONTENTS

Page

RULE 29.6 STATEMENT i

TABLE OF AUTHORITIES iii

ARGUMENT 1

I. THE COURT SHOULD GRANT THE PETITION TO RESOLVE THE CONCEDED CIRCUIT SPLIT ABOUT THE COPYRIGHT ACT'S REGISTRATION REQUIREMENT 1

II. FOR PURPOSES OF § 411(a), A COPYRIGHT OWNER MAKES REGISTRATION BY SUBMITTING THE REQUIRED MATERIALS TO THE COPYRIGHT OFFICE 2

CONCLUSION 6

TABLE OF AUTHORITIES

Page

STATUTES

Copyright Act (17 U.S.C.) 1, 2, 3

17 U.S.C. § 205 4

17 U.S.C. § 205(a) 4

17 U.S.C. § 205(b) 5

17 U.S.C. § 205(c) 4

17 U.S.C. § 406(a) 5

17 U.S.C. § 406(a)(1) 5

17 U.S.C. § 408(c)(3) 2

17 U.S.C. § 410(a) 2

17 U.S.C. § 410(b) 2

17 U.S.C. § 410(d) 5-6

17 U.S.C. § 411(a) 1, 2, 3, 6

17 U.S.C. § 411(c) 2

17 U.S.C. § 412 6

17 U.S.C. § 412(2) 2

The government agrees that this case turns on a question that has split the circuits: at what point "registration of [a] copyright claim has been made" within the meaning of § 411(a) of the Copyright Act, 17 U.S.C. § 411(a). It also rejects respondents' position that this Court should leave this conflict unresolved and urges the Court to grant review. On all those scores, the government is right.

But it is wrong on the merits, because it cannot square its position with the Copyright Act's text. The Court should resolve the question presented only after full briefing, but the key point is that the Copyright Act consistently uses the phrase "makes registration" or a passive-voice counterpart to refer to an action of the copyright owner. The government's effort to overcome that textual evidence yields no reason to hold that Congress used the same phrase to mean anything else in § 411(a). The Court should therefore grant the petition, order merits briefing, and reverse the judgment.

ARGUMENT

I. THE COURT SHOULD GRANT THE PETITION TO RESOLVE THE CONCEDED CIRCUIT SPLIT ABOUT THE COPYRIGHT ACT'S REGISTRATION REQUIREMENT

The government and the parties agree that the Eleventh Circuit's decision deepens an entrenched circuit conflict about the question presented. U.S. Br. 9-10; Opp. 2-5. And the government agrees with petitioner that the Court should resolve that split in this case. U.S. Br. 9-12. For those reasons, the Court should grant the petition.

In particular, the government correctly explains that, because this case arrives on a motion to dismiss, any question about whether petitioner in

fact submitted the materials required for registration does not affect whether this case cleanly presents the legal issue in a meaningful context. U.S. Br. 11-12. Petitioner disputes the government's assertions regarding the date on which its application was complete; it has no record of receiving the letters attached to the government's brief and no record of having resubmitted payment. In short, petitioner stands by the factual allegations in the complaint. That factual question will be ripe for resolution on remand if the Court reverses the Eleventh Circuit's judgment. Moreover, because petitioner regularly relies on the Copyright Act to protect its online works, it has every incentive to ensure that the question presented is correctly decided not only for this case but also for future cases.

II. FOR PURPOSES OF § 411(a), A COPYRIGHT OWNER MAKES REGISTRATION BY SUBMITTING THE REQUIRED MATERIALS TO THE COPYRIGHT OFFICE

A. The government devotes much of its merits presentation to proving an undisputed proposition: that the Copyright Act sometimes uses the word "registration" to refer to an action of the Copyright Office. *See* Pet. 21 (noting that 17 U.S.C. § 410(a) and (b) so use the word). But the statute also repeatedly uses variants of the construction "makes registration" to refer to the copyright owner's submission of an application and compliance with the required formalities. *See* Pet. 19-21 (cataloging Congress's use of those variants in 17 U.S.C. §§ 408(c)(3) and (e), 411(c), and 412(2)). As the petition explains, that is how Congress used that construction in § 411(a).

The government argues that the second sentence of § 411(a) – which permits a copyright owner "to institute a civil action" after "registration has been refused" – supports the conclusion that the Register must act on an application before any suit can be initiated. U.S. Br. 14-15; *see also* Opp. 9. But that hardly follows: the second sentence of § 411(a) imposes an additional procedural requirement in cases initiated after registration is refused. It does not preclude initiation of a suit in cases where the copyright owner has made registration but the Register has not acted, and it does not speak to the procedure that should be followed in those unusual cases where registration is refused after a suit is initiated. As petitioner has explained (Pet. 18-19), the government's reading of the second sentence of § 411(a) creates an internal contradiction that petitioner's reading avoids; the government's attempt (at 19-20) to wave away the point is unavailing.

B. The government does not directly contest the point that the phrase "registration has been made" is used in the statute to refer to the action of the copyright owner, not any subsequent action by the Register. Instead, it argues (at 20) that, on its reading of the statute, the copyright owner's actions are not "divorced from the process by which copyright 'registration' is 'made.'" But that far vaguer claim sidesteps petitioner's point: the Copyright Act's consistent use of "makes registration" to refer to something done by the copyright owner, *rather than* by the Copyright Office, is strong evidence that the statute uses the same phrase in the same way in § 411(a).

The government also argues (at 21) that the statute sometimes uses the phrase in a way that refers to

the actions of the Register, but the two provisions it cites do not support the government's reading.

1. Section 205 – which permits recordation in the Copyright Office of "document[s] pertaining to a copyright," including those that pertain to a transfer of ownership, 17 U.S.C. § 205(a) – supports petitioner's reading of the statute, not the government's. Section 205(c) provides that recordation "gives all persons constructive notice of the facts stated in the recorded document" "only if" "(1) the document, or material attached to it, specifically identifies the work to which it pertains so that, after the document is indexed by the Register of Copyrights, it would be revealed by a reasonable search under the title or registration number of the work"; and "(2) registration has been made for the work." *Id.* § 205(c).

This provision does not suggest that the phrase "registration has been made" refers to the action of the Copyright Office rather than to the action of the copyright owner. It points in the opposite direction. Suppose that (1) an author took out a loan against the value of the author's copyright in a work; (2) the lender had a security interest in the copyright; (3) the author had applied for registration; but (4) the registration certificate had not yet been issued. Under petitioner's reading of the phrase "registration has been made," the lender gains protection against a subsequent transferee of the copyright by recording the lien in the manner prescribed in § 205(a) as long as the author has made registration of the work by sending the required application, copies, and fee – whether or not the Copyright Office has yet issued a certificate of registration.

The statute expressly provides that the "Register of Copyrights shall . . . record *the document*" – that is, the document pertaining to the copyright – "and return it with a certificate of recordation." *Id.* § 205(b) (emphasis added). Thus, whether or not a certificate of registration has issued, parties will have constructive notice of the recorded *document* because they will be able to find the indexed document "under the title . . . of the work" – even if a "registration number" is not yet available. On the government's reading, the lender would be in jeopardy until the registration certificate issued, but there is no evident reason that Congress would have desired that result, and nothing in the statute supports it.

2. Section 406(a) – which addresses the consequences of an error in a copyright notice on copies distributed before March 1, 1989 – is at most ambiguous. That provision makes clear that an error in a copyright notice (1) does not affect "validity or ownership of the copyright" but (2) does provide a "complete defense" to "any person who innocently begins an undertaking that infringes the copyright" if the person "proves that he or she was misled by the notice and began the undertaking in good faith under a purported transfer or license from the person named" in the copyright notice. 17 U.S.C. § 406(a). There are two situations, however, in which that defense is unavailable, including if "registration for the work had been made in the name of the owner of copyright." *Id.* § 406(a)(1).

The government insists (at 19) that, because this is a "constructive notice" provision, it would make no sense to deprive an infringer of the defense before registration is granted and recorded. But because the "effective date of a copyright registration," 17

U.S.C. § 410(d), is the date that the copyright owner files the application and required copies and fees, it is possible under either competing reading of the statute that the infringer would lose the defense as of that date. That result is not surprising: the statute similarly limits awards of "statutory damages or of attorney's fees" for infringement of copyright in unpublished, unregistered works – presumably for similar reasons related to fair notice – but expressly authorizes them for infringement after the "effective date" of registration. *Id.* § 412. The statute grants a copyright owner the benefit of registration as of the date that the owner had done everything to make registration. Section 411(a) – which authorizes a civil action at the same juncture – fits comfortably into that statutory framework.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

JOEL B. ROTHMAN
JEROLD I. SCHNEIDER
SCHNEIDER ROTHMAN
INTELLECTUAL PROPERTY
LAW GROUP, PLLC
4651 N. Federal Highway
Boca Raton, Florida 33431
(561) 404-4350

AARON M. PANNER
Counsel of Record
GREGORY G. RAPAWY
COLLIN R. WHITE
KELLOGG, HANSEN, TODD,
FIGEL & FREDERICK, P.L.L.C.
1615 M Street, N.W.
Suite 400
Washington, D.C. 20036
(202) 326-7900
(apanner@kellogghansen.com)

June 5, 2018

No. 17-571

In the Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE SUPPORTING RESPONDENTS

NOEL J. FRANCISCO
Solicitor General
Counsel of Record
JOSEPH H. HUNT
Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
JONATHAN Y. ELLIS
Assistant to the Solicitor General
MARK R. FREEMAN
DENNIS FAN
Attorneys

Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

REGAN A. SMITH
General Counsel and Associate Register of Copyrights
JASON E. SLOAN
Assistant General Counsel
United States Copyright Office
Washington, D.C. 20540

QUESTION PRESENTED

Section 411(a) of the Copyright Act provides that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with this title" or (2) "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused." 17 U.S.C. 411(a). The question presented is as follows:

Whether a copyright owner may commence an infringement suit after delivering the proper deposit, application, and fee to the Copyright Office, but before the Register of Copyrights has acted on the application for registration.

TABLE OF CONTENTS

Page

Interest of the United States 1
Statement 1
Summary of the argument 11
Argument:
Under Section 411(a), a copyright-infringement suit may not be filed until the Register of Copyrights has either approved or refused registration of the work 14
A. The text and structure of the Copyright Act support the court of appeals' interpretation of Section 411(a) 14
B. The history of the Copyright Act supports the court of appeals' interpretation of Section 411(a) 22
C. Petitioner's contrary arguments are unavailing 26
Conclusion 33
Appendix A — United States Copyright Office letter to William Brown (Apr. 4, 2016) 1a
Appendix B — United States Copyright Office letter to William Brown (Aug. 4, 2017) 3a

TABLE OF AUTHORITIES

Cases:

Algonquin Music, Inc. v. *Mills Music, Inc.*, 93 F. Supp. 268 (S.D.N.Y. 1950) 23
Bouvé v. *Twentieth Century-Fox Film Corp.*, 122 F.2d 51 (D.C. Cir. 1941) 24
Carr v. *United States*, 560 U.S. 438 (2010) 30
Clark v. *Rameker*, 134 S. Ct. 2242 (2014) 17
Eldred v. *Ashcroft*, 537 U.S. 186 (2003) 33
Feist Publ'ns, Inc. v. *Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) 10
Golan v. *Holder*, 565 U.S. 302 (2012) 31
Hall v. *United States*, 566 U.S. 506 (2012) 18

Cases—Continued: Page

Lumiere v. *Pathé Exch., Inc.*, 275 F. 428 (2d Cir. 1921) 23
Mazer v. *Stein*, 347 U.S. 201 (1954) 30
Petrella v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014) 16
Reed Elsevier, Inc. v. *Muchnick*, 559 U.S. 154 (2010) 6, 31
Rosedale v. *News Syndicate Co.*, 39 F. Supp. 357 (S.D.N.Y. 1941) 23
Roth Greeting Cards v. *United Card Co.*, 429 F.2d 1106 (9th Cir. 1970) 17, 25
Star Athletica, L.L.C. v. *Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) 14
Vacheron & Constantin-Le Coultre Watches, Inc. v. *Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958) 23, 24
Vermont Agency of Natural Res. v. *United States ex rel. Stevens*, 529 U.S. 765 (2000) 21
Washingtonian Publ'g Co. v. *Pearson*, 306 U.S. 30 (1939) 3, 32
Wheaton v. *Peters*, 33 U.S. (8 Pet.) 591 (1834) 2
White-Smith Music Publ'g Co. v. *Goff*, 187 F. 247 (1st Cir. 1911) 25

Statutes and regulations:

Act of May 31, 1790, ch. 15, 1 Stat. 124 2
§ 2, 1 Stat. 124 3
§ 3, 1 Stat. 125 ..... 15, 22
§§ 3-4, 1 Stat. 125 2
Act of July 8, 1870, ch. 230, 16 Stat. 198:
§§ 90-91, 16 Stat. 213 3
§ 91, 16 Stat. 213 ..... 15, 22
§ 97, 16 Stat. 214 3
§§ 99-100, 16 Stat. 214 ..... 3, 22

Statutes and regulations—Continued: Page

Act of Feb. 19, 1897, ch. 265, 29 Stat. 545 3
Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075:
§ 9, 35 Stat. 1077 3
§ 10, 35 Stat. 1078 4
§ 12, 35 Stat. 1078 ..... 4, 12, 17, 23
Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (17 U.S.C. 101 *et seq.*) 1
17 U.S.C. 101 6
17 U.S.C. 102(a) 1
17 U.S.C. 106 2
17 U.S.C. 205(c) 28, 29
17 U.S.C. 205(c)(1) 29
17 U.S.C. 406(a) 29, 30
17 U.S.C. 406(a)(1) 29
17 U.S.C. 408 ..... 16, 20
17 U.S.C. 408(a) 4, 6, 27
17 U.S.C. 408(b) 4
17 U.S.C. 408(c)(3) 27
17 U.S.C. 408(f) 21, 22, 32
17 U.S.C. 408(f)(2) 22
17 U.S.C. 408(f)(3) 12, 20
17 U.S.C. 409 ..... 4, 16, 20
17 U.S.C. 410 4
17 U.S.C. 410(a) 4, 9, 11, 16, 21
17 U.S.C. 410(b) 5
17 U.S.C. 410(c) 7, 31
17 U.S.C. 410(d) 6, 12, 21, 28, 29
17 U.S.C. 411 6
17 U.S.C. 411(a) ..... *passim*
17 U.S.C. 411(b)(1) 6, 16
17 U.S.C. 411(c) 27, 28, 32

Statutes and regulations—Continued: Page

17 U.S.C. 411(c)(2) 27
17 U.S.C. 412 ..... 7, 27, 32
17 U.S.C. 412(2) 27, 28
17 U.S.C. 501(a) 2
17 U.S.C. 502 2
17 U.S.C. 503 2
17 U.S.C. 504 2
17 U.S.C. 504(a)(2) 7
17 U.S.C. 504(c) 7
17 U.S.C. 504(c)(1) 33
17 U.S.C. 504(c)(2) 33
17 U.S.C. 505 ..... 2, 7
17 U.S.C. 508 20
17 U.S.C. 508(a) 19
17 U.S.C. 508(b) 20
17 U.S.C. 508(c) 20
17 U.S.C. 705 29
17 U.S.C. 705(a) 4, 15, 32
17 U.S.C. 705(b) 4, 32
17 U.S.C. 708 4
17 U.S.C. 708(a) 28
17 U.S.C. 708(a)(1) 4, 12, 20
37 C.F.R.:
Section 201.3(d)(7) 5
Section 202.16(b)(1) 22
Section 202.16(c) 22

Miscellaneous: Page

Caruthers Berger, *Study No. 18: Authority of the Register of Copyrights to Reject Applications for Registration* (1959), *reprinted in* Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revision: Studies Prepared Pursuant to S. Res. 240, Studies 17-19* (Comm. Print 1960) 25

Black's Law Dictionary:

(revised 4th ed. 1968) 15, 20

(10th ed. 2014) 15

134 Cong. Rec. 28,302-28,303 (1988) 6

Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess. (Comm. Print 1961) 25, 26

83 Fed. Reg. 24,054 (May 24, 2018) 5

H.R. Rep. No. 199, 115th Cong., 1st Sess. (2017) 5

H.R. Rep. No. 1476, 94th Cong., 2d Sess. (1976) 24, 30

Prof. Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (1958), *reprinted in* Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revision: Studies Prepared Pursuant to S. Res. 240, Studies 17-19* (Comm. Print 1960) 2

U.S. Copyright Office:

Compendium of U.S. Copyright Office Practices (3d ed. 2017) 4, 5, 8, 10, 16

Public Catalog, http://cocatalog.loc.gov (last visited Oct. 18, 2018) 5

Miscellaneous—Continued: Page

Registration Processing Times, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (last visited Oct. 18, 2018)..... 5, 10, 30

Webster's Third New International Dictionary (1966)..... 15

In the Supreme Court of the United States

No. 17-571

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE SUPPORTING RESPONDENTS

INTEREST OF THE UNITED STATES

This case presents the question whether a copyright owner may commence a suit for copyright infringement before the Register of Copyrights, as director of the Copyright Office, has acted on the owner's application for registration. The United States has a substantial interest in the resolution of that question, as the Copyright Office is responsible for copyright registration. At the Court's invitation, the United States filed a brief as amicus curiae at the petition stage of this case.

STATEMENT

1. The Copyright Act of 1976 (Copyright Act or 1976 Act), 17 U.S.C. 101 *et seq.*, grants copyright protection to "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. 102(a). Among other rights and benefits, copyright protection confers on

owners the exclusive rights to copy, distribute, and perform the works. 17 U.S.C. 106. Anyone who violates these rights is "an infringer of the copyright" and may be held liable to the copyright owner for actual or statutory damages, injunctive relief, and attorney's fees and costs. 17 U.S.C. 501(a), 502, 503, 504, 505.

Beginning with the initial Copyright Act, Act of May 31, 1790 (1790 Act), ch. 15, 1 Stat. 124, Congress has provided for the official registration of copyrighted works. See Prof. Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (1958), *reprinted in* Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revision: Studies Prepared Pursuant to S. Res. 240, Studies 17-19*, at 9-27 (Comm. Print 1960). Congress has generally required that such registration be completed before a copyright owner could commence an action for infringement.

a. The 1790 Act required each author first to deposit a copy of his work prior to its publication with the clerk's office of the district court where the author resided, so that the clerk could "record the same forthwith, in a book to be kept by him for that purpose," and then to publish notice of the copyright record in a newspaper for four weeks. 1790 Act §§ 3-4, 1 Stat. 125. Under that law, compliance with the deposit requirement was a prerequisite to copyright protection. See *Wheaton* v. *Peters*, 33 U.S. (8 Pet.) 591, 663 (1834) (noting that "a right accrues under the act of 1790, from the time a copy of the title of the book is deposited in the clerk's office"). The 1790 Act conferred on each author a cause of action, "from and after the recording the title of any" copyrighted work, through which an infringer

could be required to forfeit any infringing works and to pay damages. 1790 Act § 2, 1 Stat. 124.

Over the next century, Congress consolidated the registration functions within the Library of Congress, while maintaining registration as a precondition to copyright protection. In 1870, Congress required each author to "deposit in the mail" a copy or description of her work for delivery to the Library of Congress before publication, so that the Librarian of Congress could "record the name of such copyright book, or other article, forthwith in a book to be kept for that purpose." Act of July 8, 1870 (1870 Act), ch. 230, §§ 90-91, 16 Stat. 213. The 1870 Act also provided that "no person shall maintain an action for the infringement of his copyright" in a work unless he included in the work a notice that it had been "[e]ntered according to act of Congress * * * in the office of the librarian of Congress, at Washington," § 97, 16 Stat. 214, and it conferred a cause of action available "after the recording of the title" of the copyrighted work, §§ 99-100, 16 Stat. 214. In 1897, Congress established the office of the Register of Copyrights within the "Copyright Department" (now the Copyright Office) of the Library of Congress and directed the Register to "perform all the duties relating to copyrights." Act of Feb. 19, 1897, ch. 265, 29 Stat. 545.

In 1909, Congress changed prior law to provide that registration was not a precondition to copyright protection for published works. See Act of Mar. 4, 1909 (1909 Act), ch. 320, § 9, 35 Stat. 1077 ("[A]ny person entitled thereto by this Act may secure copyright for his work by publication thereof with the notice of copyright required by this Act."); *Washingtonian Publ'g Co.* v. *Pearson*, 306 U.S. 30, 37 (1939). The 1909 Act continued to provide for registration of works by the Register of

Copyrights, 1909 Act §§ 10, 12, 35 Stat. 1078, however, and it stated that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with," § 12, 35 Stat. 1078.

b. The current Copyright Act continues to provide for the registration of works by the Register as director of the Copyright Office. 17 U.S.C. 408(a), 410. A copyright owner generally "may obtain registration of the copyright claim by delivering to the Copyright Office" two deposit copies of the work, an application containing information about the work, and the application fee. 17 U.S.C. 408(a) and (b), 409, 708. When the Register receives those materials, she "examin[es]" the "material deposited" to determine whether the work "constitutes copyrightable subject matter" and whether "other legal and formal requirements of [the Copyright Act] have been met." 17 U.S.C. 410(a).

If "after examination" the Register determines that the work is copyrightable and that all legal and formal requirements are satisfied, "the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office." 17 U.S.C. 410(a). The copyright owner's original application fee covers the "issuance of a certificate of registration if registration is made." 17 U.S.C. 708(a)(1). The Office also creates an official public record of registrations, entering into its records catalog the "records of * * * registrations" and making public "the articles deposited in connection with completed copyright registrations." 17 U.S.C. 705(a) and (b); see U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 209 (3d ed. 2017) (*Compendium*). Records of post-

1977 registered works are available on the Internet to be searched by the public. See U.S. Copyright Office, *Public Catalog*, http://cocatalog.loc.gov. If the Register instead "determines that * * * the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration." 17 U.S.C. 410(b).

The examination process often involves a dialogue between the Copyright Office and the applicant. In the course of such correspondence, an owner may clarify the scope of his application or may withdraw or otherwise abandon his claim. *Compendium* §§ 605.3(B), 605.7, 605.9. Depending on the necessary correspondence and the complexity of the legal issues presented, the time to complete this process varies. The average time for the Copyright Office to resolve a registration application is approximately seven months. See U.S. Copyright Office, *Registration Processing Times* 1, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (*Registration Processing Times*).[1] For an additional fee, however, an applicant may request expedited processing, and "the Office will make every attempt to examine the application or the document within five working days." *Compendium* § 623.4; see *id.* § 623.6; see also 37 C.F.R. 201.3(d)(7) ($800-per-

---

[1] After fiscal year 2016, the Copyright Office has "engaged in a variety of regulatory reforms that are projected to increase the efficiency of various registration, recordation, or licensing activities." 83 Fed. Reg. 24,054, 24,055 (May 24, 2018) (citation omitted). Additionally, the Office is modernizing its information-technology systems over the next five years. *Ibid.*; see H.R. Rep. No. 199, 115th Cong., 1st Sess. 19 (2017) (stating that the "modernization of the [Office's] electronic copyright registration system is of utmost importance").

application fee for expedited processing). If the Register ultimately grants registration of a work, the effective date of that registration is the date on which the Copyright Office first received a proper application, deposit, and fee. See 17 U.S.C. 410(d).

c. Although registration is not a "condition of copyright protection," 17 U.S.C. 408(a), the current Copyright Act provides a number of incentives for owners to seek registration promptly.

As most relevant here, Section 411(a) states that "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. 411(a).[2] That provision establishes a non-jurisdictional "precondition to filing a claim" of infringement. *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154, 157 (2010). Unless the owner has knowingly submitted an inaccurate application, the Register's issued certificate of registration "satisfies the requirements of" Section 411. 17 U.S.C. 411(b)(1). Section 411(a) further provides that, "[i]n any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil

---

[2] In general, "United States work[s]" are works first published in the United States or created exclusively by domestic authors. 17 U.S.C. 101. Amicus International Trademark Association suggests (Br. 7-13) that Section 411(a) may not satisfy the requirements of the Berne Convention. Congress addressed that issue, however, by excusing owners of non-United States works from the requirement to register before filing suit. See 17 U.S.C. 411(a); 134 Cong. Rec. 28,302-28,303 (1988); see also Pet. Br. 10 n.6. There is no dispute in this case that the works at issue are "United States work[s]." 17 U.S.C. 411(a).

action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a). Within the 60-day period after such notice has been served, the Register may intervene "with respect to the issue of registrability of the copyright claim." *Ibid.*

The Copyright Act creates additional incentives for prompt submission of applications to register authors' works. The Act authorizes awards of statutory damages, costs, and attorney's fees to prevailing copyright owners. 17 U.S.C. 504(a)(2) and (c), 505. Subject to limited exceptions, however, those remedies are available only for acts of infringement commenced after the effective date of registration. 17 U.S.C. 412. In addition, a "certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. 410(c).

2. Petitioner Fourth Estate Public Benefit Corporation generates online news content and licenses its news articles to others while retaining ownership of its works. Pet. App. 2a, 16a. Respondents Wall-Street.com and its owner initially entered into such a licensing agreement to display petitioner's works online. *Ibid.* That agreement required respondents to cease displaying those works if respondents ever cancelled the agreement. *Id.* at 2a, 18a-19a. Petitioner alleges that respondents cancelled their licensing agreement but continued to display petitioner's news articles on their website without permission. *Ibid.*

In early March 2016, petitioner deposited a number of articles with the Copyright Office and submitted an application and fee for registration of an automated

computer database. See App., *infra*, 3a-4a. "For purposes of copyright registration, a database is defined as a compilation of digital information" where the "selection, coordination, and/or arrangement of data or other component elements within the database is sufficiently creative to warrant registration." *Compendium* §§ 1117.1, 1117.2. Petitioner did not request expedited processing of its copyright claim.

On March 11, 2016, before the Register had acted on the application, petitioner filed this copyright-infringement suit. Pet. App. 15a-22a. The complaint stated that petitioner had filed "applications to register [its] articles with the Register of Copyrights immediately prior to the filing of this case," and that petitioner would file the certificate of registration with the court when it received the certificate. *Id.* at 18a. The complaint further stated that "when issued by the Register of Copyrights the registration certificate will be dated prior to the filing of this action." *Ibid.* Petitioner sought injunctive relief, actual or statutory damages, and attorney's fees and costs. *Id.* at 21-22a.

After the commencement of this suit, Copyright Office records indicate that the Office sent a letter to the contact listed in petitioner's application, informing him that petitioner's check for the application fee could not be processed. App., *infra*, 1a-2a. A week later, on April 11, 2016, the Copyright Office received a collectable fee, permitting it to examine petitioner's application materials. See *id.* at 3a-4a.

3. a. While petitioner's application for registration remained pending, the district court dismissed the complaint without prejudice. Pet. App. 11a-14a. While recognizing that registration is not "a jurisdictional requirement" for a copyright-infringement suit, the court

explained that the absence of registration "is nonetheless a procedural bar to infringement claims." *Id.* at 13a. The court rejected petitioner's argument that having "an application to register * * * pending at the time of the suit * * * is sufficient to survive a motion to dismiss." *Ibid.*

b. The court of appeals affirmed. Pet. App. 1a-10a. The court held that, for purposes of Section 411(a)'s directive that no copyright-infringement suit may be instituted "until preregistration or registration of the copyright claim has been made in accordance with this title," 17 U.S.C. 411(a), registration of a copyright "'has [not] been made in accordance with . . . title [17]' * * * until 'the Register . . . registers the claim.'" Pet. App. 6a (quoting 17 U.S.C. 410(a), 411(a)) (brackets in original). The court explained that "[t]he Copyright Act defines registration as a process that requires action by both the copyright owner and the Copyright Office." *Ibid.* Although the Act requires the owner to commence the registration process by submitting a deposit, application, and fee, it directs the Register to "examine[]" the submissions and to "determine[]" whether the work is copyrightable before approving or refusing registration. *Ibid.* The court concluded that "[f]iling an application does not amount to registration" as that term is used in the Copyright Act, *ibid.*, and that petitioner's arguments grounded in "legislative history and policy" could not overcome Section 411(a)'s plain meaning, *id.* at 8a-9a.

4. In August 2017, after the court of appeals' mandate had issued, Copyright Office records indicate that the Office notified petitioner of the Register's disposition of petitioner's application. App., *infra*, 3a-9a. The

Office stated that, if the claim were ultimately registered, the effective date of registration would be April 11, 2016, when a proper fee was received. *Id.* at 3a-4a.[3] It further explained, however, that the Register was refusing registration. *Id.* at 3a.

Noting that petitioner had sought registration on the ground that its news articles comprised a database, the Copyright Office explained that the registrability of a database, as a type of compilation, depends on whether the selection and arrangement of the elements displays sufficient originality to qualify as a work of authorship. App., *infra*, 7a (citing *Feist Publ'ns, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)). The Office concluded that the selection and arrangement of petitioner's database, in which individual articles were arranged in chronological order, lacked sufficient originality to warrant registration. *Ibid.* The Office also noted that the articles appeared to be from a news website, and that for registration purposes the *Compendium* distinguishes between websites and databases. *Id.* at 8a (citing *Compendium* § 1002.6).[4]

---

[3] Petitioner's application fell within the category of copyright claims with the longest processing times. See *Registration Processing Times* 1. Applications submitted by mail that require further correspondence constitute about two percent of all applications. *Ibid.* The processing time for those applications varies between three and 37 months depending on the issues that arise. *Ibid.*

[4] Petitioner notes (Br. 16) that AHN Feed Syndicate (petitioner's licensee) had previously made "group registration for databases containing the same type of material at issue here." But the merits of the Copyright Office's decision to refuse registration—including the relevance of the Office's recent clarification of the distinction between websites and databases—are not at issue in this Court.

SUMMARY OF THE ARGUMENT

Under Section 411(a) of the Copyright Act, a copyright-infringement suit may not be filed until the Register of Copyrights has either approved or refused registration of the work.

A. Several aspects of Section 411(a) itself, and of the larger statutory scheme, support the court of appeals' conclusion that "registration of [a] copyright claim has been made," 17 U.S.C. 411(a), only when the Register has approved an application. In this context, the term "registration" is naturally read to denote the Register's entry of a claim of copyright into the official register. Section 411(a)'s requirement that registration have been made "in accordance with this title" reinforces this understanding. Although the owner of a copyright initiates the registration process by submitting specified materials to the Copyright Office, registration "in accordance with" Title 17 occurs only "after examination" of that submission by the Register, who "determines" whether the submission is "acceptable for registration" and (if the statutory requirements are satisfied) "register[s] the claim." 17 U.S.C. 410(a) and (d).

Section 411(a)'s second and third sentences bolster that conclusion. The second sentence's exception to the registration requirement, which allows an infringement suit to be commenced when "registration has been refused," would be superfluous if "registration" were "made" at the moment a copyright owner submits the required materials to the Register. And Section 411(a)'s third sentence, which authorizes the Register to intervene in cases where registration is refused, could not fully serve its intended purpose if the applicant could initiate suit, and the district court potentially

could decide the merits, before the Register had rendered her registration decision.

Other Copyright Act provisions confirm the court of appeals' interpretation. The Act describes a copyright owner's submission of his deposit, application, and fee as an "application for registration," not as "registration" itself. 17 U.S.C. 408(f)(3) (capitalization altered). The Act states that the fees paid for filing an "application * * * for registration" should also cover "the issuance of a certificate of registration if registration is made." 17 U.S.C. 708(a)(1). The Act's backdating provision, under which the effective date of registration is the day on which an application, deposit, and fee are submitted in proper form, 17 U.S.C. 410(d), would be unnecessary if the submission itself "made" registration. And the Act's preregistration regime, which allows owners of copyrights in certain classes of works to sue for infringement before registration, would serve little purpose if every copyright owner could always file suit as soon as he applied for registration.

B. The Copyright Act's history likewise supports the court of appeals' interpretation of Section 411(a). The immediate predecessor to Section 411(a) provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with." 1909 Act § 12, 35 Stat. 1078. Courts interpreted that provision to require dismissal of any infringement suit that was filed before the owner had obtained a certificate of registration. Some courts further held that, even after registration had been refused, a copyright owner could not institute an infringement suit unless it

first obtained a writ of mandamus compelling the Register to grant registration of the copyright.

By authorizing a copyright owner to institute an infringement suit when he has delivered "the deposit, application, and fee required for registration * * * and registration has been refused," 17 U.S.C. 411(a), the 1976 Act abrogated the requirement to seek a writ of mandamus after such a refusal. But Section 411(a)'s first sentence continues in effect the pre-existing general rule that no infringement suit can be filed unless the Copyright Office has registered the relevant copyright.

C. Petitioner's contrary arguments are unpersuasive. Petitioner principally contends that, while the term "registration" can refer to the actions of either the copyright owner or the Register, the phrase "registration has been made" throughout the Act refers only to the copyright owner's submission of an application for registration. But petitioner's examples demonstrate only that, while the copyright owner's actions are necessary to initiate the registration process, "registration" is not "made" unless and until the Register approves an application. Indeed, several provisions use the phrase "registration has been made" (or a close variant) in ways that make sense only if that phrase refers to the Register's ultimate approval of the application.

Petitioner also contends that, because the Act's exclusive rights, right to sue, and remedies are ultimately available whether the Register approves or refuses registration, waiting for the Register of Copyrights to determine registration would serve no useful purpose. But while a copyright owner may sue regardless of the Copyright Office's conclusion as to registrability, the court will benefit from knowing what that conclusion is. And

although petitioner expresses concern that the registration requirement may temporarily prevent copyright owners from enforcing their rights, that is the intended result of a congressional design to encourage prompt registration for the public benefit. Congress has provided various means of mitigating these risks, in circumstances where they are particularly acute, while maintaining a strong incentive for prompt submission of applications to register copyrights more generally.

ARGUMENT

UNDER SECTION 411(a), A COPYRIGHT-INFRINGEMENT SUIT MAY NOT BE FILED UNTIL THE REGISTER OF COPYRIGHTS HAS EITHER APPROVED OR REFUSED REGISTRATION OF THE WORK

The text, structure, and history of the Copyright Act confirm that, under Section 411(a), the Register of Copyrights must have acted on an application for copyright registration—either by approving or refusing registration—before the copyright owner may institute an infringement suit. The court of appeals correctly affirmed the dismissal of petitioner's suit, which was instituted before the Register had acted on petitioner's application for registration. Petitioner's contrary arguments are unavailing.

A. The Text And Structure Of The Copyright Act Support The Court Of Appeals' Interpretation Of Section 411(a)

In construing Section 411(a), this Court begins "with the text, giving each word its 'ordinary, contemporary, common meaning,'" and "'look[s] to the provisions of the whole law to determine [the Section's] meaning.'" *Star Athletica, L.L.C.* v. *Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (citations omitted). Section 411(a)

states that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with this title," or (2) "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused." 17 U.S.C. 411(a). Several aspects of Section 411(a) itself, and of the larger statutory scheme, support the court of appeals' conclusion that "registration of [a] copyright claim has been made," *ibid.*, only when the Register has approved an application.

1. The term "registration" in Section 411(a) is most naturally read to refer to the Copyright Office's official recording of an accepted copyright claim. The term "registration" signifies an authoritative act of "[r]ecording" or "inserting in an official register." *Black's Law Dictionary* 1449 (revised 4th ed. 1968); see *Webster's Third New International Dictionary* 1912 (1966) ("something registered" or "an entry in a register"); see also *Black's Law Dictionary* 1474 (10th ed. 2014) ("The act of recording or enrolling."). Since 1790, federal copyright law has consistently provided for recordation or registration of copyrights *by a government official*, whether the copyright was "record[ed]" by the clerk of the district court (1790 Act § 3, 1 Stat. 125), "record[ed]" by the Librarian of Congress (1870 Act § 91, 16 Stat. 213), or maintained as "records of * * * registrations" by the Register of Copyrights (17 U.S.C. 705(a)).

Where copyrighted works are involved, "registration" thus denotes the act of the eponymous Register of Copyrights in entering a claim of copyright into the official register. See 17 U.S.C. 705(a) (requiring public catalog of "records of * * * registrations" and "the articles

deposited in connection with completed copyright registrations"); *Compendium*, Glossary 14 ("Registration involves examining the claim, and if the claim is approved by the U.S. Copyright Office, numbering the claim, issuing a certificate of registration, and creating a public record."). If Congress had intended to adopt the rule that petitioner advocates, it could have omitted the requirement that "registration * * * ha[ve] been made," and could have combined language from the first two sentences of Section 411(a), to provide that "no civil action for infringement of the copyright in any United States work shall be instituted until the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form."

Section 411(a)'s requirement that "registration" have been "made in accordance with this title" reinforces this natural meaning. 17 U.S.C. 411(a). Under Title 17, the copyright owner initiates the registration process by delivering a deposit, application, and fee to the Copyright Office. See 17 U.S.C. 408, 409. Registration "in accordance with" Title 17 occurs, however, only "after examination" of those submissions by the Register, who "determines" whether the submissions are "acceptable for registration." 17 U.S.C. 410(a) and (d). Only then does the Register "register the claim," by recording the work as copyrightable, and "issue to the applicant a certificate of registration under the seal of the Copyright Office." 17 U.S.C. 410(a); see 17 U.S.C. 411(b)(1) (explaining that the "certificate of registration satisfies the requirements of [Section 411(a)]"). Thus, in the ordinary case, "both the certificate and the original work must be on file with the Copyright Office before a copyright owner can sue for infringement." *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1977 (2014).

2. The second sentence of Section 411(a), which creates an exception to the registration requirement for circumstances in which the Register refuses registration, confirms that conclusion. That sentence provides: "In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a). Thus, a copyright owner who has submitted a procedurally compliant application package may file an infringement suit once the Register has refused registration. That exception would be superfluous if an applicant could commence suit under the first sentence of Section 411(a) as soon as he had submitted the required materials. See *Clark* v. *Rameker*, 134 S. Ct. 2242, 2248 (2014) ("[A] statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous.") (citation omitted).

Petitioner reads (Br. 30-31) Section 411(a)'s second sentence to mean that, although a copyright owner may initiate suit as soon as the required materials have been submitted, he must notify the Register about the suit if the Register refuses registration while the litigation is ongoing. But if Congress had intended that result, it could have made notice to the Register a precondition for the copyright owner to "maintain" or "continue with" the suit. The 1909 Act's precursor to current Section 411(a) stated that no infringement action "shall be maintained" without complying with the registration requirement. 1909 Act § 12, 35 Stat. 1078; see *Roth Greeting Cards* v. *United Card Co.*, 429 F.2d 1106, 1108 (9th

Cir. 1970) (noting that courts were "divided on the question of whether 'maintained,' as used in [the 1909 Act,] mean[t] 'begun' or 'continued'"). Section 411(a)'s second sentence, however, provides that, in circumstances where registration has been refused, "the applicant is entitled to *institute* a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a) (emphasis added). That language makes clear that, in cases where the Register refuses registration, the plaintiff must notify the Register at the time suit is commenced.

Under petitioner's approach, moreover, the term "registration" would have a quite different meaning in Section 411(a)'s second sentence than it has in the first. Petitioner construes (Br. 21) that term in the first sentence to refer solely "to the action of the copyright owner and not to the action of the Copyright Office." But the second sentence, which addresses cases in which "registration has been refused," 17 U.S.C. 411(a), clearly uses the term to refer to the Register's disposition of the application. "[I]dentical words and phrases within the same statute should normally be given the same meaning," *Hall* v. *United States*, 566 U.S. 506, 519 (2012) (citation omitted), and that common-sense understanding applies with particular force when the same word appears in consecutive sentences of a single statutory subsection.

Petitioner asserts (Br. 30) that the first two sentences of Section 411(a) would "contradict each other" if the "the second sentence w[ere to] mean that a suit for infringement may be instituted even though registration had *not* been made." But that is the point. As explained above, Section 411(a)'s second sentence is best understood to create an exception to the general

rule that "registration" must be "made" before an infringement suit may be commenced. To be sure, Congress could have communicated more precisely the relationship between the two sentences. But the word "however" in the second sentence at least makes clear that Congress understood that sentence as a departure from, or qualification of, the rule announced in the sentence that precedes it. Taken as a whole, Section 411(a) provides that a copyright owner may initiate infringement litigation if he has submitted a compliant application, deposit, and fee, and the Register has acted on that submission, either by granting or denying it. There is nothing substantively contradictory about that regime.

3. Petitioner's approach would also subvert the congressional purpose that underlies Section 411(a)'s third sentence, which authorizes the Register to intervene within 60 days in cases where registration has been refused. See 17 U.S.C. 411(a) (authorizing the Register to "become a party to the action with respect to the issue of registrability of the copyright claim" when she has refused registration). The evident purpose of that provision is to ensure that the Register can explain to the court in the infringement suit why she concluded that the requirements for registration were not satisfied. That provision could not fully serve its intended purpose if the applicant could initiate suit, and the district court potentially could decide the case on the merits, before the Register had either rendered her registration decision or received the mandated notice.

Petitioner observes (Br. 39 n.24) that, for each copyright-infringement suit, the clerk of the district court where suit is filed must notify the Register of Copyrights within one month of "the names and addresses of the parties and the title, author, and registration

number of each work involved in the action." 17 U.S.C. 508(a). The context in which that provision appears, however, makes clear that its purpose is to enable the Register to make the relevant information "a part of the public records of the Copyright Office," 17 U.S.C. 508(c), not to enable the Register to participate in such suits. Unlike Section 411(a), Section 508 does not authorize the Register to intervene in infringement suits. And under Section 508(b), the district court must likewise inform the Register "[w]ithin one month after any final order or judgment is issued in [an infringement] case," when participation by the Register is no longer possible. 17 U.S.C. 508(b).

4. Other Copyright Act provisions reinforce the conclusion that the Register must approve or refuse registration before the copyright owner may institute an infringement suit. Section 408 describes the copyright owner's submission to the Copyright Office of his deposit, application, and fee as an "application for registration." 17 U.S.C. 408(f)(3) (capitalization altered); see *Black's Law Dictionary* 127 (revised 4th ed. 1968) (defining "application" as "[t]he act of making a request for something"); see 17 U.S.C. 409 (requirements for "application for registration"). That language indicates that submission of the required materials is an action distinct from "registration" itself.

Section 708 states that the fees paid by a copyright owner for filing an "application under section 408 for registration of a copyright claim" must cover "the issuance of a certificate of registration *if registration is made*." 17 U.S.C. 708(a)(1) (emphasis added). That language again assumes that the copyright owner's "application" under Section 408 is distinct from the "ma[king]" of "registration," *and* that a certificate of registration will

be issued "if registration is made." That will be true only if the Register's approval of an application, rather than the applicant's submission of it, is the act by which "registration" is "made." See 17 U.S.C. 410(a) (providing that the Register will "register the claim and issue to the applicant a certificate of registration" if she determines that "the material deposited constitutes copyrightable subject matter" and that all "other legal and formal requirements" are met). Petitioner contends that Section 708 "sheds little light" (Br. 27) on the proper construction of Section 411(a), because Section 708 was added in 1982. But it is "well established that a court can, and should, interpret the text of one statute in the light of text of surrounding statutes, even those subsequently enacted." *Vermont Agency of Natural Res.* v. *United States ex rel. Stevens*, 529 U.S. 765, 786 n.17 (2000).

Petitioner's approach would also render superfluous Section 410(d), under which "the effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights * * * to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. 410(d). If "registration of [a] copyright claim" were "made" on the date those materials are submitted, 17 U.S.C. 411(a), there would be no need for the backdating rule of Section 410(d).

Petitioner's approach would also deprive the Copyright Act's "preregistration" regime of any significant practical effect. See 17 U.S.C. 408(f). Preregistration is available for limited classes of unpublished commercial works (such as prerelease versions of mainstream films) as to which the Copyright Office has found a history of infringement before commercial distribution.

Ibid. After the Copyright Office has conducted a truncated review based on a description of the unpublished work, see 17 U.S.C. 408(f)(2); 37 C.F.R. 202.16(b)(1) and (c), Section 411(a) permits the copyright owner to sue based on preregistration. The preregistration regime ensures that, for these limited classes of works, the copyright owner can seek a judicial remedy while its application for registration is pending before the Register. But if every copyright owner could file an infringement suit as soon as it had submitted the required deposit, application, and fee—*i.e.*, if the time required for the Register to examine and register a work would *never* delay the point at which an infringement suit could be commenced—there would be little need for the preregistration scheme.

B. The History Of The Copyright Act Supports The Court Of Appeals' Interpretation Of Section 411(a)

Since 1790, the Copyright Act has allowed a copyright owner to file an infringement suit only after the relevant authority has acted on an application to enter the copyright into the public record. The 1790 Act created a cause of action "from and after the recording the title of any copyright work," § 2, 1 Stat. 124-125, and directed the clerk of the district court to "record" the title "in a book to be kept by him for that purpose," § 3, 1 Stat. 125. The 1870 Act directed the Librarian of Congress to "record the name of" a copyrighted work upon his receipt of specified materials, § 91, 16 Stat. 213, and it authorized an infringement suit "after the recording of the title" of the work, §§ 99-100, 16 Stat. 214. The 1909 Act—the immediate predecessor to the current Copyright Act—provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of

copies and registration of such work shall have been complied with." § 12, 35 Stat. 1078. The courts' interpretation of the 1909 Act's registration requirement, and the subsequent changes that Congress made in drafting the 1976 Act, are particularly instructive here.

1. Courts interpreted the 1909 Act to require dismissal of any infringement suit that was filed before the owner had obtained a certificate of registration, even if the proper deposit had been made. See, *e.g.*, *Lumiere* v. *Pathé Exch., Inc.*, 275 F. 428, 430 (2d Cir. 1921) (affirming dismissal of suit and explaining that, "[w]hen this bill was filed, two copies of each of the [copyrighted] photographs had been deposited, but the registration required by the act had not been obtained"); *Algonquin Music, Inc.* v. *Mills Music, Inc.*, 93 F. Supp. 268, 268 (S.D.N.Y. 1950); *Rosedale* v. *News Syndicate Co.*, 39 F. Supp. 357, 357 (S.D.N.Y. 1941). As Judge Learned Hand explained, the 1909 Act required compliance with statutory provisions governing "'registration of [the] work'" as well as with those governing "'deposit of copies,'" and the court could "think of no other added condition for 'registration' but acceptance by the Register." *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637, 640-641 (2d Cir. 1958) (citation omitted).

The Second Circuit construed the 1909 Act to provide that, even after registration had been refused, a copyright owner could not commence an infringement suit unless it first obtained a writ of mandamus compelling the Register to grant registration of the copyright. See *Vacheron*, 260 F.2d at 639 ("Title 17 forbade any action for infringement of the copyright when the Register of Copyrights had refused * * * to accept [it].");

id. at 640 (discussing the use of mandamus in this context); see also, *e.g.*, *Bouvé* v. *Twentieth Century-Fox Film Corp.*, 122 F.2d 51, 52, 56 (D.C. Cir. 1941) (affirming entry of a writ of mandamus against the Register). By authorizing a copyright owner to "institute a civil action for infringement" when he has delivered "the deposit, application, and fee required for registration * * * and registration has been refused," the 1976 Act overrode that holding and made clear that a copyright owner need not obtain a writ of mandamus against the Register after such a refusal. 17 U.S.C. 411(a); see H.R. Rep. No. 1476, 94th Cong., 2d Sess. 157 (1976) (1976 House Report) ("The second and third sentences of section 411(a) would alter the present law as interpreted in *Vacheron*."). But the legislative history does not suggest that Congress intended to allow commencement of an infringement suit while the plaintiff's application for copyright registration remains pending. To the contrary, the House Report for the 1976 Act explained that "[t]he first sentence of section 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted." 1976 House Report 157.

2. Petitioner contends (Br. 32-36) that courts of appeals construing the 1909 Act were divided on the question whether a copyright owner could sue for infringement while his application for registration was pending. Petitioner argues (*ibid.*) that Congress, in enacting the 1976 Act, adopted the view (which petitioner ascribes to the First and Ninth Circuits) that action by the Register should not be a precondition to suit. That argument reflects a misunderstanding of the pertinent pre-1976 decisions.

The First and Ninth Circuit decisions on which petitioner relies held at most that a copyright owner could file an infringement suit after "registration was refused." *White-Smith Music Publ'g Co.* v. *Goff*, 187 F. 247, 247 (1st Cir. 1911); see *Roth Greeting Cards*, 429 F.2d at 1108 (applications returned to change the "category of registration"). As explained above, the Second Circuit in *Vacheron* reached a contrary conclusion. See pp. 23-24, *supra*. The "unsettled question" that Congress resolved in 1976 thus was "whether a claimant who has fulfilled the procedural requirements (deposit, application, and fee) for registration but has been refused registration * * * must first secure registration by a mandamus action against the Register before he can maintain a suit for infringement." Caruthers Berger, *Study No. 18: Authority of the Register of Copyrights to Reject Applications for Registration* (Mar. 1959), *reprinted in* Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revisions: Studies Prepared Pursuant to S. Res. 240, Studies 17-19*, at 97 (Comm. Print 1960) (recommending that copyright revision "clarif[y]" this question).

While the 1909 Act was in effect, the Register of Copyrights expressed the view that the rule announced in *Vacheron*, under which an unsuccessful copyright-registration applicant was required to obtain a writ of mandamus against the Register before commencing an infringement suit, was ill-advised. *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong., 1st Sess. 75 (Comm. Print 1961). The Register explained that "two successive actions * * * may be an expensive

burden," and that such a requirement was not necessary to give the Register "the opportunity to advise the court of the reasons for refusing registration." *Ibid.* Instead, the Register recommended to Congress that "[r]egistration should continue to be a prerequisite to an action for copyright infringement. But where the procedural requirements for obtaining registration have been fulfilled and the Register of Copyrights refuses registration, the claimant should be entitled to bring an infringement suit if the Register is notified and permitted to become a party to the suit." *Id.* at 76. Section 411(a)'s second and third sentences implement that recommendation. The provision's first sentence, however, continues in effect the pre-existing general rule that the Register's approval of an application for registration is a prerequisite to the filing of a copyright-infringement suit.

C. Petitioner's Contrary Arguments Are Unavailing

1. a. Petitioner states (Br. 28) that, within the Copyright Act, the term "registration" sometimes refers to "the action of the copyright holder in applying for registration" and sometimes refers to "the action of the Copyright Office." Petitioner contends (Br. 21), however, that throughout the 1976 Act, "the phrase 'make registration' and its passive-voice counterpart 'registration has been made'" are used to refer "to the action of the copyright owner and not to the action of the Copyright Office." That argument is misconceived. To be sure, the copyright owner's actions are a necessary part of the overall registration process. As the court below correctly held, however, even after the copyright owner has performed his role in that process, "registration" can be "made" only after the Register has performed hers.

Petitioner relies (Br. 24-25) on provisions describing how the copyright owner initiates the registration process. See 17 U.S.C. 408(a) (providing that "the owner * * * may obtain registration of the copyright claim by delivering to the Copyright Office" the deposit, application, and fee); 17 U.S.C. 408(c)(3) (providing that, in certain circumstances, "a single renewal registration may be made for a group of works by the same individual author * * * upon the filing of a single application and fee"). But petitioner does not and cannot dispute that, even when an applicant has submitted a procedurally compliant application for copyright registration, the Register is charged with determining whether the registration criteria (procedural and substantive) are satisfied. The provisions cited above do not suggest that the applicant "obtain[s] registration," or that "registration" is "made," at the moment the application is submitted.

Petitioner's reliance (Br. 22-23) on the three-month deadlines for registration in Sections 411(c) and 412 is similarly unavailing. Section 411(c) creates a narrow exception to Section 411(a)'s registration requirement, allowing an individual to file an infringement action for a live broadcast before applying for registration—indeed, before the broadcast is even fixed in a tangible medium—but only if the copyright owner "makes registration for the work * * * within three months after its first transmission." 17 U.S.C. 411(c)(2). Section 412(2) creates an exception to the bar on statutory damages and attorney's fees for an "infringement of copyright commenced after first publication of the work and before the effective date of its registration," but again only if "registration is made within three months after the first publication." 17 U.S.C. 412(2).

Petitioner argues (Br. 24) that it would "make no sense" for a copyright owner's ability to invoke those provisions to depend on the speed with which the Copyright Office acts on a registration application. But the Court need not adopt petitioner's strained reading of Section 411(a) to avoid that problem. Section 410(d) provides that, no matter when the Copyright Office acts, if registration is ultimately granted, its effective date "is the day on which an application, deposit, and fee * * * have all been received in the Copyright Office." 17 U.S.C. 410(d). As long as the effective date of registration falls within the three-month windows defined by Sections 411(c) and 412(2), the requirements of those provisions are met.

b. Other Copyright Act provisions that use the phrase "registration has been made" (or a close variant) plainly refer to circumstances in which the entire registration process, including the Copyright Office's disposition of the copyright owner's application to register his work, has been completed.

As petitioner acknowledges (Br. 27), Section 708(a), which provides that the filing fees for an application also encompass the fees for "the issuance of a certificate of registration if registration is made," 17 U.S.C. 708(a), is one such example. See pp. 20-21, *supra*. The Act also provides that recording with the Office a transfer of ownership or other document pertaining to a copyrighted work gives the public "constructive notice" of the facts in the recorded document if, *inter alia*, "registration has been made for the work." 17 U.S.C. 205(c). And in certain circumstances, a copyright infringer who began the infringement in good faith under a purported license from someone other than the copyright owner has a "complete defense" to infringement liability unless

"registration for the work had been made in the name of the owner of copyright." 17 U.S.C. 406(a). These constructive-notice provisions assume that, once "registration has been made," a public record will have been created. That will be true if, but only if, "registration" is "made" when the Register approves an application and the Copyright Office enters the registration into her records catalog. See 17 U.S.C. 705; pp. 4-5, *supra*.

Petitioner contends (Br. 26-27) that the "constructive notice" described by Section 205(c) must apply *before* the Register creates a public record of the copyrighted work, because otherwise a third party would not have constructive notice between the time an application for registration was filed and the time the copyright was registered. But there is nothing "odd [or] counterintuitive" (Br. 27) about the conclusion that the public will not be deemed to have notice of a recorded transaction pertaining to a copyrighted work before the registration record for that work is publicly available. Indeed, the other requirement for such constructive notice—that the recorded document "would be revealed by a reasonable search under the title *or registration number* of the work"—assumes that the Register has completed the registration process by approving the application. 17 U.S.C. 205(c)(1) (emphasis added).

Petitioner argues (Br. 25 n.19) that, even under the government's construction of Section 406(a)(1), an innocent infringer may be liable for infringement that occurs before the Register creates a public record of the work, because the date the application is filed may be treated as the date of registration under the backdating provision in Section 410(d). Petitioner is mistaken. Section 406(a)(1) refers not simply to the date of "registration," but to the date that "registration had been made."

Congress's use of the past-perfect tense indicates that the statute protects any infringement that occurs before the Register's actual approval of the copyright owner's application, not only infringement that occurs before the backdated effective date. Cf. *Carr* v. *United States*, 560 U.S. 438, 449-450 (2010); see 1976 House Report 149 (explaining that, under Section 406(a), "the innocent infringer is given a complete defense unless a search of the Copyright Office records would have shown that the owner was someone other than the person" who provided the license).

2. Petitioner contends (Br. 36-43) that, because the Act's exclusive rights, right to sue, and remedies are ultimately available whether the Register approves or refuses registration, it would be "paradoxical" and "strange" to defer the filing of suit until the Register has acted on the application. But while Section 411(a) allows a copyright owner to sue regardless of the Copyright Office's conclusion as to registrability, the court in adjudicating an infringement suit will benefit from knowing what that conclusion is. That is especially true in cases involving novel issues of copyright law. See, *e.g.*, *Mazer* v. *Stein*, 347 U.S. 201, 213 (1954) (relying on "the practice of the Copyright Office" to determine whether works were copyrightable).[5]

Indeed, multiple Copyright Act provisions make clear that the Register's determination is expected to play a meaningful role in litigation. A timely obtained

---

[5] Petitioner suggests (Br. 41) that the Copyright Office's views would be of little benefit in most cases because the "Office typically grants the overwhelming majority of applications." That suggestion elides the fact that the Office corresponds on a significant percentage of applications to cure some defect before registering the copyright claims. See *Registration Processing Times* 1.

certificate of registration constitutes "prima facie evidence of the validity of copyright and the facts stated in the certificate." 17 U.S.C. 410(c). Where registration is refused, the Register has a statutory right to intervene "with respect to the issue of registrability of the copyright claim." 17 U.S.C. 411(a). The congressional purposes underlying these provisions would be subverted if litigants could proceed with infringement suits before the Register had acted on their applications. And although petitioner suggests (Br. 39-41) several methods of staying infringement litigation while the Copyright Office processes an application, the Copyright Act does not leave the Register's role in litigation to judicial discretion. Instead, Congress reasonably chose to require the Register either to approve or refuse the application before an infringement suit can be "instituted." 17 U.S.C. 411(a).

By deferring the initiation of suit until the Register has determined whether a work is registrable, the Copyright Act also provides a significant incentive for copyright owners to begin the registration process before the work has been published or promptly after publication, rather than waiting until an infringement dispute arises. See *Golan* v. *Holder*, 565 U.S. 302, 314 n.11 (2012) (observing that Section 411(a) provides "incentives for authors to register their works"); *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154, 158 n.1 (2010) (noting that "registration process" provides "incentives to encourage copyright holders to register their works"). Timely registration of creative works confers significant benefits on the Library of Congress and the public. Registration enables the Copyright Office to compile a public record of copyright claims, and the deposited copies provide definitive evidence of what the work was

at the time of registration. See 17 U.S.C. 705(a) and (b). These records serve as a valuable resource for persons who seek to use copyrighted works lawfully.

Petitioner expresses concern (Br. 37-38, 41) that, if a copyright owner is barred from commencing suit (including a suit for injunctive relief) while its application for registration is pending before the Register, the copyright may "temporarily" be rendered "valueless," and the Act's three-year statute of limitations may elapse before suit can be brought. But these risks strengthen the incentives for copyright owners to seek registration promptly, and they are a far cry from the permanent forfeiture that this Court considered in *Washingtonian Publishing Co.* v. *Pearson*, 306 U.S. 30, 39 (1939). Congress has provided various means of mitigating these risks in circumstances where they are particularly acute. See, *e.g.*, 17 U.S.C. 408(f) and 411(a) (conferring immediate right to sue after preregistration for classes of works with "a history of infringement prior to authorized commercial distribution"); 17 U.S.C. 411(c) (conferring immediate right to sue for infringement of live broadcasts); see also 17 U.S.C. 412 (permitting statutory damages and attorney's fees dating back to the filing of an application for registration). The Copyright Office also has established a mechanism for expedited consideration of applications for registration of all works. See pp. 5-6, *supra*.[6]

---

[6] Petitioner observes (Br. 42) that the $800-per-application fee for expedited consideration could have a significant economic effect on persons who seek to register large collections of works. That fee pales, however, in comparison to the up-to-$30,000-per-work statutory damages that a successful infringement plaintiff may receive.

That Congress did not provide a wider panoply of judicial remedies for all copyright owners is not a reason to depart from the statute. The text of Section 411(a), and of the Copyright Act as a whole, is the best indication of the balance between competing objectives that Congress sought to draw. See *Eldred* v. *Ashcroft*, 537 U.S. 186, 212 (2003) ("[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause's objectives."). Any adjustment of that balance is properly entrusted to Congress rather than to this Court.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

NOEL J. FRANCISCO
Solicitor General
JOSEPH H. HUNT
Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
JONATHAN Y. ELLIS
Assistant to the Solicitor General
MARK R. FREEMAN
DENNIS FAN
Attorneys

REGAN A. SMITH
General Counsel and Associate Register of Copyrights
JASON E. SLOAN
Assistant General Counsel
United States Copyright Office

OCTOBER 2018

---

17 U.S.C. 504(c)(1); see 17 U.S.C. 504(c)(2) (allowing the court to increase an award of statutory damages to up to $150,000 per work in cases of willful infringement).

APPENDIX A

United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington DC 20559-6000 · www.copyright.gov

Apr. 4, 2016

William Brown
922 Honeytree Lane, Apt. A
Wellington, FL 33414

Correspondence ID: 1-1I3Z4PR

RE: Group Registration . . . "Fourth Estate Public Benefit Corporation News Articles" Published January 1, 2016 to February 29, 2016—updated hourly.

Dear Mr. Brown:

We received your application, deposit, and payment to register your copyright claim. We are writing because the check you sent in payment of the filing fee was rejected by your bank as an uncollectible item.

If you wish register this claim, you must provide a new filing **fee.** In **addition,** the Office charges **$30.00** to service an uncollectible check. The full amount due is **$115.00.** You may send a check or money order with the accompanying reply sheet. Alternatively, you may pay the amount by credit card. See instructions on the reply sheet.

It is recommended that you respond as quickly as possible to establish an early effective date of registration. The effective date of registration for claims to copyright is established upon receipt of an application, deposit, **and valid filing fee.**

If we have not received your payment or credit card information within **45 days** of the date of this letter, we will cancel your registration. After that time, in order to register, you will have to file an entirely new claim, consisting of an application, deposit, and valid filing fee. If you have questions, please call 202-707-8443.

Sincerely,

Accounts Section
Receipt Analysis & Control Division
202-707-8443

Enclosure:
Copy of remittance
Reply Sheet
SL-4

APPENDIX B

United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington DC 20559-6000 · www.copyright.gov

Aug. 04, 2017

William Brown
922 Honeytree Lane, Apt A
Wellington, FL 33414

Correspondence ID: 1-2M4Y45H

RE: *Group registration of an automated database entitled "Fourth Estate Public Benefit Corporation News Articles", published January 1, 2016 to February 29, 2016—updated hourly* (1-3223995975)

Dear William Brown:

We are writing to refuse registration for *Group registration of an automated database entitled "Fourth Estate Public Benefit Corporation News Articles", published January 1, 2016 to February 29, 2016—updated hourly* ("the work") because this submission does not meet the legal or formal requirements for registration under the group database option or any other application option currently available.

Procedural History

Fourth Estate Public Benefit Corporation ("Fourth Estate") submitted this application, which was received on or about March 7, 2016. Due to Fourth Estate's

initial submission of an uncollectable check, the $85.00 filing fee was not received until April 11, 2016.

The receipt of a completed application, the appropriate fee, and an acceptable deposit can establish an effective date of registration (EDR) for purposes of title 17, section 410(d). But the establishment of that date is contingent on the issuance of a certificate of registration following the requisite examination for copyrightability and the legal and formal requirements of title 17, section 410(a). If the Office refuses registration, after determining compliance with the requirements of section 410(a), a court of competent jurisdiction may later find the work to be copyrightable and rely on the filing date as the EDR for purposes of title 17, section 412. 17 USC § 410(d).

In this case, not only did the uncollectable check delay the examination of this work and remove the claim from the U.S. Copyright Office's ordinary workflow, it also changed what would have been the effective date of registration, if the claim were ultimately registered, to the date when the proper fee was received by the Office.

Discussion

You have submitted multiple articles for registration with this application. As a general rule, a registration covers an individual work, and an applicant must submit a separate application, filing fee, and deposit copy for each work that is submitted for registration. In some cases, an applicant may register several works together on one application if one of the following limited exceptions applies: registering multiple works as a collective work, as an unpublished collection, as a "unit of

publication," or using one of several group registration options. For an in-depth discussion on the options for registering multiple works, see *Compendium of U.S. Copyright Office Practices*, Third Edition Chapter 1100.

In this case, it appears you have submitted these works for registration under the group database option. For purposes of copyright registration, a database is defined as a compilation of digital information comprised of data, information, abstracts, images, maps, music, sound recordings, video, other digitized material, or references to a particular subject or subjects. In all cases, the content of a database must be arranged in a systematic manner, and it must be accessed solely by means of an integrated information retrieval program or system with the following characteristics:

- A query function must be the sole means of accessing the contents of the database.
- The information retrieval program or system must yield a subset of the content, or it must organize the content based on the parameters specified in each query.

When seeking registration for a database or group registration of periodic revisions to a database, the applicant must deposit identifying portions of the updated content, with 50 representative pages marked to disclose the new material added on one representative publication date, along with a copy of the copyright notice (if any). In addition, an application for a group registration must include a descriptive statement containing specific information identified in the Office's regulations. *See* 37 CFR § 202.20(c)(2)(vii)(D).

For registration purposes, a database must be a copyrightable compilation, which is defined in the statute as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 USC 101 (definition of "compilation"). A database containing component works is considered a collective work, which is defined in the statute as a type of compilation. 17 USC 101 (definition of "collective work"), ("The term compilation includes collective works.") As such, the principal question in an application for registration of a database or group registration of periodic revisions to a database is whether there is sufficient creative selection, coordination, and/or arrangement of the elements to qualify as an original work of authorship. A database containing component works must demonstrate creative selection, coordination, and/or arrangement of the component works to be registrable as a copyrightable database. The copyrightability of component elements contained within a database will not suffice to demonstrate that a database is copyrightable or that multiple elements or works may be registered together in one application. Where sufficient creativity in the selection, coordination, and/or arrangement of elements is not demonstrated in the deposit material, the application for registration must be refused.

In this regard, the group database registration option is different from the Office's other group registration options. When the Office issues a registration for a group of published photographs or contributions to periodicals, the registration covers each individual on a separate basis and the group as a whole is not consid-

ered a compilation, a collective work, or a derivative work. 37 CFR 202.4(m); *Compendium* § 1104.4.

By contrast, the group database option covers new derivative versions of the selection, coordination, or arrangement of elements within the database. In essence, each update with the group is registered as a derivative compilation and/or derivative collective work. *Compendium* § 1104.4.

The critical copyrightable element in a compilation or collective work is not the copyrightability of individual elements, but rather the sufficiency of creative authorship in the selection, coordination, and/or arrangement of elements or works, such that the work as a whole qualifies as an original work of authorship in accordance with the principles of the statute and the decision in *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

The works you seek to register are multiple, separately published textual contributions. Although the application does not provide a year of completion or a date of first publication, the title space states that the contributions were published from January 1, 2015 through February 29, 2016 and that updates occur "hourly." The application describes the nature of authorship as "new matter: new text & revisions" and states that the work was not previously registered. The deposit material consists of separate articles, with publication dates ranging from January 1, 2016 through January 4, 2016.

The individual news articles submitted as the deposit material were submitted separately, and were selected and arranged in a manner that utterly lacks originality: in chronological order. As submitted, these articles

do not reveal any selection, coordination, and/or arrangement to support a claim to copyright in a compilation. Further, the registration materials do not demonstrate that these individual articles are even a part of a database. Instead, the articles appear to be from a news website. The *Compendium of U.S. Copyright Office Practices* clarifies the significant distinction between databases and websites for registration purposes. *Compendium* § 1002.6. Finally, Fourth Estate's application claims only in new text and revisions, and does not include a claim in selection, coordination, and/or arrangement. Therefore, as there is no original selection, coordination, and/or arrangement authorship evident in the registration materials, this submission is not eligible for registration under the group database and registration, as a compilation generally, or as a collective work. As a result, this claim must be refused.

In addition to the reasons discussed above, it is important to note that this application is deficient in meeting the formal requirements of the group database option in a number of other ways. Namely, Fourth Estate has not submitted the required Descriptive Statement; the application does not provide a representative publication date; and it lacks a limitation of the claim statement that would be necessary in relation to the application's references to "new matter" and "revised text" in the authorship statement. Were these the only defects in the application for registration, the application could be cured through correspondence and a submission of the omitted required information. However, in light of the inability for the work to qualify under the group database option, and the fact that the work does not qualify as a compilation or collective work, an at-

tempt to cure the application as submitted would be futile.

In order to register the articles contained within this claim, separate applications for each article must be submitted to the Copyright Office together with the proper application and proper fee. If the Office receives all of the required elements in proper form, it will examine the applications and the deposits to determine whether the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of title 17 have been met. If there is a need for expedited examination of such new applications, you may request special handling during the electronic application process or in writing with a paper application, explaining the basis for your need for expedited examination, together with payment of the required fee for this service.

This letter is for your information only. No reply is required. Should you choose to request administrative reconsideration of this decision, please follow the instructions on the enclosed reply sheet.

Sincerely,

Elizabeth Stringer
Supervisor
Literary Division
U.S. Copyright Office

Enclosures:
Reply Sheet

No. 17-571

IN THE

Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,

Petitioners,

—v.—

WALL-STREET.COM, LLC, *et al.*,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF OF THE AMERICAN BAR ASSOCIATION AS *AMICUS CURIAE* SUPPORTING PETITIONER

Of Counsel:
DALE M. CENDALI
JOSHUA L. SIMMONS
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, New York 10019
(212) 446-4800

ROBERT M. CARLSON
Counsel of Record
AMERICAN BAR ASSOCIATION
321 North Clark Street
Chicago, Illinois 60654
(312) 988-5000
abapresident@americanbar.org

Attorneys for Amicus Curiae
American Bar Association

September 4, 2018

QUESTION PRESENTED

Whether "registration of [a] copyright claim has been made" within the meaning of § 411(a) when the copyright holder delivers the required application, deposit, and fee to the Copyright Office, as the Fifth and Ninth Circuits have held, or only once the Copyright Office acts on that application, as the Tenth and, in the decision below, the Eleventh Circuit have held.

TABLE OF CONTENTS

PAGE

QUESTION PRESENTED i

INTEREST OF AMICUS CURIAE 1

SUMMARY OF ARGUMENT 3

ARGUMENT 7

I. THE APPLICATION APPROACH IS CONSISTENT WITH THE TEXT OF THE COPYRIGHT ACT 7

II. THE APPLICATION APPROACH BETTER REFLECTS THE UNIQUE NATURE AND PURPOSE OF COPYRIGHT LAW AS OPPOSED TO PATENT LAW 12

A. Copyright is Created through Fixation in a Tangible Medium, Not Copyright Office Grant 13

B. The Procedural Barriers to Patent Protection are Higher than Copyright 16

C. The Copyright Office's Opinion on Registrability is Not Binding on Courts 21

III. THE APPLICATION APPROACH SAFEGUARDS AUTHORS' ABILITIES TO EFFECTIVELY RESOLVE INFRINGEMENT CLAIMS 23

A. The Application Approach Ensures that Authors May Seek the Injunctive Relief that is Critical to Copyright Litigation 23

B. The Application Approach Better Accounts for Copyright Infringement's Short Statute of Limitations..... 29

C. The Application Approach Eliminates the Wasteful Re-Filing of Infringement Claims that Occurs Under the Certificate Approach 31

IV. THE APPLICATION APPROACH MINIMIZES PREJUDICE TO AUTHORS OF UNITED STATES WORKS 33

CONCLUSION 35

TABLE OF AUTHORITIES

PAGE(S)

Cases

A&M Records, Inc. v. Napster, Inc.,
239 F.3d 1004 (9th Cir. 2001) 27

Abramski v. United States,
134 S. Ct. 2259 (2014) 13

Apple Comput., Inc. v. Franklin Comput. Corp.,
714 F.2d 1240 (3d Cir. 1983) 24

Aqua Creations USA Inc. v. Hilton Hotels Corp.,No. 10 Civ. 246, 2011 WL 1239793 (S.D.N.Y. Mar. 28, 2011), *aff'd sub nom. Aqua Creations USA Inc. v. Hilton Worldwide, Inc.*, 487 Fed. App'x 627 (2d Cir. 2012)..... 22

Asche & Spencer Music, Inc. v. Principato-Young Entm't, Inc.,
147 F. Supp. 3d 833 (D. Minn. 2015)..... 31

Asche & Spencer Music, Inc. v. Principato-Young Entm't, Inc.,
No. 17 Civ. 150 (D. Minn. filed Jan. 18, 2017) 31

ATCS Int'l LLC v. Jefferson Contr. Corp.,
807 F. Supp. 2d 516 (E.D. Va. 2011)..... 22

Bartok v. Boosey & Hawkes, Inc.,
523 F.2d 941 (2d Cir. 1975)..... 21

In re Brandt,
886 F.3d 1171 (Fed. Cir. 2018) 17

Carol Barnhart Inc. v. Economy Cover Corp.,
773 F.2d 411 (2d Cir. 1985) 22

Carter v. United States,
530 U.S. 255 (2000) 7

Chere Amie, Inc. v. Windstar Apparel, Corp.,
191 F. Supp. 2d 343 (S.D.N.Y. 2011) 14

Cosmetic Ideas, Inc. v. IAC/Interactivecorp,
606 F.3d 612 (9th Cir. 2010) 9, 27, 31

Dable Grain-Shovel Co. v. Flint,
137 U.S. 41 (1890) 14

Darden v. Peters,
402 F. Supp. 2d 638 (E.D.N.C. 2005),
aff'd, 488 F.3d 277 (4th Cir. 2007) 21

EMI Christian Music Grp., Inc. v. MP3tunes, LLC,
844 F.3d 79 (2d Cir. 2016) 21

Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.,
499 U.S. 340 (1991) 18

Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC,
856 F.3d 1338 (11th Cir. 2017) 3, 11

Fox Television Stations, Inc. v. Aereokiller, LLC,
851 F.3d 1002 (9th Cir. 2017) 22

Greene v. Columbia Records/ Sony Music Entm't,
No. 3 Civ. 4333, 2004 WL 3211771
(S.D.N.Y. Mar. 1, 2004)..... 32

Greene v. Columbia Records, Inc.,
No. 1:13 Civ. 6965 (S.D.N.Y. filed
Sept. 30, 2013) 32

Int'l Kitchen Exhaust Cleaning Ass'n v. Power Washers of N. Am.,
81 F. Supp. 2d 70 (D.D.C. 2000) 15

Jama v. Immigration & Customs Enforcement,
543 U.S. 335 (2005)..... 12

K Mart Corp. v. Cartier, Inc.,
486 U.S. 281 (1988)..... 7

Kregos v. Associated Press
795 F. Supp. 1325 (S.D.N.Y. 1992)..... 30

La Resolana Architects, PA v. Clay Realtors Angel Fire,
416 F.3d 1195 (10th Cir. 2005) 11

Lakedreams v. Taylor,
932 F.2d 1103 (5th Cir. 2011) 24

Lumetrics, Inc. v. Blalock,
23 F. Supp. 3d 138 (W.D.N.Y. 2014) 32

Lumetrics, Inc. v. Blalock,
No. 6:14 Civ. 6322 (W.D.N.Y. filed
June 11, 2014)..... 32

Morrow v. Microsoft Corp.,
499 F.3d 1332 (Fed. Cir. 2007) 14

New Line Cinema Corp. v. Bertlesman Music Grp., Inc.,
693 F. Supp. 1517 (S.D.N.Y. 1988)..... 24

Omega Imp. Corp. v. Petri-Kine Camera Co.,
451 F.2d 1190 (2d Cir. 1971) 24

Original Appalachian Artworks, Inc. v. Toy Loft, Inc.,
684 F.2d 821 (11th Cir. 1982) 16

Past Pluto Prods. Corp. v. Dana,
627 F. Supp. 1435 (S.D.N.Y. 1986)..... 23

Petrella v. Metro-Goldwyn-Mayer, Inc.,
134 S. Ct. 1962 (2014) 30

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) (en banc) .. 17

Prima Tek II, L.L.C. v. Polypap, S.A.R.L.,
412 F.3d 1284 (Fed. Cir. 2005) 17

Reed Elsevier v. Muchnick,
559 U.S. 154 (2010)..... 4, 8, 20

Robinson v. Shell Oil Co.,
519 U.S. 337 (1997).....8

Salinger v. Colting,
607 F.3d 68 (2d Cir. 2010)..... 24

Sapon v. D.C. Comics,
No. 00 Civ. 8992, 2002 WL 485730
(S.D.N.Y. Mar. 29, 2002) 23

Sari v. America's Home Place, Inc.,
129 F. Supp. 3d 317 (E.D. Va. 2015)..... 22

Skidmore v. Swift & Co.,
323 U.S. 134 (1994) 21

I.C. ex rel. Solovsky v. Delta Galil USA,
135 F. Supp. 3d 196 (S.D.N.Y. 2015) 22

Sony Corp. of Am. v. Universal City Studios, Inc.,
464 U.S. 417 (1984) 13

United Sav. Ass'n of Tex. v. Timbers of Inwood Forest Assocs., Ltd.,
484 U.S. 365 (1988) 12

Varsity Brands, Inc. v. Star Athletica, LLC,
799 F.3d 468 (6th Cir. 2015), *aff'd sub nom. Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) 21

Statutes

17 U.S.C. (the Copyright Act) ..... *passim*

17 U.S.C. § 101 ..... 7, 8, 17, 33

17 U.S.C. § 102(a) 8, 14

17 U.S.C. § 401 18

17 U.S.C. § 408 ..... 9, 10

17 U.S.C. § 408(a) 9, 11, 18

17 U.S.C. § 408(c) 19

17 U.S.C. § 408(f) 10

17 U.S.C. § 408(f)(3) 10

17 U.S.C. § 408(f)(3)(A) 10

17 U.S.C. § 409 10
17 U.S.C. § 410 19
17 U.S.C. § 410(a) 11, 20
17 U.S.C. § 410(b) 20
17 U.S.C. § 410(c) 15
17 U.S.C. § 410(d) 9, 20
17 U.S.C. § 411(a) ..... *passim*
17 U.S.C. § 412 ..... 15, 28
17 U.S.C. § 501 15
17 U.S.C. § 502 ..... 15, 23
17 U.S.C. § 503 15
17 U.S.C. § 504 ..... 15, 28
17 U.S.C. § 505 15
17 U.S.C. § 507(b) 29
35 U.S.C. § 101 17
35 U.S.C. § 102 17
35 U.S.C. § 103 17
35 U.S.C. § 111 17
35 U.S.C. § 112(a) 18
35 U.S.C. § 112(b) 18
Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 18

Regulations

37 C.F.R. § 1.104(a) 17

Other Authorities

ABA, Amicus Curiae Briefs, http://www.americanbar.org/amicus/1998-present.html 2

Ben Depoorter & Robert Kirk Walker, *Copyright False Positives*, 89 NOTRE DAME L. REV. 319 (2013) 19

Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886 (Paris Text 1971), S. Treaty Doc. No. 99–27 ..... 33, 34

H.R. REP. NO. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659..... 14, 15, 19

Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ART 311 (2010) 15, 19

Arthur J. Levine & Jeffrey L. Squires, *Notice, Deposit and Registration: The Importance of Being Formal*, 24 UCLA L. REV. 1232 (1977) 20

2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (2013) .. 12, 22, 31, 32

Shira Perlmutter, *Freeing Copyright from Formalities*, 13 CARDOZO ARTS & ENT. L.J. 565 (1995) 27

Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439 (2009) 28

U.S. COPYRIGHT OFFICE, COMPENDIUM (2017) 19, 26, 27

U.S. Copyright Office, Fees, https://copyright.gov/about/ fees.html 28

U.S. Copyright Office, Registration Processing Times, https://copyright.gov/registration/docs/processing-times-faqs.pdf 25, 26

INTEREST OF AMICUS CURIAE[1]

The American Bar Association ("ABA") respectfully submits this brief as amicus curiae in support of Petitioner Fourth Estate Public Benefit Corporation ("Fourth Estate").

The ABA is the leading national organization of the legal profession, with more than 400,000 members from all 50 states, the District of Columbia, and the U.S. territories. Membership is voluntary and includes attorneys in private practice, government service, corporate law departments, and public interest organizations. ABA members include judges, legislators, law professors, law students, and non-lawyer "associates" in related fields, and represent the full spectrum of public and private litigants.[2]

---

[1] Pursuant to Supreme Court Rule 37.6, *amicus curiae* certifies that no counsel for a party authored this brief in whole or in part and that no person or entity, other than *amicus curiae* or its counsel, has made a monetary contribution to its preparation or submission. The parties have granted blanket consent for the filing of *amicus curiae* briefs.

[2] Neither this brief nor the decision to file it should be interpreted to reflect the views of any judicial member of the American Bar Association. No inference should be drawn that any member of the Judicial Division Council has participated in the adoption or endorsement of the positions in this brief. This brief was not circulated to any member of the Judicial Division Council prior to filing.

The ABA Section of Intellectual Property Law ("IPL Section"), which was established in 1894 (three years before the Copyright Office was created), is the world's oldest and largest organization of intellectual property professionals. The IPL Section has approximately 20,000 members, including attorneys who represent authors, copyright owners, accused infringers, a wide range of companies across the entertainment and technology industries, and public interest organizations and institutions such as libraries, archives, and museums.

The IPL Section promotes the development and improvement of intellectual property law and takes an active role in addressing proposed legislation, administrative rule changes, and international initiatives regarding intellectual property. It also develops and presents resolutions to the ABA House of Delegates for adoption as ABA policy to foster necessary changes to the law. These policies provide a basis for the preparation of ABA amicus curiae briefs, which are filed primarily in this Court and the United States Court of Appeals for the Federal Circuit.[3] The IPL Section includes and represents attorneys on all sides of issues of intellectual property law, and its reliance on the expertise of its members to develop consensus positions within the ABA

---

[3] *See* ABA, Amicus Curiae Briefs, http://www.americanbar.org/amicus/1998-present.html (last visited August 29, 2018).

ensures its positions reflect those of the broader intellectual property community.

SUMMARY OF ARGUMENT

The ABA is concerned about the adverse impact on attorneys, their clients, and the judicial system of requiring copyright holders to wait to seek relief for copyright infringement until a certificate of registration is issued by the Copyright Office or the Copyright Office refuses to issue one. This "**certificate approach**" to the term "registration" in the Registration and Civil Infringement Actions provision of the Copyright Act, 17 U.S.C. § 411(a) denies access to the courts in a manner inconsistent with the overall structure and nature of the Copyright Act.[4] By contrast, the "**application approach**"—which merely requires a copyright holder to submit a complete set of registration materials (*i.e.*, an application, deposit copy, and registration fee) to the Copyright Office—is more consistent with the text of Subsection 411(a), the text of neighboring Copyright Act provisions, the purposes of the Copyright Act, and the overall copyright system.

The ABA closely has monitored—long before the *Fourth Estate* case itself—the circuit split between the

---

[4] While Respondents and certain lower court opinions refer to this as the "registration" approach, that name is misleading because, as discussed below, the term "registration" in the Copyright Act properly means the act of delivering a copyright application, deposit copy, and fee to the Copyright Office.

"certificate approach" and the "application approach." After careful analysis and input from its members, many of whom are expert intellectual property practitioners, the ABA IPL Section adopted a resolution favoring the application approach in October 2017. The ABA House of Delegates adopted a similar resolution on behalf of the ABA as a whole in February 2018. The ABA favors the application approach interpretation of Subsection 411(a) for several reasons.

First, the application approach better reflects the text of the Copyright Act. As an initial matter, this Court already has considered the text of Subsection 411(a) in *Reed Elsevier, Inc. v. Muchnick* and tacitly recognized that the term "registration" in that Subsection refers to an act performed by copyright holders (when they submit their applications, deposits, and fees to the Copyright Office) not the Copyright Office (when it issues or refuses to issue a certificate of registration). *See* 559 U.S. 154, 158 n.1 (2010) (considering "the registration process" and the "incentives to encourage *copyright holders* to register their works" (emphasis added)). Similarly, other provisions of the Copyright Act describe "registration" as something that the copyright holder "may obtain" when she delivers the registration materials to the Copyright Office without reference to the Office's issuance or refusal of a certificate memorializing that registration. *See infra* 9. Moreover, the "effective date of registration" is the date on which the copyright holder delivers her registration materials to the

Copyright Office, *not* when the Copyright Office issues its decision. *See infra* 9.

Second, the application approach is particularly important to copyright practitioners who submit copyright registrations and counsel clients on the meaning of the Copyright Office's review. In sharp contrast to patent law—where no rights exist until and unless a patent is formally issued—under copyright law, a copyright exists at the moment an original work is "fixed" in a "tangible medium of expression," regardless of any action by the Copyright Office. *See infra* 13. In addition, unlike in patent law, the Copyright Office's refusal to issue a certificate of registration for a work has no preclusive effect on the district court, which reviews copyrightability *de novo*.[5] *See infra* 21. As copyrights exist regardless of whether works are registered, and the Copyright Office's position on copyrightability is not binding on the courts, it does not make sense and would be an abrupt departure for copyright practitioners from the normal operation of copyright law to interpret Subsection 411(a) as requiring receipt of a final

---

[5] To be clear, the ABA has great respect for the Copyright Office and the role that it plays in the copyright system. But the submission of registration materials to the Copyright Office should suffice for a copyright holder to gain access to the courts. Under this approach, a court still benefits from the Copyright Office's views at some point early in the case, and the benefits of collecting deposit copies and filing fee revenues are still realized, but in a manner that better enables litigants to obtain adequate redress.

decision from the Copyright Office before a lawsuit can be commenced.

Third, the application approach avoids the draconian impact that the certificate approach has on litigants as it permits the prompt filing of lawsuits to obtain urgent injunctive relief, while still ensuring that copyright holders register their works with the Copyright Office. *See infra* 23. It also eliminates the adverse consequences for meeting the Copyright Act's short three-year statute of limitations that can flow from the certificate approach's preclusion of suit until the Copyright Office decides whether to issue a certificate of registration. *See infra* 29.

Finally, the application approach reduces the inequity authors of United States works face as Subsection 411(a)'s prerequisite applies only to them, not authors of foreign works, who are entirely exempt from Subsection 411(a)'s registration requirement to gain access to United States courts. By permitting copyright holders to bring suit as soon as their registration materials are filed, rather than when the Copyright Office eventually decides whether to issue a certificate of registration, the application approach minimizes the additional burden on authors of United States works in gaining access to the court system. *See infra* 33.

For these reasons, and as further detailed below, the application approach to Subsection 411(a) better comports with the Copyright Act as a whole, and

better serves authors of United States works, their lawyers, and the judicial system at large.

ARGUMENT

I. THE APPLICATION APPROACH IS CONSISTENT WITH THE TEXT OF THE COPYRIGHT ACT

Subsection 411(a) of the United States Copyright Act states that, subject to certain exceptions, "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). The issue before this Court is the meaning of the term "registration" in this Subsection.

When confronted with a question of statutory interpretation such as this, this Court "begin[s] by examining the text," *Carter v. United States*, 530 U.S. 255, 271 (2000), including both "the particular statutory language at issue, as well as the language and design of the statute as a whole," *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281, 291 (1988). The Copyright Act defines the term "registration" to mean "a registration of a claim in the original or the renewed and extended term of copyright." 17 U.S.C. § 101. This self-referential definition sheds little light on the meaning of Subsection 411(a) because it does not indicate what steps must be taken, and by whom, for registration to occur.

In contrast to its unhelpful definition of the term "registration," the Copyright Act makes clear through other provisions that submitting a copyright application, deposit copy, and fee is sufficient to satisfy the requirements of Subsection 411(a). This Court already implicitly has read the text of Subsection 411(a) as providing that registration occurs when the copyright holder acts by delivering her application, deposit copy, and fee to the Copyright Office. In *Reed Elsevier, Inc. v. Muchnick*, this Court found that Subsection 411(a)'s registration requirement was a precondition to filing rather than a limitation on a court's subject-matter jurisdictional prerequisite. 559 U.S. 154. In so holding, this Court highlighted the "incentives to encourage *copyright holders* to register their works." *Id.* at 158 n.1 (emphasis added). [6]

Neighboring provisions to Subsection 411(a) also confirm that registration is dependent upon the

---

[6] Relatedly, reading Subsection 411(a) to give the Copyright Office control over which authors can enforce their copyrights and when is inconsistent with the fundamental rule expressed in the Copyright Act that copyright "subsists . . . in original works of authorship fixed in a tangible medium of expression," 17 U.S.C. § 102(a), and that fixation occurs when the work is made sufficiently permanent "by or under the authority of the author," *id.* § 101. This language makes clear that copyright protection is contingent upon the author's acts, not Copyright Office action. Reading Subsection 411(a) to increase arbitrarily the burden on authors to enforce their copyrights is inconsistent with this "broader context of the [Copyright Act] as a whole." *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997).

copyright holder's conduct, not that of the Copyright Office. Possibly most critically, Subsection 410(d) expressly states that the effective date of a registration is the "day on which an application, deposit, and fee" are submitted to the Copyright Office. *Id.* § 410(d); *see also Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 617 (9th Cir. 2010). Thus, registration is deemed to have occurred when the copyright holder submitted the registration materials, *not* when the Copyright Office issued a certificate memorializing that registration. It would be inconsistent with the statute's text to interpret Subsection 411(a) as saying that registration does not occur until the Copyright Office acts, because that would suggest that the date of the Copyright Office's action is the date of registration, which the plain language of Subsection 410(d) refutes. The application approach accords with this language by focusing on the timing of the submission of registration materials.

In addition, Subsection 408(a) expressly states that "[t]he owner of copyright or of any exclusive right in the work *may obtain registration . . . by delivering* to the Copyright Office the deposit specified by this section, together with the application and fee specified." 17 U.S.C. § 408 (emphasis added). This confirms that the copyright holder alone effectuates registration by "delivering" registration materials. The certificate approach would have the Court read into the statute the additional words "and receiving a certificate of registration or refusal from the

Copyright Office," but that is not what the plain text says.[7]

Similarly, the latter part of Subsection 411(a) shows that registration does not require Copyright

---

[7] Respondents argue that Section 408's preregistration provision supports the certificate approach, *see* Respondents' Brief in Opposition to Petitioner's Petition for Certiorari ("Resp. Cert. Br.") 15, but Section 408 is a red herring. As an initial matter, preregistration is a completely distinct process from the registration process that is at issue in this appeal, applying in a unique set of circumstances involving delineated types of works. Moreover, the text of Section 408 does not support Respondents' assertion that submitting an application, deposit copy, and fee under Subsection 408(f)(3) constitutes an "application for registration," rather than a registration. The statute makes clear that the phrase "application for registration" refers to solely the application *form*, not the combined registration materials. *See* 17 U.S.C. § 408(f)(3)(A) ("application for registration" is one out of three materials that must be submitted); *id.* § 409 (describing an "application for copyright registration" without mention of deposit copies or fees). Respondents also argue that Subsection 408(f) states that a preregistrant "must 'appl[y] for registration of the work'" by submitting an application, deposit copy, and fee. Resp. Cert. Br. 15 (quoting 17 U.S.C. § 408(f)(3)). The text, however, does not provide that submitting these materials constitutes "application." Instead, it merely says that one must "submit to the Copyright Office" the enumerated materials. 17 U.S.C. § 408(f)(3). Lastly, the Government's argument that the application approach would render the preregistration scheme unnecessary, *see* U.S. Amicus Br. 16–17, does not stand as, under either approach, an author wanting to sue for infringement of an unfinished, unpublished work would be unable to do so without the benefit of preregistration.

Office action. That provision permits the copyright holder to file suit even "where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and *registration has been refused*." 17 U.S.C. § 411(a) (emphasis added). The language here is telling because saying "registration has been refused" in the past tense contemplates a registration upon filing, which only later was refused. Indeed, this phrasing suggests that the act of registration is something *distinct* from the act of refusal. If these acts were one and the same, this provision would not make sense, as the Copyright Office cannot refuse to accept a registration that does not yet exist.[8]

Finally, while advocates of the certificate approach argue that the Copyright Office must act for registration to occur, the provisions on which they rely actually support the application approach because each of those provisions focuses on issuance of the "certificate of registration." *Id.* §§ 408(a), 410(a). This

---

[8] In interpreting this portion of Subsection 411(a), some certificate-approach courts have found that because the provision contemplates that one may submit the "deposit, application, and fee required for registration" yet registration may still be refused, the submission of registration materials cannot constitute registration, *see La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1200–01 (10th Cir. 2005); *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, 856 F.3d 1338, 1341 (11th Cir. 2017). But again, the plain text undermines this argument, as it construes registration and acceptance or refusal of the registration as different things.

makes sense under the application approach as the act of registration (filing the application, deposit copy, and fee with the Copyright Office) is different from the issuance of a certificate of registration. By contrast, the certificate approach would require treating two different terms used by Congress—"registration" and "certificate of registration"—as defining the same conduct. This is contrary to the standard rules of statutory interpretation. *See Jama v. Immigration & Customs Enforcement*, 543 U.S. 335, 358 (2005) (explaining that a statute should be interpreted so that "distinct words have distinct meanings").[9]

As a result, "only one of the permissible meanings produces a substantive effect that is compatible with the rest of the law." *United Sav. Ass'n of Tex. v. Timbers of Inwood Forest Assocs., Ltd.*, 484 U.S. 365, 371 (1988). Submitting an application, deposit copy, and fee to the Copyright Office constitutes "registration" under Subsection 411(a).

II. THE APPLICATION APPROACH BETTER REFLECTS THE UNIQUE NATURE AND PURPOSE OF COPYRIGHT LAW AS OPPOSED TO PATENT LAW

As discussed above, the application approach is the better reading of the Copyright Act. At best, those supporting the certificate approach have raised arguments suggesting that the term "registration" is

---

[9] *See also* 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][3][a][i] (2013) (hereinafter NIMMER).

ambiguous. When this Court is confronted with an ambiguous statute, it looks to the "statutory context, 'structure, history, and purpose.'" *Abramski v. United States*, 134 S. Ct. 2259, 2267 (2014) (quoting *Maracich v. Spears*, 570 U.S. 48, 76 (2013)).

There can be no debate that the application approach is more consistent with the purpose of the statute and the unique role of the Copyright Office. As discussed below, adopting this approach is critical to the ABA as copyright practitioners prosecute copyright registrations and advise their clients on copyright law issues every day. The certificate approach diverges from ordinary copyright principles in an unhelpful and inconsistent manner.

A. Copyright is Created through Fixation in a Tangible Medium, Not Copyright Office Grant

While this Court sometimes has analyzed copyright and patent as analogous regimes due to their "historic kinship," *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439 (1984), there are fundamental differences in the way individuals and their lawyers secure rights under these regimes that have critical bearing on the question presented.

Under patent law, no patent rights exist until the Patent and Trademark Office ("PTO") undertakes an extensive analysis of factors including novelty, obviousness, and subject matter, and formally issues

a patent. In other words, one can acquire patent rights through *only* an express grant from the PTO after the intense application process detailed below; "the patentee has no exclusive right of property in his invention, except under and by virtue of the statutes securing it to him, and according to the regulations and restrictions of those statutes." *Dable Grain-Shovel Co. v. Flint*, 137 U.S. 41, 43 (1890); *see also Morrow v. Microsoft Corp.*, 499 F.3d 1332, 1336–37 (Fed. Cir. 2007).

By contrast, Congress designed the Copyright Act to allow copyright to "subsist" from the time that an author fixes a work in a "tangible medium of expression," with no Copyright Office input required. 17 U.S.C. § 102(a). The Copyright Office is not positioned as a gatekeeper for deciding who receives copyrights and when those rights arise. Thus, unlike the PTO, "[t]he Copyright Office does not grant copyrights." *Chere Amie, Inc. v. Windstar Apparel, Corp.*, 191 F. Supp. 2d 343, 350 (S.D.N.Y. 2011).

This is not to say that registration with the Copyright Office is not, or should not be, encouraged.[10] ABA practitioners regularly counsel their clients to register their copyrighted works, as it confers many practical benefits. For example, a certificate of registration can constitute *prima facie* evidence of a

---

[10] *See* H.R. REP. NO. 94-1476, at 158 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5774 (stating that a robust register of copyrighted works "is useful and important to users and the public at large").

copyright's validity, *see* 17 U.S.C. § 410(c), and timely obtaining a certificate may enable the copyright holder to seek statutory damages and attorney's fees for infringement, *see id.* §§ 411, 412, 501–505. But while a certificate of registration might afford the copyright holder litigation benefits, it does *not* determine whether, and when, copyright exists.

Critically, the certificate approach does not incentivize registration of copyrighted works any more than the application approach. Under *either* approach, copyright holders must register their copyrights to enforce them against infringers.[11] Congress's express aim in the Copyright Act was to induce copyright registration "in some *practical* way."[12] ABA practitioners have found that the application approach—which furthers the goals of the registration system to the same extent as the certificate approach—achieves this in the manner that "best effectuate[s] the interests of justice and promote[s] judicial economy." *Int'l Kitchen Exhaust Cleaning Ass'n v. Power Washers of N. Am.*, 81 F. Supp. 2d 70, 72 (D.D.C. 2000).

---

[11] *See* Jane C. Ginsburg, *The U.S. Experience with Mandatory Copyright Formalities: A Love/Hate Relationship*, 33 COLUM. J.L. & ARTS 311, 340–41 (2010) ("Where the author has in fact sought to make the requisite public record of her claim, it is unclear what public policy such a wooden approach . . . to registration advances.").

[12] H.R. REP. NO. 94-1476, at 158 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5774 (emphasis added).

Thus, the application approach better accords with the structure of the Copyright Act.

B. The Procedural Barriers to Patent Protection are Higher than Copyright

The application approach also better accords the Copyright Office's review procedure, which in turn reflects the basic tenet of copyright that legal rights arise upon the author's fixation in a tangible medium, which typically occurs before the Copyright Office is called upon for review. In contrast to the patent regime, Congress did not position the Copyright Office as a gate-keeper to copyright protection so much as a steward looking after authors and their works. The application approach better reflects the important practical distinctions between these systems.

Specifically, patent practitioners regularly find that patent law imposes demanding subject-matter, novelty, and non-obviousness requirements on inventors seeking patent protection. *See Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 824 (11th Cir. 1982) (noting that "courts generally agree that 'originality' for copyright purposes is something less than the novelty or uniqueness necessary for patent protection"). Consistent with the fact that the PTO's decision on patentability determines whether an inventor receives patent rights, the review required prior to

issuance of a patent is extremely demanding.[13] *See, e.g.*, *Prima Tek II, L.L.C. v. Polypap, S.A.R.L.* 412 F.3d 1284, 1287 (Fed. Cir. 2005) (noting that the patent application process is so demanding because the "patent system depends primarily on the Patent and Trademark Office's . . . care in screening out invalid patents during prosecution"). In addition to the statutory requirements for patentability, the patent itself must satisfy an additional set of requirements. In particular, it must (1) provide a written description showing actual possession of the invention; and (2) enable a person of ordinary skill in

---

[13] To obtain a utility patent, an applicant must prove to the PTO that a claimed invention is a "new and useful process, machine, manufacture, or composition of matter," 35 U.S.C. § 101, that is novel and nonobvious, *id.* §§ 102, 103. The inventor must prove this in a written application consisting of a specification, drawing, and oath or declaration. *See id.* § 111. Once submitted, the application is assigned to a patent examiner who begins a rigorous process of review. This involves a "thorough study" of prior art (*i.e.*, things that have already been invented) to test for novelty and nonobviousness. 37 C.F.R. § 1.104(a). The examiner looks "both to compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form." *Id.* The patent examination process is an "ongoing negotiation," *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc), that usually involves initial rejection, narrowing or clarification efforts from the applicant, reconsideration by the examiner, evidentiary submissions, amendments, and other steps depending upon the claims at issue, *see, e.g.*, *In re Brandt*, 886 F.3d 1171, 1175–76 (Fed. Cir. 2018).

that art or field to make and use the invention without undue experimentation. 35 U.S.C. § 112(a)–(b). Although litigants often challenge the patentability of the subject invention in patent litigation, it is also common to challenge these elements of the patent itself.

Unlike the rigorous, highly formal requirements of obtaining patent rights, this Court has made clear that copyright has a low threshold that permits any work that has been "independently created by the author" and that possesses "at least some minimal degree of creativity" to qualify for protection. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). Thus, while the Copyright Office reviews an application to make sure that it comports with the overall requirements of copyrightability, it is not the same type of analysis typically conducted by the PTO. The application approach better accords with this reality.

In fact, the United States systematically has sought to *remove* administrative barriers to copyright protection (known as formalities). *See, e.g.*, Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853. As a result, submitting works to the Copyright Office "is not a condition of copyright protection." 17 U.S.C. § 408(a). Nor is compliance with other formalities—such as affixing copyright notices to the work—required. *See id.* § 401 (stating that a notice of copyright "*may* be placed" on copies of the work (emphasis added)); *id.* § 407(a) ("Neither the deposit requirements of this subsection

nor the acquisition provisions of subsection (e) are conditions of copyright protection."). The net-effect of these critical legislative decisions is that a work is protected by copyright law as soon as the author creates it in tangible form, regardless of the Copyright Office's subsequent opinion on whether the work deserves a certificate of registration.

Consistent with the foregoing, the Copyright Office's policy is to conduct only a high-level review of submitted registration materials,[14] focusing on whether "the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of [the Copyright Act] have been met." *Id.* § 410. Although the Copyright Office reviews some substantive qualities of the work, a certificate of registration "is usually granted as a matter of course, so long as the applicant correctly files their application and the deposited subject matter is within the scope of copyright protection."[15]

---

[14] Indeed, Congress understood that, "unlike a patent claim, a claim to copyright is not examined for basic validity before a certificate is issued." H.R. Rep. 94-1476, at 5773.

[15] Ben Depoorter & Robert Kirk Walker, *Copyright False Positives*, 89 NOTRE DAME L. REV. 319, 348–49 (2013). The Copyright Office admits that in its review, it "generally does not compare deposit copies to determine whether the work for which registration is sought is substantially similar to another work." *See, e.g.*, U.S. COPYRIGHT OFFICE, COMPENDIUM 602.4(C). Nor does it undertake a substantive review of prior registrations to ascertain what, if any, expression in the application is protected. *See, e.g.*, Ginsburg, *supra* note 11, at 347 (noting that the "bulk" of

If the Copyright Office has questions about matters in an application, it will informally correspond with the copyright holder, often seeking additional materials or written answers to clarify and remedy any perceived issues. Once its examination is complete, the Copyright Office either will issue a certificate of registration, effective as of the date it received the registration materials, *see id.* § 410(d), or will refuse to issue a certificate, notifying the copyright holder in writing of the reasons for refusal, *see id.* § 410(a)–(b).

Finally, it should not go unnoticed that while patent litigants routinely challenge both the validity of the patented invention and the sufficiency of the patent specification itself, in copyright cases, the words of the certificate are almost never relevant and even copyrightability is rarely challenged due to the low standard described above. This further supports why the certificate approach is ill-suited to the needs of litigation: it places weight on Copyright Office formalities that are generally irrelevant to the

---

examination time is spent reviewing information in the application form, not "ascertaining originality"). Indeed, "[t]he enforcement of the substantive provisions of Copyright law by the Copyright Office is . . . limited." Arthur J. Levine & Jeffrey L. Squires, *Notice, Deposit and Registration: The Importance of Being Formal*, 24 UCLA L. REV. 1232, 1262 (1977). As a result, and as the United States government has admitted, the Copyright Office accepts approximately *ninety-nine* percent of the applications it receives. *See* U.S. Br. at 4 n.2, *Reed Elsevier v. Muchnick*, 559 U.S. 154 (2010).

protectability of a work or the merits of copyright infringement suits.

C. The Copyright Office's Opinion on Registrability is Not Binding on Courts

In addition to the certificate of registration being an infrequent focus of copyright litigation, even where the Copyright Office refuses to issue such a certificate, copyright litigation still may commence. *See* 17 U.S.C. § 411(a). This makes sense given that the Copyright Office's views with respect to copyrightability do not dictate the existence, scope, or validity of copyrights.

In fact, even when courts have access to the Copyright Office's decision in a copyright infringement litigation, "copyrightability is a question of law reserved to the judge and subject to *de novo* review by appellate courts." *Darden v. Peters*, 402 F. Supp. 2d 638, 641 (E.D.N.C. 2005), *aff'd*, 488 F.3d 277 (4th Cir. 2007); *see also Bartok v. Boosey & Hawkes, Inc.*, 523 F.2d 941, 946 (2d Cir. 1975) (noting that the "Copyright Office has no authority to give opinions or define legal terms"). Indeed, it is well-settled that Copyright Office decisions on copyrightability are entitled to the lower level of deference afforded under *Skidmore v. Swift & Co.*, 323 U.S. 134 (1994). *See, e.g., EMI Christian Music Grp., Inc. v. MP3tunes, LLC*, 844 F.3d 79, 97 (2d Cir. 2016); *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 479 (6th Cir. 2015), *aff'd sub nom. Star Athletica, L.L.C. v. Varsity*

Brands, Inc., 137 S. Ct. 1002 (2017). Accordingly, a federal court may elect to follow Copyright Office opinions where it finds them "persuasive and reasonable," *Fox Television Stations, Inc. v. Aereokiller, LLC*, 851 F.3d 1002, 1013 (9th Cir. 2017), but ultimately, where a copyright owner is denied certificate of registration prior to bringing an infringement action, courts "make an independent determination as to copyrightability," *Aqua Creations USA Inc. v. Hilton Hotels Corp.*, No. 10 Civ. 246, 2011 WL 1239793, at *3 (S.D.N.Y. Mar. 28, 2011), *aff'd sub nom. Aqua Creations USA Inc. v. Hilton Worldwide, Inc.*, 487 Fed. App'x 627 (2d Cir. 2012).[16]

Given that the Copyright Office's decision on copyrightability is not binding, the application approach better reflects that the Copyright Office's opinion likely will have little bearing on substantive issues before a court.[17]

---

[16] *See also* NIMMER, *supra* note 9, § 12.11[B][3].

[17] *See, e.g.*, *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985) (mannequin figures listed as "sculptures" in certificates of registration not copyrightable); *Sari v. America's Home Place, Inc.*, 129 F. Supp. 3d 317, 326–28 (E.D. Va. 2015) (architectural plans not copyrightable even though Copyright Office issued certificate of registration); *I.C. ex rel. Solovsky v. Delta Galil USA*, 135 F. Supp. 3d 196, 213–15 (S.D.N.Y. 2015) (t-shirt design sufficiently original to make out *prima facie* case of copyright validity despite Copyright Office's refusal to issue registration certificate); *ATCS Int'l LLC v. Jefferson Contr. Corp.*, 807 F. Supp. 2d 516, 518 (E.D. Va. 2011) (drawings were nonprotectable "functionally driven designs" even

III. THE APPLICATION APPROACH SAFEGUARDS AUTHORS' ABILITIES TO EFFECTIVELY RESOLVE INFRINGEMENT CLAIMS

The application approach resolves numerous critical issues of timing, efficiency, and access to effective redress that arise under the certificate approach.

A. The Application Approach Ensures that Authors May Seek the Injunctive Relief that is Critical to Copyright Litigation

Significantly, the application approach ensures that copyright holders may go to court to obtain injunctions or temporary restraining orders "to prevent or restrain infringement of a copyright" as early as possible. 17 U.S.C. § 502. One of the unique characteristics of copyright law is the frequent need for copyright holders to seek emergency injunctive relief. As ABA members are well aware, monetary relief often does not suffice to remedy copyright infringement and injunctive relief is the only way of

---

though plaintiff held certificate of registration); *Sapon v. D.C. Comics*, No. 00 Civ. 8992, 2002 WL 485730, at *7 (S.D.N.Y. Mar. 29, 2002) (plaintiff's "Black Bat" drawings not sufficiently original despite fact that Copyright Office issued certificate of registration); *Past Pluto Prods. Corp. v. Dana*, 627 F. Supp. 1435, 1440–42 (S.D.N.Y. 1986) (design for foam hat of Statue of Liberty Crown not protectable despite Copyright Office issuing certificate of registration).

preventing irreparable injury. *See, e.g.*, *Salinger v. Colting*, 607 F.3d 68, 81 (2d Cir. 2010) (injunction warranted because harm to plaintiff is often "irreparable in light of possible market confusion"); *Omega Imp. Corp. v. Petri-Kine Camera Co.*, 451 F.2d 1190, 1195 (2d Cir. 1971) (noting that "prov[ing] the loss of sales due to infringement is . . . notoriously difficult"). Moreover, circumstances often arise in practice where several days of delay in filing for an injunction can make a world of difference, such as where an infringing work will undermine the demand for the yet-to-be-released original, *see New Line Cinema Corp. v. Bertlesman Music Grp., Inc.*, 693 F. Supp. 1517, 1530–31 (S.D.N.Y. 1988), or the market for the original work is "fleeting" in nature and will be displaced by the infringer, *see Lakedreams v. Taylor*, 932 F.2d 1103, 1109 (5th Cir. 2011). Indeed, "it is virtually axiomatic that the public interest can be served only by upholding copyright protections and, correspondingly, preventing the misappropriation of the skills, creative energies, and resources which are invested in the protected work." *Apple Comput., Inc. v. Franklin Comput. Corp.*, 714 F.2d 1240, 1254–55 (3d Cir. 1983).

As a copyright holder need not register a work to hold a copyright in it, it is common practice for authors not to immediately register their works, particularly given the rapid manner in which works are created in the modern world and the expense of keeping up with such registrations. Thus, it is foreseeable under the certificate approach that a copyright holder could learn of incipient infringement,

but be unable to sue immediately to obtain injunctive relief because she does not yet have a certificate of registration or refusal in hand. By the time the copyright holder's certificate of registration is either issued or refused, irreparable damage already may have occurred, and the proverbial horse will have left the barn.

While requiring a copyright holder to obtain a decision from the Copyright Office prior to filing suit may sound like a trivial delay, these delays present real problems. As of July 2018, the Copyright Office reports that a certificate of registration may issue anywhere between *three and twenty-eight months* after a copyright holder submits her application, deposit copy, and fee.[18] The length of time depends upon factors such as the form in which the application was submitted (*i.e.*, online or via mail), "how difficult a claim is to review, whether the Copyright Office needs to correspond with an applicant, and the number of registration specialists available to review claims."[19]

On average, the delay between filing and decision for online claims with no ensuing correspondence is seven months, and nine months for those requiring

---

[18] *See* U.S. Copyright Office, Registration Processing Times, https://copyright.gov/registration/docs/processing-times-faqs.pdf (last visited August 29, 2018).

[19] *Id.*

correspondence.[20] For claims made through the mail, the Copyright Office's review takes an average of nine months if there is no correspondence, and sixteen months with correspondence.[21] Thus, if a copyright holder learns of infringement early enough to stop it, but must wait to bring an infringement action until the Copyright Office issues either a certificate of registration or a refusal, the copyright holder effectively could lose her ability to get the immediate temporary restraining order or preliminary injunctive relief needed to best protect her interests.

The United States Government's brief asserts that this concern can be remedied by authors filing their registration materials through the Copyright Office's expedited review process known as "special handling." Brief for the United States as Amicus Curiae ("U.S. Amicus Br.") 22.[22] But special handling is not a solution. As a threshold matter, special handling is available only in limited circumstances, namely "pending or prospective litigation," "customs matters," and "contract or publishing deadlines that necessitate the expedited issuance of a certificate."[23] In addition, even accepting at face value the Copyright Office's

---

[20] *See id.*

[21] *See id.*

[22] U.S. COPYRIGHT OFFICE, COMPENDIUM 207 (2017).

[23] *Id.* at 623.2 (explaining prerequisites, process, and requirements for special handling).

goal to resolve expedited requests within five working days, this delay could still be the difference between an infringing work being publicly disseminated all over the world or not.[24] Moreover, the ABA's members report it can take much longer than five days for the Copyright Office to issue a decision through special handling. Indeed, ABA practitioners find it can take three or more weeks for the expedited decision to issue, if not longer.

Even if a copyright holder qualifies for special handling, in reality, this period of inaction can allow the infringement to spread far beyond the initial infringer and become impossible to track down and rectify. *See A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001). As the Ninth Circuit has recognized, "the application approach avoids unnecessary delays in copyright infringement litigation, which could permit an infringing party to continue to profit from its wrongful acts," without "impairing the central goal of copyright registration." *Cosmetic Ideas*, 606 F.3d at 619–20.[25] Importantly, it also eliminates the need for victims of copyright infringement to incur the often prohibitive additional

---

[24] *See id.* at 623.4.

[25] *See also* Shira Perlmutter, *Freeing Copyright from Formalities*, 13 CARDOZO ARTS & ENT. L.J. 565, 582 (1995) ("If the automatic attachment of rights may be reversed in whole or in part by inadvertent forfeitures of rights or remedies, the structure of incentives is seriously undercut.").

expense required to expedite Copyright Office review of an application.

Moreover, it should not be overlooked that special handling requires an *$855 fee*, as opposed to the $55 required for standard registration.[26] For many copyright holders, such as individual artists, photographers, and start-ups, this expense simply is not feasible. Moreover, this $855 sum could be compounded many times over if a copyright holder wants to sue on multiple works at the same time, or must continually file copyright applications due to the repeated infringement of her rights. Although copyright holders with limited resources have some hope of recovering their attorney's fees and costs incurred pursuing their claims should they ultimately prevail, *see* 17 U.S.C. § 504, they have no hope of recovering this steep special handling fee.[27] The net

---

[26] *See* U.S. Copyright Office, Fees, https://copyright.gov/about/fees.html (last visited August 29, 2018).

[27] Significantly, statutory damages and attorney's fees only would be available if the registration is made prior to the infringement, which is unlikely under the above circumstances, or within three months of publication. *See* 17 U.S.C. § 412; *see also* Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439, 545–55 (2009) (noting that "'[l]ittle guy' authors . . . in theory, have the same strong legal rights as major copyright industry players, but . . . effectively do not have the means to obtain relief when their rights are infringed" under the statutory damages limitations).

result is that authors who cannot afford the special handling fees may be deprived of the ability to obtain recourse for infringement of their rights. These burdens are inconsistent with copyright law's constitutional goal of incentivizing the creation and dissemination of new works by giving authors a limited monopoly for a period of time, as leaving authors effectively unable to protect their rights disrupts copyright's incentive system.

B. The Application Approach Better Accounts for Copyright Infringement's Short Statute of Limitations

The Copyright Office's delay in deciding whether to issue or refuse to issue a certificate of registration also has consequences for meeting the short three-year statute of limitations under the Copyright Act. The application approach reduces the likelihood that copyright claims will become statute of limitations barred in the time between filing an application, deposit copy, and fee with the Copyright Office and receiving a final decision.

Copyright infringement claims are subject to a short, three-year statute of limitations. *See* 17 U.S.C. § 507(b). Under the certificate approach, the statute of limitations may run out while the copyright holder waits for a decision from the Copyright Office, thus forever foreclosing a meritorious claim. By contrast, the application approach avoids this abject unfairness by allowing copyright holders to file suit within the

statute of limitations while Copyright Office review is ongoing.

This issue is even more significant in courts that calculate the limitations period from the time infringement begins (*i.e.*, using the "injury rule"), rather than the time the author discovers it (*i.e.*, the "discovery rule"). *See Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 n.4 (2014) (noting that not all circuits have adopted the discovery rule for infringement claims). In such circumstances, time is truly of the essence, as an author must find and craft claims against the infringer, and potentially also seek and obtain the Copyright Office's decision on whether to issue a certificate of registration, all within the three-year limitations period. Without justification, the certificate approach maximizes the hardship these authors must endure and might forever foreclose a copyright holder from bringing suit.

This statute of limitations issue is not idle conjecture. In *Kregos v. Associated Press*, the plaintiff filed his application with the Copyright Office in 1985, but due to an administrative delay, the Office did not issue a decision on that application until late 1988. 795 F. Supp. 1325, 1328 (S.D.N.Y. 1992). The district court held that the statute of limitations would not be tolled and barred plaintiff's copyright claim that fell outside of the three-year limitations period. *Id.* at

1331.[28] Copyright holders should not lose their property rights due to agency delay.

C. The Application Approach Eliminates the Wasteful Re-Filing of Infringement Claims that Occurs Under the Certificate Approach

The application approach also prevents the all-too-familiar circumstance of a court dismissing a copyright holder's infringement suit for failure to have a certificate of registration or refusal in hand, only to have the same claim refiled once the Copyright Office issues a decision later on. For example, in *Asche & Spencer Music, Inc. v. Principato-Young Entm't, Inc.*, 147 F. Supp. 3d 833, 838 (D. Minn. 2015), the court dismissed a copyright infringement claim after the copyright holder "obtained neither registration nor denial of registration from the Copyright Office" before filing suit, only for the plaintiff to file a new suit for infringement of the same works later, *see Asche & Spencer Music, Inc. v. Principato-Young Entm't, Inc.*, No. 17 Civ. 150 (D. Minn. filed Jan. 18, 2017); *see also*

---

[28] *See also Cosmetic Ideas*, 606 F.3d at 620 (noting that "under the [certificate] approach, a plaintiff who applied for registration towards the end of the three-year period could see the statute of limitations expire during the time it took the Copyright Office to act on the application"); NIMMER, *supra* note 9, at § 7.16[B] [1][a][i] ("[G]iven . . . a three-year statute of limitations . . . the narrow [certificate] approach may indeed occasion complete inability to recover damages.").

Lumetrics, Inc. v. Blalock, 23 F. Supp. 3d 138 (W.D.N.Y. 2014) (dismissing copyright infringement complaint for failing to register all software allegedly infringed, only for plaintiff to refile listing registrations, *see Lumetrics, Inc. v. Blalock*, No. 6:14 Civ. 6322 (W.D.N.Y. filed June 11, 2014)); *Greene v. Columbia Records/ Sony Music Entm't*, No. 3 Civ. 4333, 2004 WL 3211771 (S.D.N.Y. Mar. 1, 2004) (copyright infringement complaint dismissed where plaintiff had not yet received a decision, only for plaintiff to file suit based on infringement of same musical composition later, *see Greene v. Columbia Records, Inc.*, No. 1:13 Civ. 6965 (S.D.N.Y. filed Sept. 30, 2013)). This is wasteful of both the parties' and the judiciary's resources and improperly places form over the substance of the claims, which is out of step with our overall judicial system.

The process of filing a complaint, opposing a motion to dismiss, and later refiling a claim is both taxing on litigants—particularly those with limited means—and district courts. Indeed, the cost of filing additional court papers to oppose dismissal, or an amended or second complaint, can be very costly and deny copyright holders access to justice. Moreover, it simply "makes little sense to create a period of 'legal limbo' in which suit is barred."[29] The application approach alleviates this problem.

Overall, the application approach minimizes the procedural barriers to obtaining adequate relief for

---

[29] NIMMER, *supra* note 9, at § 7.16[B][3][b][ii].

copyright infringement, and enables copyright holders to seek such redress in a timely, efficient manner.

IV. THE APPLICATION APPROACH MINIMIZES PREJUDICE TO AUTHORS OF UNITED STATES WORKS

Significantly, the certificate approach further disadvantages authors of United States works in seeking relief in their own judicial system. In 1989, the United States became a signatory to the Berne Convention for the Protection of Literary and Artistic Works ("Berne")—an international treaty that, among other things, seeks to lessen formalities under copyright law, such as by eliminating the need to affix copyright notices and obtain registrations for works as conditions to copyright protection. Indeed, Berne mandates that, for foreign works, the "enjoyment and the exercise of . . . [copy]rights shall not be subject to any formality." Berne Convention art. 5(2), Sept. 9, 1886 (Paris Text 1971), S. Treaty Doc. No. 99–27 [hereinafter Berne Convention].

Yet, Berne permits its signatories to impose stricter requirements on authors within their own nation. Accordingly, United States law requires authors of United States works to comply with Subsection 411(a) before filing suit, while authors of foreign works seeking to sue in the United States face no such prerequisite. *See* 17 U.S.C. § 411(a) (applying only to "United States work[s]"); *id.* § 101 (defining "United States work"). This has resulted in a

situation where authors of foreign works have faster and cheaper access to United States courts than authors of United States works. *See* Berne Convention art. 5(3).

The application approach reduces the burden of this registration formality, and lessens discrimination against the owners of copyrights in United States works. If the certificate approach is followed, authors of United States works must submit registration materials to the Copyright Office, *and also* wait for the Register's decision before they can enforce their copyrights against infringers. As noted above, this can take months if not years. It is hard to see the logic in interpreting the term "registration" in a way that exacerbates the already significant impediment on the ability of authors of United States works to enforce their rights. Therefore, the ABA supports the application approach as a way of better protecting authors of United States works and facilitating the swift resolution of their copyright claims.

CONCLUSION

For the foregoing reasons, the ABA respectfully requests that the Court reverse the Eleventh Circuit's holding below.

Respectfully submitted,

Of Counsel:
Dale M. Cendali
Joshua L. Simmons
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, NY 10019
(212) 446-4800

Robert M. Carlson
Counsel of Record
AMERICAN BAR ASSOCIATION
321 North Clark Street
Chicago, Illinois 60654
(312) 988-5000
abapresident@americanbar.org

No. 17-571

In The Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,

Petitioner,

v.

WALL-STREET.COM, LLC, *et al.*,

Respondents.

On Writ Of Certiorari To The United States Court Of Appeals For The Eleventh Circuit

BRIEF OF AUTHORS AND EDUCATORS AS *AMICI CURIAE* IN SUPPORT OF RESPONDENTS

PETER JASZI
Counsel of Record
HILLARY BRILL
GLUSHKO-SAMUELSON INTELLECTUAL PROPERTY LAW CLINIC
WASHINGTON COLLEGE OF LAW
AMERICAN UNIVERSITY
4300 Nebraska Ave. NW
Washington, DC 20016
(202) 274-4148
pjaszi@wcl.american.edu
Counsel for Amici Curiae

October 18, 2018

COCKLE LEGAL BRIEFS (800) 225-6964
WWW.COCKLELEGALBRIEFS.COM

TABLE OF CONTENTS

Page

INTEREST OF *AMICI CURIAE* 1

SUMMARY OF THE ARGUMENT 3

INTRODUCTION 4

ARGUMENT 8

I. Historically, the Copyright Office Register and the Registration Process Has Upheld Copyright Quality 8

II. Congress Intended the Term "Registration" to Mean a Final Action by the Copyright Office, Not a Mere Application 14

A. The Plain Meaning of the Word "Registration" in Section 411(a) of the Copyright Act Means an Action Taken by the Copyright Office Because to Interpret Otherwise Does Not Make Common Sense 14

B. Legislative History Supports Registration as Meaning a Final Decision by the Copyright Office 19

III. The Term "Registration" Should Mean a Final Action by the Copyright Office Because the Courts, Parties to Litigation, and the General Public Benefit from a Screening Process that Supports Copyright Quality 24

TABLE OF CONTENTS – Continued

Page

A. Courts benefit from the screening process before copyright litigation because they can look to the expertise of the Copyright Office 24

B. Actual and potential defendants benefit from a registration approach that guards against unfounded and spurious claims 27

C. Creators and educators also benefit from the registration approach because a screening process provides clarity to those seeking to safeguard their rights 30

D. The general public benefits from institutions that support copyright quality 32

CONCLUSION 33

TABLE OF AUTHORITIES

Page

CASES

Brown v. Gardner, 513 U.S. 115 (1994) 16

Combat Zone, Inc. v. Does 1-1037, No. 3:10-cv-0090 (N.D.W. Va. Jan. 3, 2011) 29

Corley v. United States, 556 U.S. 303 (2009) 17

Esquire, Inc. v. Ringer, 591 F.2d 796 (D.C. Cir. 1978) 25

Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 338 (1991) 32

Fogerty v. Fantasy, Inc., 510 U.S. 517 (1991) 32

Garcia v. Google, Inc., 786 F.3d 733 (9th Cir. 2015) 25, 26, 27

Inhale, Inc. v. Starbuzz Tobacco, Inc., 755 F.3d 1038 (9th Cir. 2014) 25

Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962 (2014) 24

Righthaven, LLC v. Democratic Underground, 791 F. Supp. 2d 968 (D. Nev. 2011) 30

Righthaven, LLC v. DiBiase, No. 2:10-cv-01343, 2011 WL 5101938 (D. Nev. Oct. 26, 2011) 30

S.O.S., Inc. v. Payday, Inc., 886 F.2d 1081 (9th Cir. 1989) 31

Star Athletica, LLC v. Varsity Brands, Inc., 137 S. Ct. 1002 (2017) 14, 16

TABLE OF AUTHORITIES – Continued

Page

Third World Media, LLC v. Does 1-1568, No. C 10-04470 LB, 2011 WL 4344160 (N.D. Cal. Sept. 15, 2011) 29

Varsity Brands, Inc. v. Star Athletica, LLC, 799 F.3d 468 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002 (2017) 25, 26

CONSTITUTIONAL PROVISIONS

U.S. Const. art. I, § 8, cl. 8 3

STATUTES AND REGULATIONS

8 Anne, c. 2 (1710) 9

Act of May 31, 1790, ch. 15, § 3, 1 Stat. 124 (1790 Act) 9

17 U.S.C. § 53 (1909) 11

Va. Code Ann. (1989)

Va. Code Ann. § 46.2-600 16

Va. Code Ann. § 46.2-645 16

17 U.S.C. (2018)

17 U.S.C. § 410(a) 16

17 U.S.C. § 410(b) 16

17 U.S.C. § 410(c) 7, 31

17 U.S.C. § 410(d) 17, 18, 19

17 U.S.C. § 411 ..... 19, 21

TABLE OF AUTHORITIES – Continued

Page

17 U.S.C. § 411(a) ..... *passim*

17 U.S.C. § 412 18

14 C.F.R. § 47.39 (2010) 15

37 C.F.R. § 201.2 (2018) 7

LEGISLATIVE AUTHORITIES

Abe Goldman, The History of U.S.A. Copyright Law Revision From 1901 to 1954, in S. Comm. on the Judiciary Subcomm. on Patents, Trademarks, and Copyrights, 86th Cong., Copyright Law Revision (Study No. 1) (Comm. Print 1960) 11

Benjamin Kaplan, The Registration of Copyright, in S. Comm. on the Judiciary Subcomm. on Patents, Trademarks, and Copyrights, 86th Cong., Copyright Law Revision (Study No. 17) (Comm. Print 1960) 9, 10, 11, 12

Caruthers Berger, Authority of the Register of Copyrights to Reject Applications for Registration, in S. Comm. on the Judiciary Subcomm. on Patents, Trademarks, and Copyrights, 86th Cong., Copyright Law Revision (Study No. 18) (Comm. Print 1960) 12

134 Cong. Rec. S28302 (daily ed. Oct. 5, 1988) (Joint Explanatory Statement on Amendment to S. 1301) 21

TABLE OF AUTHORITIES – Continued

Page

Copyright Office Operations, Accomplishments, and Challenges: Hearing Before the Subcomm. on Courts, and Intellectual Property of the H. Comm. on the Judiciary, 105th Cong. (1998) (Statement of Marybeth Peters, The Register of Copyrights) 5

Energy and Water, Legislative Branch, and Military Construction and Veterans Affairs Appropriations Act of 2019, Pub. L. No. 115-244 (2018) 6

Fiscal 2019 Budget Request of the United States Copyright Office: Hearing Before the Subcomm. on Leg. Branch Appropriations of the H. Comm. on Appropriations, 115th Cong. (2018) (Statement of Karyn Temple, Acting Register, United States Copyright Office) 5

H. Comm. on the Judiciary, 87th Cong., Rep. on Copyright Law Revision (Comm. Print 1961) (Report of the Register of Copyrights, General Revision of Copyright Law) 20, 21

H. Comm. on the Judiciary, 89th Cong., Supplementary Register's Report on the General Revision of the U.S. Copyright Law (Comm. Print 1965) 20

H.R. 897, 103rd Cong. (1993) 22

H.R. Rep. No. 94-1476 (1976) 19, 20

H.R. Rep. No. 100-609 (1988) 21, 22

TABLE OF AUTHORITIES – Continued

Page

Library of Cong., Rep. on the Advisory Comm. on Registration & Deposit (1993) (Robert Wedgeworth & Barbara Ringer, Co-Chairs) 22, 23

OTHER AUTHORITIES

Brief for Petitioner, *Fourth Estate Public Benefit Corp. v. Wall-Street.com* (No. 17-571), 2018 WL 4091715 19

Freedom of Information Act (FOIA) Records, U.S. Copyright Office, https://www.copyright.gov/foia/ (last visited Oct. 9, 2018) 7

John Y. Cole, *Ainsworth Spofford & Copyright Law of 1870*, 6 J. Libr. Hist. 34 (1971) 9, 10

Judith Nierman, *Certificate from 1897 Has Antique Charm*, Copyright Lore (Nov. 2007), https://www.copyright.gov/history/lore/pdfs/200711%20CLore_November2007.pdf 10

Matthew Sag, *Copyright Trolling, An Empirical Study*, 100 Iowa L. Rev. 1105 (2015) 29

2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2018) 24

Register, Black's Law Dictionary (10th ed. 2010) 15

Register, Merriam-Webster Dictionary, https://www.merriam-webster.com/dictionary/register (last visited Oct. 13, 2018) 15

TABLE OF AUTHORITIES – Continued

Page

Registration Processing Times, U.S. Copyright Office, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (last visited Oct. 5, 2018) 6

Review Board Letters Online, U.S. Copyright Office, https://www.copyright.gov/rulings-filings/review-board/ (last visited Oct. 12, 2018) 7

Rules of the Cal. St. Bar § 4.16(a)-(b) (West 2018) 15

U.S. Copyright Office, Compendium of U.S. Copyright Office Practices (2d ed. 1998) 13

U.S. Copyright Office, Compendium of U.S. Copyright Office Practices (3d ed. 2017) 5, 14

William F. Patry, *Copyright Law and Practice* (1994) 11

5 William F. Patry, *Patry on Copyright* (2018) 9, 20, 21

INTEREST OF *AMICI CURIAE*[1]

The undersigned authors, educators, and other creators respectfully submit this brief as *amici curiae* in support of Respondents Wallstreet.com, et al. pursuant to Rule 37 of the Rules of this Court. *Amici* urge this Court to affirm the judgment of the U.S. Court of Appeals for the Eleventh Circuit and its definition of "registration" in Section 411(a) of the Copyright Act as meaning a final decision on an application for registration filed with the Copyright Office, after an expert review to determine the copyrightability of the work, rather than the mere filing of the application.

The *amici* are: Steve Anderson, Professor of Digital Media at UCLA; Patricia Aufderheide, Professor at the School of Communication at American University; Nancy Breslin, a fine art photographer and teacher in Washington, D.C.; Peter Decherney, Professor of Cinema & Media Studies and English at the University of Pennsylvania; Melissa Dunphy, an award-winning composer specializing in political and theatrical music; Bob Hercules, a Peabody Award-winning filmmaker whose work has been seen widely on PBS, BBC, the Discovery Channel, and elsewhere; Senna Hubbs, a playwright and fanfiction author; Lewis Hyde, an author and Professor Emeritus of Creative Writing at

---

[1] Pursuant to Supreme Court Rule 37.6, *amici curiae* certify that no counsel for a party authored this brief in whole or in part and that no person or entity, other than *amici curiae* or its counsel, has made a monetary contribution to its preparation or submission. The parties have granted blanket consent for the filing of *amici curiae* briefs.

Kenyon College; Kelly Richmond Pope, a documentary filmmaker; Gordon Quinn, the Artistic Director of Kartemquin Films, whose award-winning documentary filmmaking career spans over 50 years; Aram Sinnreich, Associate Professor at the School of Communication at American University; and Rebecca Tushnet, the Frank Stanton Professor of First Amendment Law at Harvard Law School.

Amici are individuals whose livelihood and means of self-expression are dependent on consistent and fair copyright protection. As creators covering a diverse swath of artistic and educational disciplines, *amici* interact with potentially protected material routinely. To reach their audience of viewers, readers, students, and others, the *amici* depend on clarity and transparency in the law. *Amici* require protection for the new copyrightable works they produce, but they also depend in their daily practice on the reasonable availability of pre-existing works as source material. Thus, they depend on the maintenance of what might be called "copyright quality," elements of which include a fair, clear, and consistent boundary between copyrightable and non-copyrightable material and the regular application of that demarcation in particular cases, as well as the availability of public records relating to copyright ownership. In this case, *amici's* main concern is to ensure that the Copyright Office will continue, as Congress intended, to serve as an objective and timely source of expertise on questions of ownership and copyrightability, as this benefits courts, rights holders, users, and the general public.

The "registration approach," requiring domestic copyright claimants to participate in a thorough review by the Copyright Office before commencing infringement litigation in federal court, will help maintain robust and expert oversight of copyright quality, which in turn helps fulfill the constitutional mandate "[t]o promote the Progress of Science and useful Arts." U.S. Const. art. I, § 8, cl. 8. Methodical copyright examination in advance of litigation benefits *amici* by providing useful guidance to courts grappling with difficult copyright questions and serves as an important check (or "speed bump") to discourage unfounded or spurious claims – both functions on which *amici* rely in their capacity as potential copyright defendants. In addition, *amici* also rely on the registration process and the institutional expertise that has developed for guidance about the true nature and extent of their own rights as creators. Moreover, as members of the general public, *amici* depend on the guidance provided by the registration process to distinguish protected content from material in the public domain. By relegating the examination process to a subsidiary position, the so-called "application approach" favored by the Petitioner would put all these interests at risk.

SUMMARY OF THE ARGUMENT

The plain meaning of Section 411(a) of the Copyright Act, its legislative history, and the history of the registration process, as well as both contemporary

Copyright Office registration practices and fundamental underlying policies, necessitate the registration approach. This approach not only enables the Copyright Office to provide timely institutional expertise through consistent and rigorous review of all individual applications for registration, but also through the publication of comprehensive guidance documents. The registration approach promotes effective and efficient judicial decision making by assuring prelitigation review of whether individual works conform to standards of copyrightability; likewise, it supports creators in meeting those standards. It also provides actual or potential defendants with a means for understanding the credibility of claims made against them and functions as a screening mechanism that safeguards against the proliferation of unfounded assertions of copyright.

INTRODUCTION

Many factors in the U.S. copyright regime contribute to copyright quality, including the thorough examination of applications as part of the copyright registration process. The registration process helps assure that the standards of originality and subject-matter eligibility are met with respect to specific works, and that those standards are well articulated and widely understood. After a creator submits an application, an examiner (or "registration specialist") with relevant subject-matter expertise is assigned to the application who then performs a rigorous review of

that application. *See* U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 206 (3d ed. 2017) (hereinafter Compendium III). The same examiner handles all claims relevant to the application, ensuring familiarity with the needs of that creator. *See Copyright Office Operations, Accomplishments, and Challenges: Hearing Before the Subcomm. on Courts, and Intellectual Property of the H. Comm. on the Judiciary*, 105th Cong. (1998) (Statement of Marybeth Peters, The Register of Copyrights). The registration screening process involves expert scrutiny of applications to assure they meet prevailing standards relating to copyrightable subject-matter and originality, as well as information regarding ownership. *See* Compendium III §§ 206, 602.2. To that end, the Copyright Office has developed a 1,200-plus page manual, the Compendium III, that guides expert examiners. The Compendium III details specific standards to determine what is copyrightable and provides an outline of the examination process. The Compendium III is the result of the effort to maintain and refine standards of copyright quality that has been ongoing since the first edition was published in 1967.

The Copyright Office has recently emphasized the importance of examination, as reflected in its fiscal year 2019 budget request for additional funding to hire examiners, "much-needed registration specialists," and to "train[] [them] in complex copyright claim[] examination." *Fiscal 2019 Budget Request of the United States Copyright Office: Hearing Before the Subcomm. on Leg. Branch Appropriations of the H. Comm. on*

Appropriations, 115th Cong. 5 (2018) (Statement of Karyn Temple, Acting Register, United States Copyright Office); *see also* Energy and Water, Legislative Branch, and Military Construction and Veterans Affairs Appropriations Act of 2019, Pub. L. No. 115-244, § 135 (2018). Expert trained examiners are essential because copyright examination is not a mechanical or ministerial process. When issues arise, copyright examiners correspond with applicants by phone, mail, or e-mail, sometimes for several rounds, in an attempt to resolve deficient aspects of applications, which may include limiting claims relating to a work's copyrightable elements. Approximately 30 percent of all applications lead to such correspondence. *See Registration Processing Times*, U.S. Copyright Office, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (last visited Oct. 5, 2018). Since many applications are noncontroversial, the effective rate of correspondence in difficult cases is necessarily higher. For instance, in the digital age, examiners frequently work with creators to revise applications to comply with the law of copyrightability in areas such as online databases, websites, and sample-based art and music.

After the review process, when an application is granted registration, a certificate of registration is then issued to the applicant and added to the Copyright Office's online database, which is easily accessible to the public via its website. The public can look to the online database to confirm validity and ownership of a copyright. The end result of the registration review, as confirmed in the certificate, can then be used

as *prima facie* evidence of copyrightability during litigation. *See* 17 U.S.C. § 410(c) (2018).

If after review an application has been denied registration, written notice with an explanation as to why the application was rejected and how to appeal the decision is sent to the applicant. Since 2016, all of the final determinations on second appeal by the Copyright Office's Review Board regarding decisions to refuse copyright registrations are publicly available online. *See Review Board Letters Online*, U.S. Copyright Office, https://www.copyright.gov/rulings-filings/review-board/ (last visited Oct. 12, 2018). Though there is currently no database of every communication between applicants and the Copyright Office, "the vast quantity" of "official correspondence" with applicants, as well as other registration records, are generally available for public inspection on request and discoverable in litigation as part of the public record. *See* 37 C.F.R. § 201.2 (2018); *see also Freedom of Information Act (FOIA) Records*, U.S. Copyright Office, https://www.copyright.gov/foia/ (last visited Oct. 9, 2018).

Documentation relating to registration provides an obvious general public benefit. The value of such information in connection with contemplated or actual legal proceedings, however, depends entirely on when the Copyright Office's expert review is available. By ensuring that the examination process is completed before any lawsuit is commenced, the registration approach promotes both sound jurisprudence and equity among litigants.

The usefulness of a pre-litigation examination process to promote copyright quality is exemplified in the present case, where the Petitioner had attempted to register a collection of materials. Although its application ultimately was rejected because the database was found to lack original selection, coordination, or arrangement, a lawsuit was already underway, proceeding without the benefit of the Copyright Office's expertise. In this case, the lawsuit now has continued for years; whereas, it might have been resolved more quickly under the registration approach.

Registration has been improved, refined, and streamlined over the modern history of U.S. copyright law; as a result, both the application of registration standards to specific works, and general knowledge about those standards, have been enhanced. Only the registration approach supports the mission of the Copyright Office to promote copyright quality by applying clear and consistent standards to disputable questions of ownership and copyrightability in advance of litigation.

ARGUMENT

I. Historically, the Copyright Office Register and the Registration Process Has Upheld Copyright Quality.

Over almost 125 years, the Copyright Office has played an important role in promoting copyright quality by establishing a registration process based on a

comprehensive examination of all claims. In fact, since its very inception, some form of registration in service of copyright quality has been a feature of copyright jurisprudence. In Great Britain, the 1710 Statute of Anne established registration as a prerequisite for the special remedies afforded to copyright owners. *See* 8 Anne, c. 2 (1710). The goal was to assure a public record of copyright ownership. *See* 5 William F. Patry, *Patry on Copyright* § 17:64:10 (2018).

Likewise, the Copyright Act of 1790 required would-be beneficiaries of protection to register "a printed copy of the title of the work, prior to publication, in the clerk's office of the [author's local federal] district court," pay a fee, publish a public notice in a newspaper, and deposit "a copy of the work, within 6 months of publication, [directly] to the Secretary of State," in Washington, D.C. *See* Act of May 31, 1790, ch. 15, § 3, 1 Stat. 124 (1790 Act); *see also* Benjamin Kaplan, The Registration of Copyright, in S. Comm. on the Judiciary Subcomm. on Patents, Trademarks, and Copyrights, 86th Cong., Copyright Law Revision 9 (Study No. 17) (Comm. Print 1960) (hereinafter Kaplan) ("Section 3 stated that 'no person shall be entitled to the benefit of this act' unless he registered."). While the Copyright Act itself continued to evolve from 1831 to 1867, some form of a registration process remained consistent. *See* Kaplan at 11.

By 1870, the need for a centralized federal copyright registration system had become apparent to Ainsworth Spofford, the Librarian of Congress at the time. *See* John Y. Cole, *Ainsworth Spofford &*

Copyright Law of 1870, 6 J. Libr. Hist. 34, 34 (1971) (hereinafter Cole). Registration was established as a condition precedent (along with notice placed on printed copies) to the enjoyment of federal copyright protection. *See* Kaplan at 13-14. In an effort to improve the registration process, Spofford lobbied Congress to centralize federal copyright registration under the Library of Congress. *See* Cole at 34 (quoting a letter Spofford sent to Representative Thomas A. Jenkins, "Permit me to bring your attention to some leading reasons why transfer of the entire copyright business to the Library of Congress would promote public interest."). Spofford ultimately succeeded and became the first *de facto* Register responsible for upholding copyright quality and administering copyright registrations. *See id.*

Although Spofford is perhaps most known for his interest in expanding the Library's collection through registration-related deposits, he also introduced the qualitative dimension of copyright examination. Under Spofford, the newly centralized copyright examination and registration system was informal, but Spofford signed each certificate of registration by hand, and there are records of rejected and cured applications during Spofford's tenure. *See* Judith Nierman, *Certificate from 1897 Has Antique Charm*, Copyright Lore 16 (Nov. 2007), https://www.copyright.gov/history/lore/pdfs/200711%20CLore_November2007.pdf. Spofford, who felt that issuing copyright registrations required his review and that this time commitment

pulled him away from his duties as the Librarian, asked Congress to establish the Copyright Office as a separate entity within the Library of Congress. *See* William F. Patry, *Copyright Law and Practice* 51, n. 166, 52 (1994). When the new Copyright Office was established to handle registration, Spofford passed the torch, nominating Thorvald Solberg as the first official Register of Copyrights. *See id.* at 52.

Solberg, as Register, was at the head of the movement to make a general revision of U.S. copyright law and his efforts led to the passage of the Copyright Act of 1909. *See* Abe Goldman, The History of U.S.A. Copyright Law Revision From 1901 to 1954, in S. Comm. on the Judiciary Subcomm. on Patents, Trademarks, and Copyrights, 86th Cong., Copyright Law Revision 1 (Study No. 1) (Comm. Print 1960). The 1909 Copyright Act statutorily put in place the existing registration requirements necessary before bringing suit, recognizing the importance of a pre-litigation copyright review. *See* Kaplan at 15-21. Moreover, the 1909 Act codified the Register of Copyright's authority to "make rules and regulations for the registration of claims to copyright," allowing the Register to further improve the registration process and establish a rigorous examination review. *See* 17 U.S.C. § 53 (1909).

As part of the groundwork for another projected general revision of U.S. copyright law, in 1958 Professor Benjamin Kaplan was commissioned to conduct a study detailing the registration review process. His findings reflect the evolution of that process and its function under the 1909 Act: "When applications are

received in the Copyright Office, the Examining Division scrutinizes them . . . check[ing] for adequacy of the notice of copy-right; agreement in dates, names, etc., between the application and the deposited copies; propriety of the 'class' in which copyright is claimed; evident copyrightability of the work, and some other matters." Kaplan at 35-36. Further, he emphasized its importance stating, "The check carried out by the Examining Division is a means of enforcing both formal and substantive requirements including . . . copyrightability. . . . As a practical matter this check is perhaps the chief official instrument of law enforcement." Kaplan at 41.

Additionally, Kaplan noted that the registration process is a means of utilizing the expertise of the Copyright Office because "the examination of submitted papers and deposits carried on in the Copyright Office helps to secure a trustworthy body of information," which benefits courts and parties to litigation. *See* Kaplan at 42. The value attached to the registration process was further documented in a 1959 commissioned study by Caruthers Berger, who noted the detrimental effects of not having a thorough registration process: "Further consequences also seem evident: the registration records would be cluttered with unfounded claims; registration records and certificates would be unreliable and would lose much of their probative value for copyright claimants, for other persons dealing with them, and for the courts; and many unfounded claims would probably become the source of litigation." Caruthers Berger, Authority of the Register

of Copyrights to Reject Applications for Registration, in S. Comm. on the Judiciary Subcomm. on Patents, Trademarks, and Copyrights, 86th Cong., Copyright Law Revision 95 (Study No. 18) (Comm. Print 1960) (hereinafter Berger). Further, Berger affirmed that refusals of registration have a variety of useful functions. *See id.* (noting that courts give weight to the Copyright Office's interpretation of the law, and that a refusal can benefit the public and parties by "serv[ing] to inform applicants and the public of the scope of the copyright law.").

Against this backdrop, the 1976 Copyright Act provided that "registration must be made before a suit for copyright infringement is instituted." 17 U.S.C. § 411(a) (2018). As will be discussed below, this provision clearly recognizes that a pre-screening allows the Copyright Office to exercise its expertise on issues of registrability before litigation commences. And in 1984, with the new Copyright Act in place, the Copyright Office published a refined and improved Compendium setting forth in greater detail the standards and procedures designed to ensure a comprehensive copyright quality review process. *See* U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 108 (2d ed. 1998).

As displayed in the institutional history above, copyright registration has long played an essential role in promoting and upholding copyright quality. It evolved from a system for title recordation into one that also served to promote the central goals of the copyright system. The registration approach respects

this historical development by ensuring that review occurs before litigation, when it is of greatest utility to courts, parties, and the general public. In fact, the Copyright Office itself defines "registration" as an expert review process, not a mere unilateral action, which involves "examining the claim, and if the claim is approved, . . . numbering the claim, *issuing* a certificate of registration, and creating a public record." Compendium III, Glossary, 14 (emphasis added).

II. Congress Intended the Term "Registration" to Mean a Final Action by the Copyright Office, Not a Mere Application.

A. The Plain Meaning of the Word "Registration" in Section 411(a) of the Copyright Act Means an Action Taken by the Copyright Office Because to Interpret Otherwise Does Not Make Common Sense.

In construing a federal statute, one begins with the legislative language as written. In turn, the plain language of Section 411(a) indicates that Congress intended registration to occur only after the Copyright Office has made a decision on an application. When faced with questions of statutory interpretation, this Court prioritizes the plain meaning of the text, giving each word its "ordinary contemporary, [and] common meaning." *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (quoting *Walters v. Metropolitan Ed. Enterprises, Inc.*, 519 U.S. 202, 207 (1997)).

The common and ordinary meaning of "register" requires an official *action*, such as "to enter in a public registry" or "to make a record of." *Register*, Black's Law Dictionary (10th ed. 2010); *see also Register*, Merriam-Webster Dictionary, https://www.merriam-webster.com/dictionary/register (last visited Oct. 13, 2018) ("[T]o make or secure official entry of in a register."). Copyrights cannot be officially "entered" on the relevant "public registry" until the Copyright Office has reviewed and made a decision on an application.

Common official usage is to the same effect. For example, an individual who owns an aircraft must, before flying, register with the Federal Aviation Administration by submitting an application, acquiring an N-number, paying a fee, and receiving approval from the Administration. *See* 14 C.F.R. § 47.39 (2010) ("An aircraft is registered on the date the Registry determines that the submissions meet the requirements of this part."). Additionally, to be eligible to sit for the California State Bar, an applicant must first register as a law student or attorney with the California State Bar Office of Admissions by submitting an Application of Registration beforehand. *See* Rules of the Cal. St. Bar § 4.16(a)-(b) (West 2018) ("The Application for Registration must be approved," before the applicant can submit other mandated application materials including: a moral character determination and Bar exam application). Likewise, to register one's car with the Virginia Department of Motor Vehicles, an individual must "register with the Department and obtain from the Department the registration card and certificate of

title for the vehicle." Va. Code Ann. § 46.2-600 (1989). Only after review and approval of the applicant's materials is the applicant entitled to registration of the vehicle. *See id.* § 46.2-645 ("[W]hen satisfied that the applicant is entitled to register the vehicle, [the DMV] shall register the vehicle.").

Moreover, to understand the meaning of a statute, individual parts need to be interpreted in relation to the whole because meaning is "a creature not of definitional possibilities but of statutory context." *Brown v. Gardner*, 513 U.S. 115, 118 (1994); *see also Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (internal citation omitted) ("[A] phrase of uncertain reach is not confined to a single sentence when the text of the whole statute gives instruction as to its meaning."). With this in mind, the term "registration" in Section 411(a) must be interpreted to mean a final decision in a multi-step process in order to maintain consistency with Section 410(a), which stipulates that certificates of registration are only issued "*after examination*." 17 U.S.C. § 410(a) (2018) (emphasis added). If an application alone was needed for registration, then there would not be a need for defining "registration" in Section 410(a) as an action after an examination has occurred.

Section 410(b) similarly divides the application and the decision by the Copyright Office into separate occurrences by indicating that once an application is submitted, a refusal may only occur after the intermediary step of the Copyright Office's "determination." *See* 17 U.S.C. § 410(b) (2018). Interpreting "registration"

as the final part of a process of copyright review is further upheld in Section 410(d), which provides, "The effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. § 410(d) (2018). It would be incongruous to interpret "registration" in Section 411(a) to mean mere filing of an "application" because it would require the conclusion that Congress intended the same term to have different meanings in various parts of the same statutory chapter.

Moreover, this Court has stated "[a] statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void[,] or insignificant. . . ." *Corley v. United States*, 556 U.S. 303, 314 (2009) (quoting *Hibbs v. Winn*, 542 U.S. 88, 101 (2004)). It is notable, therefore, that the second sentence of Section 411(a) provides, "[w]here the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. § 411(a) (2018). Not only does this language indicate that application formalities and registration itself are distinct, but this authorization to sue *after refusal* would have no function under the application approach, under which a claimant can file without regard to the outcome of an

application. Likewise, the final sentence of Section 411(a) would be rendered moot in many cases under an application approach. It provides that the Register is able to intervene in litigation after it has completed its examination process and refused registration. That provision, which has its own important role in ensuring copyright quality, would be effectively meaningless in cases where the Copyright Office's decision comes only after litigation has been filed, has advanced, or has even concluded. *See* 17 U.S.C. § 411(a) (2018).

The registration approach also helps to avoid anomalies that could arise in the course of litigation with respect to Sections 410(d) and 412 were the application approach to be preferred. Under Section 410(d), the effective date of registration is backdated to the day when all three parts of an application are received. *See* 17 U.S.C. § 410(d). When the Copyright Office receives an incomplete submission, the effective date of registration is deferred until all materials have been properly submitted. *See id.* Under the application approach, however, a plaintiff may immediately bring suit after submitting even an incomplete application. In this scenario, the effective date of registration could well be later than the commencement – or even the resolution – of the litigation premised upon it. This realistic hypothetical would also create an unworkable structure for awards of attorney's fees and statutory damages, which are premised on effective registration preceding the commencement of infringement. *See* 17 U.S.C. § 412.

B. Legislative History Supports Registration as Meaning a Final Decision by the Copyright Office.

Proponents of the application approach insist that because Section 410(d) provides "[t]he effective date of copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration . . . ," judicial consideration therefore can supplant the Copyright Office's review for all purposes. *See* 17 U.S.C. § 410(d) (2018); *see also* Brief for Petitioner at 38, *Fourth Estate Public Benefit Corp. v. Wall-Street.com* (No. 17-571), 2018 WL 4091715, at *38. The legislative history of Section 410(d) indicates otherwise, demonstrating that the provision was designed *only* to fulfill a specific technical requirement relating to the timing of registration and to take into account "the inevitable time lag between receipt of application and other material and the issuance of the certificate." H.R. Rep. No. 94-1476, at 157 (1976). Courts were not meant to supplant the original function of the Copyright Office's review; instead, Congress recognized that a "federal court might later find that the Copyright Office was wrong in refusing registration" and that the effective date of registration should be assigned by a court of competent jurisdiction as the date that the Office received the application in proper form. *See id.*

Legislative history, however, does support the registration approach. When explaining Section 411 in the 1976 Copyright Act, the House Judiciary Committee

stated that "[t]he first sentence in Section 411(a) restates the present statutory requirement that registration be made before a suit for copyright infringement is instituted." H.R. Rep. No. 94-1476, at 157. Congress's understanding of the "present statutory requirement" in 1976 was informed by the 1965 *Supplementary Register's Report on the General Revision of the U.S. Copyright Law*, which assumes a multi-step process of registration as demonstrated in the statement, "If a claimant has properly applied for registration and been refused, he may maintain an infringement suit." H. Comm. on the Judiciary, 89th Cong., Supplementary Register's Report on the General Revision of the U.S. Copyright Law 11 (Comm. Print 1965); *see also* 5 William F. Patry, *Patry on Copyright* § 17:64.40, n.3 (2018) ("Courts under the 1909 Act appear to have treated the term 'maintained' to be synonymous with 'begun' and not with 'continued.'").

Legislative history also provides evidence that Congress, in the lead-up to the 1976 Act, considered and respected the values of a registration system that upholds copyright quality. The Register of Copyright's 1961 Report to Congress explained how insisting on examination before litigation promotes copyright quality by weeding out "[m]any unfounded claims, usually resulting from a lack of knowledge of the law . . . thus avoiding needless controversy and litigation." H. Comm. on the Judiciary, 87th Cong., Rep. on Copyright Law Revision 72 (Comm. Print 1961) (Report of the Register of Copyrights, General Revision of Copyright Law). Additionally, a registration system was understood to

inform "[a]uthors and other claimants not familiar with the law . . . of the requirements for copyright protection" and to assist "courts in establishing presumptive facts and applying the law." *Id.* at 73, 75.

Subsequently, Congress's continued support for the values embedded in the registration system was demonstrated by its decisions to retain the basic scheme of Section 411's pre-litigation registration requirement in the face of broad-ranging discussions of its possible elimination. First, in 1988, when the United States was attempting to bring itself into compliance with the minimum standards of the Berne Convention (especially Article 5(2)), Congress reconsidered the registration requirement comprehensively and chose to retain Section 411(a) for copyright claimants because "the validity of a copyright claim is a necessary precondition for enforcement of copyright protection under current law." 134 Cong. Rec. S28302 (daily ed. Oct. 5, 1988) (Joint Explanatory Statement on Amendment to S. 1301); *see also* 5 William F. Patry, *Patry on Copyright* § 17:79 (2018). The House Judiciary Committee recognized in its report that keeping a copyright review process before litigation, as established by Section 411(a), is in the "public interest." H.R. Rep. No. 100-609, at 41–42 (1988).

Specifically, "Copyright registration promotes efficient litigation practices, to the benefit of the courts and the public as well as to the parties in the lawsuit. Registration narrows the issues that must be litigated and, since it pertains to proof of ownership, assists the

courts in resolving the underlying copyright dispute. . . ." *Id.* at 41. The Committee also recognized that bad faith actors take advantage of a system where there is no registration process upholding a copyright quality review – a system like the application approach – and argued against the "abolition of section 411(a) [as it] would result in attempts to use the legal system to exert control over materials that Congress intends to be in the public domain." *Id.* at 42. Moreover, "Since the *prima facie* presumption of originality . . . would continue to provide a strong incentive for registration, it would arguably be those claimants who do not have a cognizable claim to copyrightability who would forego the substantial benefits of registration; examples would include utilitarian, industrial[,] and other works that do not meet the existing standards of protection." *Id.*

Congress again considered eliminating the registration requirement of Section 411(a) in the Copyright Reform Act of 1993. *See* H.R. 897, 103rd Cong. §§ 5, 6 (1993). In response, the Librarian of Congress established the Advisory Committee on Copyright Registration and Deposit ("ACCORD") "to advise him concerning aspects of the proposed Copyright Reform Act of 1993." Library of Cong., Rep. on the Advisory Comm. on Registration & Deposit 5 (1993) (Robert Wedgeworth & Barbara Ringer, Co-Chairs) (hereinafter ACCORD). In explaining the logic for keeping the registration requirement, the ACCORD Report mirrors the policy concerns voiced by the House Judiciary Committee in 1988. For example, the ACCORD noted

that Section 411(a) "provides a mechanism by which copyright claims involved in litigation are first exposed to specialized, expert scrutiny [of the Copyright Office], aiding claimants and the courts by clarifying the information on certificates and screening out unfounded claims to copyright." *Id.* at 16. In addition, the Report noted that Congress expressly preferred the "retention of the requirement as helpful to the courts: the better the Copyright Office records, the better the decisions will be." *Id.* at 16. Following the communication of this report to Congress, the legislative initiative did not proceed.

All this well-documented legislative history is consistent with the evidence of plain meaning and context. Taken together, they indicate that Congress continually upheld the values inherent in the registration process and continually chose not to eliminate a prelitigation screening process that would help prevent unfounded claims from going to trial without the benefit of the Copyright Office's expertise.

III. The Term "Registration" Should Mean a Final Action by the Copyright Office Because the Courts, Parties to Litigation, and the General Public Benefit from a Screening Process that Supports Copyright Quality.

A. Courts benefit from the screening process before copyright litigation because they can look to the expertise of the Copyright Office.

It is well established that when "the question as to copyrightability forms the core of the dispute between the parties, . . . input from the Copyright Office – the governmental agency that possesses special expertise in determining the bounds of copyright protection – [can] be of great value (particularly to a judge lacking previous exposure to higher copyright doctrine)." 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16[B][3][b][vi] (2018). Under the registration approach, whether the Copyright Office has granted or rejected an application for registration, the results of the Copyright Office's expertise are available from the outset of any copyright litigation, providing guidance for sound court decisions, and potentially helping to improve judicial inefficiency. This Court emphasized the importance of the registration process to courts as an expression of expertise when it stated, "The registration mechanism, we further note, reduces the need for extrinsic evidence . . . although registration is 'permissive,' both the certificate and the original work must be on file with the Copyright Office before a copyright owner can sue for infringement." *Petrella v.*

Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1977 (2014).

Decisions from courts regarding copyrightability disputes rely upon the Copyright Office's expertise resulting from its registration pre-litigation screening process. *See, e.g., Garcia v. Google, Inc.*, 786 F.3d 733, 741-42 (9th Cir. 2015) (*en banc*) ("The Copyright Office's well-reasoned position 'reflects a body of experience and informed judgment to which courts and litigants may properly resort for guidance.'"); *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 480 (6th Cir. 2015), *aff'd*, 137 S. Ct. 1002 (2017) ("[T]he Copyright Office has grounded its decisions to register . . . in the text of the statute using sound legal reasoning. . . . [T]he Copyright Office's expertise in identifying and thinking about the difference between art and function surpasses ours."); *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041 (9th Cir. 2014) (holding that when interpreting the Copyright Act, the court defers to the Copyright Office's interpretations in the appropriate circumstances); *Esquire, Inc. v. Ringer*, 591 F.2d 796, 801 (D.C. Cir. 1978) ("[T]he boundaries between copyrightable 'works of art' and non-copyrightable industrial designs . . . is clearly a matter in which the Register has considerable expertise.").

Additionally, courts have specifically recognized both the consistency of the Copyright Office's expertise, *Varsity Brands, Inc.*, 799 F.3d at 480 ("[T]he Copyright Office consistently applied the same interpretation of separability to Varsity's numerous designs."), and its persuasiveness. *See Inhale, Inc.*, 755

F.3d at 1042 ("Because the Copyright Office's reasoning is persuasive, [this court] adopt[s] it for this case."); *see also Varsity Brands, Inc.*, 799 F.3d at 480 ("[D]istrict court erred by failing to give greater deference to the Copyright Office's registration determinations.").

Under an application approach, courts would often be denied the benefit of the Copyright Office's expertise. They would operate less effectively and efficiently since unfounded claims would move forward without the benefit of a pre-litigation copyright quality screening review. An example of drawbacks associated with the application approach is provided by the recent case of *Garcia v. Google, Inc.* in which the plaintiff alleged copyright infringement because YouTube had hosted a video whose director had transformed her acting performance into "a blasphemous video proclamation against the Prophet Mohammed." 786 F.3d at 736. Finally, after years of litigation, including remands and a rehearing *en banc*, the Ninth Circuit affirmed that a performance in an audiovisual work was uncopyrightable in isolation. *See id.* at 737 ("In light of . . . the Copyright Office's rejection of Garcia's application for a copyright in her brief performance, we conclude that the district court did not abuse its discretion in denying Garcia's request for the preliminary injunction."), *reversing Garcia v. Google, Inc.*, 766 F.3d 929 (9th Cir. 2014) (amending and superseding *Garcia v. Google, Inc.*, 743 F.3d 1258 (9th Cir. 2014), which affirmed *Garcia v. Nakoula*, 2012 WL 12878355, at *1 (C.D. Cal. Nov. 30, 2012)). The court after years of litigation supported the initial decision of the lower court and held that

"[b]ecause neither the Copyright Act nor the Copyright Office's interpretation supports Garcia's [copyright] claim, this is a hurdle she cannot clear." *Garcia v. Google, Inc.*, 786 F.3d at 744.

If the courts of the Ninth Circuit had followed the registration approach rather than the application approach, the Copyright Office's well-reasoned denial of Garcia's registration could have guided the litigation from the outset of the case, or even possibly prevented suit altogether. Similarly, in the case at hand, had the court been able to rely upon the copyright office's expert determination that Fourth Estate's copyrighted materials at issue were part of a compilation of materials and were not worthy of copyright protection, it is possible that this case may never have been brought or would have easily been dismissed. *Garcia* and the present case demonstrate how appropriate reliance on the Copyright Office's system of review for copyright quality can safeguard judicial resources and promote just outcomes.

B. Actual and potential defendants benefit from a registration approach that guards against unfounded and spurious claims.

A cease-and-desist letter or other threat of legal action may be distressing to some, but this is especially so for copyright claims against creators and educators without formal legal training or ample resources. Few members of creative communities are copyright

experts. Too often, when faced with facially plausible threats (perhaps on a lawyer's letterhead), they may forgo their right to be heard by a court on the understandable assumption that the copyright being asserted is a valid one. The resulting chilling effect can result in dubious "settlement" fees being paid, and in valuable works being withdrawn from public circulation. In one case, an entity fraudulently claimed to own the rights to an image and ceased to make legal threats only when presented with clear evidence that the creator was acting within her rights. Were the Court to uphold the registration approach, a creator would always be in a position to demand a certificate of copyright registration in defense of a threat of litigation and could further evaluate the situation in light of the response.

Amici who are professors and scholars may encounter special difficulties because they work within universities or depend on publishers to reach intended audiences. For them, the risk-aversion of institutional legal decision-makers can lead to valuable academic works being suppressed or modified. According to *amicus* Professor Peter Decherney, a leader in the use of new technology in higher education, "it is already difficult enough for a conscientious educator to navigate the requirements of copyright in developing online course materials; it would be immeasurably more difficult to operate under a Damoclean sword of instant litigation based on unverified claims" – *i.e.*, the application approach. *Amicus* Professor Steve Anderson reiterated that in his experience as an author and

journal editor, "uncertainty related to copyright leads to especially pernicious patterns of self-censorship, in which fearful or ill-informed scholars, creators[,] or presses will avoid potentially important subjects or lines of inquiry rather than risk even the remotest possibility of a legal challenge."

Additionally, the application approach would allow malicious parties to continue to prey on creators with threats of legal action without owning a valid copyright. Requiring expert pre-litigation scrutiny by the Copyright Office will help prevent meritless threats from entities purporting to be legitimate rights holders. Adherence to the registration approach, by contrast, will help check this phenomenon of "copyright trolling," in which a business not engaged in producing creative works nevertheless acquires and asserts interests in purported copyrights for the primary purpose of securing settlements. Collectively, these bad actors have brought litigation against hundreds or thousands of individuals, demanding monetary damages for claims that may reflect little in the way of copyright quality. *See Third World Media, LLC v. Does 1-1568*, No. C 10–04470 LB, 2011 WL 4344160 (N.D. Cal. Sept. 15, 2011); *see also Combat Zone, Inc. v. Does 1-1037*, No. 3:10-cv-0090 (N.D.W. Va. Jan. 3, 2011). In 2013, multi-defendant *John Doe* cases were the majority of the copyright cases filed in 19 of the 92 federal districts. *See* Matthew Sag, *Copyright Trolling, An Empirical Study*, 100 Iowa L. Rev. 1105, 1108 (2015). One such entity was ordered to pay $116,718 for bringing suit without standing; in another case, the same

company was ordered to pay over $225,000 in legal fees and at least one $5,000 sanction for misleading the court. *See Righthaven, LLC v. DiBiase*, No. 2:10-cv-01343, 2011 WL 5101938, at *12 (D. Nev. Oct. 26, 2011); *see also Righthaven, LLC v. Democratic Underground*, 791 F. Supp. 2d 968, 973 (D. Nev. 2011).

There are other copyright disputes, however, where unfounded claims are not contested, and therefore, go unchecked. Interpreting Section 411(a) to require a final decision from the Copyright Office creates a significant speed bump for such spurious or misleading claims. The registration approach promotes fairness between the parties by reducing structural advantages that operate to the copyright trolls' advantage. More generally, under the registration approach favored by *amici*, the presence or absence of copyright registrations (as well as the details of any such registrations) would help inform the choices of those facing threats of a potential infringement litigation, whether from good-faith (but perhaps misinformed) claimants or from copyright trolls.

C. Creators and educators also benefit from the registration approach because a screening process provides clarity to those seeking to safeguard their rights.

The registration approach also benefits creators and educators, such as the *amici*, when seeking copyright protection of their works. Throughout the registration process, in ways that range from general

guidance to individualized correspondence, the Copyright Office assists applicants to clarify and improve their claims and develop more accurate and effective registrations. Individual creators' *quid pro quo* for participating in mandatory pre-litigation review is that, by the time a certificate of registration has been issued, they will have valuable information about the scope and strength of their rights. For example, a musical creator who makes use of digital samples from other recordings may be required in the course of the registration process to confine the description of an original composition to his or her own individual contributions. Likewise, the editor of a new scholarly edition may be asked to restrict his or her claim to the introduction, notes, and other original aspects of the scholarly apparatus, as distinct from the underlying public domain text. Such limitations can enhance the quality of the application where issues of both copyrightability and ownership are concerned. This kind of expert guidance ultimately enhances the copyright owner's likelihood of success in negotiations or litigation with infringers.

In turn, the *prima facie* presumption of validity conferred by a certificate of registration, 17 U.S.C. § 410(c) (2018), reflects the value that participation in the registration process confers on rights holders. The statute thus shifts the burden of proof to the alleged infringers, forcing them to rebut the Copyright Office's expert opinion. *See S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1085 (9th Cir. 1989). Once the Copyright Office has issued its certificate, a creator with limited

resources may feel more empowered to assert his or her infringement claim in court.

D. The general public benefits from institutions that support copyright quality.

All members of the public, including *amici*, constantly interact with and consume actually or potentially copyrighted works. By the same token, this Court consistently has recognized the importance of assuring fairness in public access to uncopyrightable content to best "encourage others to build freely upon the ideas and information conveyed by a work" and to uphold "the essence of copyright." *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 349 (1991). *Feist*, in which this Court unanimously expressed a strong constitutional policy favoring access to public domain material, was a dispute over the appropriate protection of an informational compilation – as is the present case. But, copyright quality matters for all kinds of works and to everyone who wishes to exercise their rights as citizens while acting in accordance with the law.

This Court has recognized that institutional support for copyright quality makes an important contribution to achieving the aims of a balanced copyright system. *See Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1991) ("Because copyright law ultimately serves the purpose of enriching the general public through access to creative works, it is peculiarly important that the law's boundaries be demarcated as clearly as

possible."). The Copyright Office's expertise serves this public interest in copyright quality by informing the courts when they decide issues of copyrightability and encouraging the creation of guidance documents that mark the metes and bounds of copyright protection more clearly before litigation.

CONCLUSION

The registration approach allows the Copyright Office to provide Congress, the courts, parties, and the general public a pre-litigation screening process to promote copyright quality and eliminate uncertainty for all creators and educators who seek federal copyright protection. Therefore, this Court should affirm the Eleventh Circuit holding that registration occurs after a final decision by the Copyright Office.

Respectfully submitted,

PETER JASZI
Counsel of Record
HILLARY BRILL
GLUSHKO-SAMUELSON INTELLECTUAL PROPERTY LAW CLINIC
WASHINGTON COLLEGE OF LAW
AMERICAN UNIVERSITY
4300 Nebraska Ave. NW
Washington, DC 20016
(202) 274-4148
pjaszi@wcl.american.edu
Counsel for Amici Curiae

October 18, 2018

No. 17-571

IN THE

Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,

v.

WALL-STREET.COM, LLC AND JERROLD D. BURDEN,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals for the Eleventh
Circuit

BRIEF OF AUTHORS GUILD AND OTHER ARTISTS' RIGHTS ORGANIZATIONS AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

MARY E. RASENBERGER
CHERYL L. DAVIS
AUTHORS GUILD
31 East 32nd Street
New York, N.Y. 10016
(212) 563-5904

ELEANOR M. LACKMAN
Counsel of Record
LINDSAY W. BOWEN
LINDSAY R. EDELSTEIN
COWAN DEBAETS ABRAHAMS
& SHEPPARD LLP
41 Madison Avenue,
38th Floor
New York, N.Y. 10010
(212) 974-7474
elackman@cdas.com

September 4, 2018

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES iii

INTEREST OF *AMICI CURIAE* 1

SUMMARY OF ARGUMENT 3

ARGUMENT 5

I. THE COURT SHOULD CONSTRUE THE STATUTE IN ACCORDANCE WITH THE PURPOSES OF THE COPYRIGHT ACT AND THE ACT'S PLAIN TEXT 5

A. Authors Depend on Copyright for Their Livelihood and to Protect Their Constitutional Rights 5

B. Plain-Text Reading of the Copyright Act Supports the Position that Authors, not the Copyright Office, Must Act to Register Works Before Suit 11

II. ADOPTING THE ELEVENTH CIRCUIT RULE WILL CAUSE SIGNIFICANT ECONOMIC HARDSHIP ON AND LOSS OF RIGHTS FOR AUTHORS 15

A. The Copyright Office Admits There Are Impediments to an Author's Ability to Timely Obtain a Registration Certificate 17

B. Authors Risk Losing the Indispensable Deterrents to Infringements: Statutory Damages and Attorneys' Fees 21

C. The Statute of Limitations and Copyright Office Processing Times Could Create a Risk of Authors Losing the Right to Enforce Copyright Rights Completely 24

D. Injunctive Relief Could Be Unavailable During the Most Crucial Period of Publication 24

III. WAITING ON ACTION FROM THE COPYRIGHT OFFICE IS NOT JUDICIALLY EFFICIENT 27

CONCLUSION 29

TABLE OF AUTHORITIES

Cases **Page(s)**

A & M Records Inc. v. Napster, Inc.,
239 F. 3d 1004 (9th Cir. 2001).....9

Agence France Presse v. Morel,
No. 10 Civ. 2730 (AJN), 2014 WL
3963124 (S.D.N.Y. Aug. 13, 2014).....14, 15

Am. Broad. Cos., Inc. v. AEREO, Inc.,
874 F. Supp. 2d 373 (S.D.N.Y. 2012) 25

Apple Barrel Prods., Inc. v. Beard,
730 F.2d 384 (5th Cir. 1984).....28

Arista Records, LLC v. Tkach,
122 F. Supp. 3d 32 (S.D.N.Y. 2015) 26

Broad. Music, Inc. v. Prana Hosp., Inc.,
158 F. Supp. 3d 184 (S.D.N.Y. 2016) 23

Broad. Music, Inc. v. R Bar of Manhattan, Inc.,
919 F. Supp. 656 (S.D.N.Y. 1996) 23

Bryant v. Media Right Prods.,
603 F.3d 135 (2d Cir. 2010) 21

Cosmetic Ideas, Inc. v. IAC/Interactivecorp.,
606 F.3d 612 (9th Cir. 2010).....24, 27, 28

Eldred v. Ashcroft,
537 U.S. 186 (2003).....6, 13

F.W. Woolworth Co. v. Contemporary Arts,
344 U.S. 228 (1952).....21, 22, 23

Feltner v. Columbia Pictures Television, Inc.,
523 U.S. 340 (1998).....21

Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC,
138 S. Ct. 2707 (2018).....19, 20

Getty Images (US), Inc. v. Virtual Clinics,
No. C13-0626 (JLR), 2014 WL 1116775
(W.D. Wash. Mar. 20, 2014) 26

Golan v. Holder,
565 U.S. 302 (2012).....13

Gonzales v. Transfer Techs., Inc.,
301 F.3d 608 (7th Cir. 2002).....23

Harper & Row Publishers, Inc. v. Nation Enters.,
471 U.S. 539 (1985).....6

Hounddog Prods., L.L.C. v. Empire Film Grp., Inc.,
826 F. Supp. 2d 619 (S.D.N.Y. 2011) 26

Iconbazaar, L.L.C. v. Am. Online, Inc.,
308 F. Supp. 2d 630 (M.D.N.C. 2004) 28

International Kitchen Exhaust Cleaning Ass'n. v. Power Washers of N. Am.,
81 F. Supp. 2d 70 (D.D.C. 2000).....16

Kernel Records Oy v. Mosley,
694 F.3d 1294 (11th Cir. 2012).....28

Kirtsaeng v. John Wiley & Sons, Inc.,
568 U.S. 519 (2013).....14

La Resolana Architects, PA v. Clay Realtors Angel Fire,
416 F.3d 1195 (10th Cir. 2005).....10, 24

Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.,
315 F. Supp. 2d 1053 (C.D. Cal. 2004).....16

Mazer v. Stein,
347 U.S. 201 (1954).....7

Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.,
545 U.S. 913 (2005).....8, 9

Positive Black Talk, Inc. v. Cash Money Records, Inc.,
394 F.3d 357 (5th Cir. 2004).....27, 28

Ryan v. Carl Corp.,
No. 97 Civ. 3873 (FMS), 1998 WL 320817 (N.D. Cal. June 15, 1998) 17

SportsMEDIA Tech. Corp. v. Upchurch,
839 F. Supp. 8 (D. Del. 1993) 28

Tang v. Hwang,
799 F. Supp. 499 (E.D. Pa. 1992) 28

Tri-Marketing v. Mainstream Mktg. Servs., Inc.,
No. 09 Civ. 09-13 (DWF) (RLE), 2009 WL 1408741 (D. Minn. May 19, 2009) 28

U.S. v. Paramount Pictures, Inc.,
334 U.S. 131 (1948) 6

Warner Bros. Entm't Inc., v. WTV Sys., Inc.,
824 F. Supp. 2d 1003 (C.D. Cal. 2011) 25

Wilson v. Mr. Tee's,
855 F. Supp. 679 (D.N.J. 1994) 28

Rules & Statutes

17 U.S.C. § 408(a) 4, 13

17 U.S.C. § 410(d) 12

17 U.S.C. § 411(a) 4, 12

17 U.S.C. § 412 ..... 13, 14, 19, 22

17 U.S.C. § 502 ..... 24, 25

17 U.S.C. § 504 21

17 U.S.C. § 505 21

17 U.S.C. § 507 24

37 C.F.R. § 201.3(c) 15

37 C.F.R. § 202.16 15

Supreme Court Rule 37 1

Other Authorities

A Section White Paper: A Call for Action for Online Piracy and Counterfeiting Legislation, 2014 A.B.A. SEC. OF INTELL PROP. L. 10

Annual Report of the Register of Copyrights (2009) 10, 11, 28

AUTHORS GUILD, *The Wages of Writing: Key Findings from the Authors Guild* (2015) 6, 7

Doug Preston, *Why is it so Goddamned Hard to Make a Living as a Writer Today?*, AUTHORS GUILD BULLETIN (Spring/Summer 2017) 7

GRAPHIC ARTISTS GUILD, GRAPHIC ARTISTS GUILD HANDBOOK: PRICING & ETHICAL GUIDELINES (Graphic Artists Guild, 15th ed. 2018) 7

New Oxford American Dictionary (3d ed. 2010) 12

Policy Decision Announcing Fee for Special Handling of Applications for Copyright Registration, 47 Fed. Reg. 19,254 (May 4, 1982) 19

S. REP. NO. 105-190 (1998) 8

Targeting Websites Dedicated to Stealing American Intellectual Property: Hearing Before the S. Comm. on the Judiciary, 112th Cong. (2011) 8, 9

U.S. Copyright Office, "Registration Processing Times," https://www.copyright.gov/registration/docs/processingtimes-faqs.pdf 11, 17

William Landes and Richard Posner, *An Economic Analysis of Copyright Law*, 18 J. LEG. STUD. 325 (1989) 8

BRIEF OF AUTHORS GUILD AND OTHER ARTISTS' RIGHTS ORGANIZATIONS AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

Pursuant to Rule 37 of the Supreme Court of the Unites States, *amici curiae* The Authors Guild, Inc. and 12 other artists' rights organizations, respectfully submit this brief in support of the request of petitioner Fourth Estate Public Benefit Corporation, that the May 18, 2017 Order of the United States Court of Appeals for the Eleventh Circuit be reversed.[1]

INTEREST OF *AMICI CURIAE*

Founded in 1912, the Authors Guild, Inc. (the "Guild") is a national non-profit association of approximately 10,000 professional, published writers of all genres including periodicals and other composite works. The Guild counts historians, biographers, academicians, journalists, and other writers of nonfiction and fiction as members. The Guild works to promote the rights and professional interests of authors in various areas, including

---

[1] Pursuant to Sup. Ct. R. 37.6, *amici curiae* state that no counsel for any party authored this brief in whole or in part, and no party or counsel for any party made a monetary contribution intended to fund the preparation or submission of this brief. Only *amici curiae* made such a monetary contribution. The Clerk has noted Petitioner's and Respondents' blanket consent to *amicus curiae* briefs, dated July 24, 2018 and July 25, 2018, respectively, on the docket.

copyright, freedom of expression, and taxation. Many Guild members earn their livelihoods through their writing. Their work covers important issues in history, biography, science, politics, medicine, business, and other areas; they are frequent contributors to the most influential and well-respected publications in every field.

The Guild's members are the creators on the front line. They file registrations, police and enforce their intellectual property rights, send demand letters to those violating such rights – and, if all else fails – they seek intervention from the federal judiciary to enjoin infringers who violate the Copyright Act and to obtain just compensation for the fruits of their labor.

The various artists' rights organizations who join this brief support, and have an interest in the theory, law and practice of copyrights, property rights, and contracts.[2] The organizations have no other stake in the outcome of this particular case, but are interested in ensuring that copyright law

---

[2] The organizations are American Photographic Artists, American Society of Media Photographers, Dramatists Guild of America, Graphic Artists Guild, Horror Writers Association, National Association of Science Writers, National Press Photographers Association, North American Nature Photography Association, Professional Photographers of America, Science Fiction and Fantasy Writers of America, Songwriters Guild of America, Inc., and Textbook & Academic Authors Association. Their descriptions are included in the Appendix to this brief.

develops in a way that best promotes creativity, innovation and competition throughout the world.

SUMMARY OF ARGUMENT

As a matter of law and policy, the Court should interpret the Copyright Act in favor of a reading that supports authors (in the broad sense, including all creators and rightsholders). Such a reading is particularly important in an era where the ability to make a living as a creator is increasingly difficult, due in large part to widespread infringement, predominantly online, and the limited means available to curtail such infringement. As the incentives to create are diminished, so is society's ability to realize the fundamental goal of the Copyright Act: to foster creation and innovation in writing, the arts, and countless other forms of expression that benefit it as a whole.

While infringement has ballooned, so has the processing time of applications at the U.S. Copyright Office. It now can take up to 16 months for an online application and 28 months for a paper application.

Under an interpretation of Section 411(a) of the Copyright Act that requires authors to wait to enforce their rights until the Copyright Office has fully processed the registration of the infringed work, the delay can have a monumental impact on an author's ability to protect the fruits of her creative endeavors.

As Petitioner argues, under a correct reading of the Copyright Act, Section 411(a) is satisfied upon the filing of a complete application for registration. The language of the statute itself, particularly when read in conjunction with other provisions in the same chapter of the Act, including Sections 408, 410, and 412, clarifies that the date a registration is "made" is the date on which the complete application (with the deposit copy and fee) are deposited with the Copyright Office. A reading to the contrary would make Section 411(a) an outlier within Chapter 4 of the Copyright Act.

Such a contrary reading would cause hardships to authors, effectively barring them from the courthouse in many cases. An author may have to wait for well over a year from submission to pursue infringing activity. Even where expedited registration is possible, the filing fee of $800 per work is prohibitively expensive for many authors – especially if multiple works are infringed. As a result, an author may have to make the choice of spending more to register the infringed work than she was paid to create it, or of waiting without recourse for many months while her works continue to be infringed. Further, the "registration" interpretation forces an interpretation of other sections of the Copyright Act that curtail the ability of infringed authors to bring suit and be made whole, including to recover statutory damages and attorneys' fees, as well as injunctive relief.

This result cannot be what Congress intended when it required that "registration of the copyright claim [be] made" prior to filing a claim for infringement. As a matter of law and policy, the Court should rule in favor of finding that Petitioner's view is correct.

ARGUMENT

I. THE COURT SHOULD CONSTRUE THE STATUTE IN ACCORDANCE WITH THE PURPOSES OF THE COPYRIGHT ACT AND THE ACT'S PLAIN TEXT.

A. Authors Depend on Copyright for Their Livelihood and to Protect Their Constitutional Rights.

> "Literature is my Utopia. Here I am not disenfranchised. No barrier of the senses shuts me out from the sweet, gracious discourses of my book friends. They talk to me without embarrassment or awkwardness."
>
> HELEN KELLER, THE STORY OF MY LIFE (Dover Publications 2012) (1903).

> "Writing a book is a horrible, exhausting struggle, like a long bout of some painful illness."
>
> GEORGE ORWELL, WHY I WRITE (Penguin Books 2015) (1946).

The goal of copyright law in the United States, as enshrined in the Constitution, is "[t]o promote the Progress of Science and useful Arts." U.S. CONST. art. I, § 8, cl. 8. The Copyright Act achieves this goal by creating economic incentives for authors (including writers, dramatists, photographers, and other artists, like the members of *amici*), to release the products of their creative endeavors to the public. *See Eldred v. Ashcroft*, 537 U.S. 186, 212 n.18 (2003) ("[C]opyright law serves public ends by providing individuals with an incentive to pursue private ones."); *see also Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985) ("By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas."); *U.S. v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948).

The life of a creator is not easy. Aside from the deadlines, writer's block, and constant scrutiny – authors face an uphill battle to make sustainable wages. For example, a 2015 Authors Guild study shows that the average income of a full-time writer decreased 30% from 2009 to 2015: from $25,000 a year, to $17,500. *See* THE AUTHORS GUILD, The *Wages of Writing: Key Findings from the Authors Guild* (2015), https://www.authorsguild.org/industry-advocacy/the-wages-of-writing/. Specifically, full-time writers with more than 15 years of experience saw a 67% drop from $28,750 a year to $9,500; part-time authors saw a 38% decrease in the average

income, from $7,500 a year to $4,500. *Id.* Creators in other genres do not fare much better. Comparing salary statistics (adjusted for inflation) shows that salaries for illustrators have remained stagnant for the fifteen years from 2003 to 2018. GRAPHIC ARTISTS GUILD, GRAPHIC ARTISTS GUILD HANDBOOK: PRICING & ETHICAL GUIDELINES (Graphic Artists Guild, 15th ed. 2018).

The stagnating and even plummeting incomes of creators "is not a problem. It's not even a crisis. It's a catastrophe . . . [and when a creator] can't make a living and switches to working in another field, an entire lifetime" of works are never made.[3]

The Founders realized that the intellectual and artistic labor of such creators was crucial to the nation, but that without the protection of legal remedies, there was little incentive for them to pursue their crafts. *See Mazer v. Stein*, 347 U.S. 201, 219 (1954) ("The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and the useful Arts.'"). This is in part because financially successful creative works are often brought forth

---

[3] Doug Preston, *Why is it so Goddamned Hard to Make a Living as a Writer Today?*, AUTHORS GUILD BULLETIN (Spring/Summer 2017), https://www.authorsguild.org/the-writing-life/why-is-it-so-goddamned-hard-to-make-a-living-as-a-writer-today/.

only intermittently over lifetimes spent honing craft. For every successful creative endeavor, there are innumerable failures, all requiring equal hardships.

While creative work comes at a high cost for authors, it can be stolen by copyright infringers at bargain prices. *See Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 961 (2005) ("deliberate unlawful copying is no less an unlawful taking of property than garden-variety theft"); William Landes and Richard Posner, *An Economic Analysis of Copyright Law*, 18 J. LEG. STUD. 325, 326 (1989) ("While the cost of creating a work subject to copyright protection – for example, a book, movie, song, ballet, lithograph, map, business directory, or computer software program – is often high . . . once copies are available to others, it is often inexpensive for these users to make additional copies."); S. REP. NO. 105-190 at 8 (1998). Copyright law attempts to correct this imbalance by placing a heavy financial and legal risk on such infringers.

As the former president of the Authors Guild, Scott Turow, has put it, copyright law has been one of history's greatest public policy successes for over 300 years, because the markets created by copyright laws "have for hundreds of years encouraged authors here and abroad to spend countless hours writing books that they hope readers will value and the marketplace will reward." *Targeting Websites Dedicated to Stealing American Intellectual Property:*

Hearing Before the S. Comm. on the Judiciary, 112th Cong. 7-9 (2011) (testimony of Scott Turow, President of the Authors Guild).

But the statutory balance has tipped away from authors in recent years. The sinister downside of the digital era's exponential advancements in information distribution is that not only has the marginal cost of infringement come down to almost nothing, but the speed at which such theft can take place has become the mirror image of long-toiling author. *See Grokster*, 545 U.S. at 923; *A & M Records Inc. v. Napster, Inc.*, 239 F. 3d 1004, 1019 (9th Cir. 2001).

For example, the combination of the proliferation of e-books and the speed at which print books also can be obtained online has sped up the market for new books. Many books can even be ordered prior to their publication date and received on the publication date. At the same time, the prevalence of e-books has made it easier to illegally copy books. Counterfeit copies can be made in the blink of an eye, creating a multitude of new counterfeit markets, which are growing every day.

As another example, a photojournalist has the capability to transmit an image within moments of taking it. These images – which may document events of great national and international importance, including political campaigns, wars, breaking news and sports – are easily infringed.

Because of the enormous public appetite in the subject matter, within seconds of its creation, such an image may be downloaded and unlawfully re-posted many times, becoming "viral" – and virally infringed – in short order.

This digital revolution has had a measurable effect not only on authors' incomes, but also on the entire economy. It is estimated by various government and private sector experts that intellectual property theft – including U.S.-produced digital content such as music, film, photography, and books (the types of works produced by members of the *amici*) – costs the U.S. economy over $100 billion per year. *See A Section White Paper: A Call for Action for Online Piracy and Counterfeiting Legislation*, 2014 A.B.A. SEC. OF INTELL PROP. L., *available at* http://perma.cc/9GCY-3D3D.

It is in this context that the Respondents' arguments and the decision below of the Eleventh Circuit, along with a similar decision of the Tenth Circuit, *see La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10th Cir. 2005) *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010), are pernicious. Because as the time to publish, distribute, purchase and consume both legitimate and infringing copies of works has vastly accelerated, the time required for the Copyright Office to process authors' registrations has ballooned. Processing times have gone from an

average of 82 days in 2005 to an average of seven to 16 months in 2018. U.S. Copyright Office, *Annual Report of the Register of Copyrights* 47 (2009), *available at* https://www.copyright.gov/reports/annual/2009/ar2020.pdf ("2009 Annual Report"). *See also* U.S. Copyright Office, "Registration Processing Times" (reporting average processing times of 7 to 16 months of registration materials), https://www.copyright.gov/registration/docs/processingtimes-faqs.pdf.

Indeed, in the case *sub judice*, the Copyright Office took the upper range of those averages, 16 months, to act on Petitioner's registration. *See* U.S. Inv. Br. App. 3a-4a. Such delays are dangerous for authors whose livelihoods depend on time-sensitive copyright remedies.

B. Plain-Text Reading of the Copyright Act Supports the Position that Authors, not the Copyright Office, Must Act to Register Works Before Suit.

"Hell is truth seen too late."

> THOMAS HOBBES, LEVIATHAN (Oxford University Press 1996) (1651).

The members of *amici*, many of whom are writers and are habitually concerned with words, note that the issue in the case revolves around the

interpretation of the language in the Copyright Act, setting forth as a prerequisite for an infringement lawsuit that, "registration of a copyright claim has been made." 17 U.S.C. Section 411(a). Does it require, as Petitioner and *amici* argue, that the *author* has made a registration (*i.e.*, filed a complete application), or instead, as Respondents argue, does it require that the *Copyright Office* has completed processing of that registration and issued a registration certificate?

Amici agree with Petitioner that the word "registration" normally can refer either to the action of a registrant or a registrar. *See, e.g.*, New Oxford American Dictionary 1470 (3d ed. 2010) (definition of "registration" as "the action or process of registering or of being registered"). However, *amici* also note that Section 410 of the Act, entitled "Registration of Claim and Issuance of Certificate" resolves the quandary by unambiguously stating that the effective date of registration is when the application is received in the Copyright Office. 17 U.S.C. § 410(d).[4] Indeed, countless authors have long relied on such an interpretation.

---

[4] Section 410 further clarifies that authors do not have to wait for the Copyright Office to make a determination on the sufficiency of their filings, because a "court of competent jurisdiction" can determine that such materials were acceptable when they were deposited. *Id.*

That statutory text should be the end of the analysis. The Court has "stressed . . . that it is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause's objectives." *Eldred*, 537 U.S. at 212. Here, Congress has already spoken. Section 410(d) cannot be read to mean that the earlier date is the effective date for some purposes and not others, when it is clearly intended to establish the key date regarding registrations in all five consecutive Sections of the Act that address registration, Sections 408 through 412.

For example, Section 408, the section that defines copyright registration, does not refer to any requirement that the Copyright Office approve an application or materials. 17 U.S.C. § 408(a). It simply states that registration is an author's submission of the application, deposit, and fee (and makes clear that registration is not a condition of copyright protection). *Id.*

Like Section 411, Section 412 makes registration (or preregistration) a prerequisite – but for certain remedies, rather than for the ability to bring a suit. Specifically, registration must be made prior to the infringement of a work or within three months of its publication to be eligible for an award of statutory damages and attorney's fees. 17 U.S.C. § 412. Like Section 411, this reflects Congress's goal of encouraging registration. *Golan v. Holder*, 565 U.S. 302, 314 n.11 (2012). But for authors, this language

also allows flexible access to the most invaluable economic tools that protect the results of their labor.

Section 412's exception, or grace period, specifically refers to Section 410's "effective date" rule – meaning that the act required within three months is a completed application by the author. *See* 17 U.S.C. §§ 412 & 412(2). This interpretation of Section 412 is consistent with canons of statutory interpretation, well-established policy goals, and the expectations of the industry and all parties involved. Indeed, neither the Copyright Office nor any court has ever adopted a contrary rule that the Copyright Office must have processed the application.

However, because the nearly identical language in Sections 411 and 412 should be interpreted the same way, Respondents' reading of Section 411 creates tension with this universally-accepted interpretation of Section 412. *See Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 536 (2013) (presuming that a statutory phrase "carr[ies] the same meaning when [it] appear[s] in different but related sections").

Under such a reading of Section 412, (again, which no court has adopted or should adopt), it would be impossible for claimants to take advantage of the three-month grace period, since, as demonstrated *supra* p. 11, it takes an average of seven to 16 months to receive a registration certificate, longer than the three months that would

be allowed for registration to "be made." *See Agence France Presse v. Morel*, No. 10 Civ. 2730 (AJN), 2014 WL 3963124, at *13 (S.D.N.Y. Aug. 13, 2014) (awarding significant statutory damages where plaintiff submitted registration materials within the three-month safe harbor). This would effectively strike the grace period, robbing authors of the most powerful protections and remedies available to them (*see infra* pp. 21-24).

Preregistration is not a solution to these problems. Only specified works – for example, advertising or marketing photographs – can be preregistered. *See* 37 C.F.R. § 202.16. Furthermore, preregistration is meant to be permissive, not mandatory. If this Court adopts the Eleventh Circuit's approach, costly preregistration will effectively become mandatory, which will add to the burden on authors to produce works. *See* 37 C.F.R. § 201.3(c) ($140 cost of pre-registration application, four times the standard fee).

II. ADOPTING THE ELEVENTH CIRCUIT RULE WILL CAUSE SIGNIFICANT ECONOMIC HARDSHIP ON AND LOSS OF RIGHTS FOR AUTHORS.

> "Estragon: Charming spot.
> (He turns, advances to front, halts facing auditorium.) Inspiring prospects. (He turns to Vladimir.) Let's go.

> Vladimir: We can't.
> Estragon: Why not?
> Vladimir: We're waiting for Godot."
>
> SAMUEL BECKETT, WAITING FOR GODOT (Grove Press 2011) (1952).
>
> "I imagined a labyrinth of labyrinths, a maze of mazes, a twisting, turning, ever-widening labyrinth that contained both past and future and somehow implied the stars."
>
> JORGE LUIS BORGES, THE GARDEN OF FORKING PATHS (Penguin 2018) (1941).

Any bar to the courthouse doors that does not center on the actions of authors themselves, and depends on the timing of bureaucratic action entirely outside of their control, will cause significant economic hardship and the loss of rights for such authors. *See, e.g., International Kitchen Exhaust Cleaning Ass'n. v. Power Washers of N. Am.*, 81 F. Supp. 2d 70, 72 (D.D.C. 2000) (registrant approach: "To best effectuate the interests of justice and promote judicial economy, the court endorses the position that a plaintiff may sue once the Copyright Office receives the plaintiff's application, work, and filing fee."); *Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.*, 315 F. Supp. 2d 1053, 1056-57 (C.D. Cal. 2004) (registration certificate approach:

"The Court shares the sentiments of the *Ryan* court that, while this is an 'inefficient and peculiar result,' 'the Court is not free to redraft statutes to make them more sensible or just.'") (quoting *Ryan v. Carl Corp.*, No. 97 Civ. 3873 (FMS), 1998 WL 320817, at *3 (N.D. Cal. June 15, 1998)) (internal citation omitted).

A. The Copyright Office Admits There Are Impediments to an Author's Ability to Timely Obtain a Registration Certificate.

The Eleventh Circuit's decision effectively puts copyright owner's profits at the mercy of the Copyright Office, and its action – or failure to act – in response to registration materials submitted by such owners. It is no secret that Copyright Office resources are lacking, which, in turn, can lead to significant processing delays. Indeed, according to the Copyright Office, registration materials sent by mail can take up to 28 months to complete. *See* U.S. Copyright Office, "Registration Processing Times," https://www.copyright.gov/registration/docs/processingtimes-faqs.pdf. Web and email claims fare little better, taking up to 16 months. *Id.* For a struggling writer, photographer or other creator, losing out on the ability to enjoin an infringer for 16 or even 28 months would be a significant injury.

The Copyright Office advises that "processing times vary based on a number of factors, including how difficult a claim is to review, whether the

Copyright Office needs to correspond with an applicant, and the number of registration specialists available to review claims." *Id.* All of these factors are out of the control of the claimant. The "difficulty" of a claim can depend on factors included, but not limited to, the age of the work, whether the work has chain of title issues, and whether the work is part of a group registration.

A significant number of registrations get caught up in communications between the examining division and the registrant. According to one photographer, the entire cycle back and forth can take months, if not significantly longer.

For example, once a registrant submits all of the required registration materials, she may not hear back from the Copyright Office for many months, or even years. When she does hear back, the communication might be a question relating to the registration, or the materials contained therein. Once supplemental materials are submitted to the Copyright Office in response to the query, it can take many additional months to even hear back from the Copyright Office again.

Indeed, the delays in many cases are due to reasons that the drafters of the statute could never have contemplated, and the delays are unjustified when their consequences are weighed. For example, one member of *amici* calculated that the average time it took for the Copyright Office to process each

of her 276 registrations was 297 days. Those 297 days represent the amount of time an infringer could have exploited this creator's work without her being able to enjoin infringement, time that she lost from the three-year statute of limitations for infringement, and more days than the grace period Section 412 allows.

The vagaries of the normal process of registration, under Respondents' reading, would force every author to use what the Copyright Office intended to be an optional expedited registration process. *See* Policy Decision Announcing Fee for Special Handling of Applications for Copyright Registration, 47 Fed. Reg. 19,254, 19,254 (May 4, 1982). As an initial matter, the fee, $800, is many times higher than that of a "normal" registration, and is prohibitively expensive for many authors, especially those who create and must register multiple works in any given period due to the nature of their medium (*e.g.*, photography, weblogs). While Respondents suggest that such a fee is low, *see* Brief of Respondents-Appellees at 7, *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 138 S. Ct. 2707 (2018) (No. 17-571), considering that even full-time writers average $17,500 a year, this sum cannot be taken for granted for *amici* and other creators. Moreover, the process of filing an expedited registration can be as difficult as the garden variety registration.

Respondents claim "[t]he $800 special handling fee, however, is a pittance compared to the cost of litigating a copyright action in federal court." *Id.* But that is not a reason to saddle authors with an additional $800 they can ill afford. Indeed, the fact that federal copyright litigation generally costs far more than the value of any given infringement – and prevents many authors from bringing suit – is why *amici* support legislation to create a Small Copyright Claims tribunal as proposed in a bill introduced in the House of Representatives on October 4, 2017. The bill would provide an alternative forum for lower-value copyright claims, with a total cap on liability of $30,000 in any one proceeding. There also would be no fee-shifting; the parties would bear their own costs, and representation by a lawyer would not be necessary.

Another factor Respondents do not consider when characterizing $800 as a "pittance," is the number of expedited registrations some creators need to file for certain works. While there are many authors who may take long periods of time to create single works, photographers can take thousands of photographs in a day. For example, a photographer may take between 1,500 to 5,000 photographs at a single photo shoot, yet only receive $250 as payment for taking the photographs.

This day rate is already less than the cost of one expedited registration. But if a photographer

discovers that an infringer has used more than one of her unregistered photographs taken in different years, she would be forced to pay $800 per expedited registration, more than she was paid to take the photographs in the first place.

B. Authors Risk Losing the Indispensable Deterrents to Infringements: Statutory Damages and Attorneys' Fees.

Creating an obstacle to recovery of statutory damages and attorneys' fees – which are indispensable deterrents against infringers – would blunt or remove the most effective arrows in a wronged author's quiver. 17 U.S.C. §§ 504-05. *See F.W. Woolworth Co. v. Contemporary Arts*, 344 U.S. 228, 232 (1952); *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 352-53 (1998) ("an award of statutory damages may serve purposes traditionally associated with legal relief, such as compensation and punishment"); *Bryant v. Media Right Prods.*, 603 F.3d 135, 144 (2d Cir. 2010) (in calculating statutory damages awards courts should consider, *inter alia*, "the deterrent effect on the infringer and third parties").

Based on rules of statutory construction that similar language should be read uniformly in related sections of a statute, there is a risk that – should this Court affirm the Eleventh Circuit's decision in holding that Section 411 requires the Copyright Office to have issued a registration certificate – the

interpretation of Section 412 could be impacted as well.

Because it is the rare instance when a registration decision is made by the Copyright Office within three months of being filed, and the highest demand, and thus the appearance of piracy, generally occurs immediately after a work is released to the public, most works will be infringed before a registration issues – due to no fault of the author. Yet, such authors, like *amici*, would lose millions in statutory damages, as well as attorneys' fees. Moreover, as described above, the removal of attorneys' fees for infringements in this crucial post-publication time period would effectively close the courthouse doors for many authors and creators.

In *F.W. Woolworth Co.*, the Supreme Court discussed the policy underpinning statutory damages, stating:

> [A] rule of liability which merely takes away the profits from an infringement would offer little discouragement to infringers. It would fall short of an effective sanction for enforcement of copyright policy. The statutory rule, formulated after long experience, not merely compels restitution of profit and reparation for injury but also is designed to discourage wrongful

> conduct. The discretion of the court is wide enough to permit a resort to statutory damages for such purposes. Even for uninjurious and unprofitable invasions of copyright the court may, if it deems it just, impose a liability within the statutory limits to sanction and vindicate the statutory policy.

344 U.S. at 233, 73 S.Ct. 222. *See also Broad. Music, Inc. v. Prana Hosp., Inc.*, 158 F. Supp. 3d 184, 200 (S.D.N.Y. 2016) (citing *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 534 n. 19 (1994)) (explaining that a court may consider, *inter alia*, considerations of deterrence in awarding attorneys' fees); *Broad. Music, Inc. v. R Bar of Manhattan, Inc.*, 919 F. Supp. 656, 661 (S.D.N.Y. 1996) (awarding attorneys' fees to the prevailing parties after considering need for deterrence). In many cases, such damages and fees are the only factors that make a lawsuit even remotely cost-effective for authors. *See Gonzales v. Transfer Techs., Inc.*, 301 F.3d 608, 609-10 (7th Cir. 2002) ("willful infringements involving small amounts of money cannot be adequately deterred . . . without an award of attorneys' fees").

C. The Statute of Limitations and Copyright Office Processing Times Could Create a Risk of Authors Losing the Right to Enforce Copyright Rights Completely.

An even harsher result for authors could come from the application of the three-year statute of limitations in cases where the registration process by the Copyright Office consumes much of the three-year period allotted. 17 U.S.C. § 507. While Congress intended for authors to have three years to investigate claims, prepare lawsuits, and perhaps to negotiate, in cases like that of Petitioner, that statute of limitations could be cut in half. *See Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 620-21 (9th Cir. 2010).

D. Injunctive Relief Could Be Unavailable During the Most Crucial Period of Publication.

Under the Eleventh Circuit's reading of the Act, other remedies, such as a temporary restraining order or a preliminary injunction, could be unavailable to authors who are waiting on the Copyright Office's action. 17 U.S.C. § 502. *See La Resolana*, 416 F.3d at 1204 ("Every remedy outlined in Title 17, including injunctions, is conditioned upon a copyright owner having registered the copyright.").

Such a delay in the availability of injunctive relief under 17 U.S.C. § 502 would harm authors. Historically, courts have been wary that failure to grant such relief, including on a preliminary basis, could create a *de facto* compulsory license to permit an infringer to continue to use copyrighted works and pay damages instead of ending infringing conduct altogether. This reasoning is rooted in the view that a copyright owner's exclusive rights by definition depend on the right to exclude, and that money damages are generally insufficient to compensate a copyright owner for harm caused by infringement. Forcing an author to watch without recourse while her work is infringed for months while awaiting the Copyright Office's action on a registration ignores the non-monetary dimension of the harms inherent in copyright infringement. Courts recognize that such harms include reputational damage to the author, damage to the author's relationships with legitimate copyright distributors, and that lost sales and profits are often difficult to calculate for monetary relief. *See, e.g., Am. Broad. Cos., Inc. v. AEREO, Inc.*, 874 F. Supp. 2d 373, 397-98 (S.D.N.Y. 2012)), *aff'd sub nom.*, 712 F.3d 676 (2d Cir. 2013), *rev'd and remanded on other grounds sub nom.*, 134 S. Ct. 2498 (2014) (damage to the plaintiff's ability to negotiate with advertisers because of a competitor's effect on ratings); *Warner Bros. Entm't Inc., v. WTV Sys., Inc.*, 824 F. Supp. 2d 1003, 1012 (C.D. Cal. 2011) (interference with

exclusive license agreements); *Getty Images (US), Inc. v. Virtual Clinics*, 2014 WL 1116775, at *6 (W.D. Wash. Mar. 20, 2014). As with monetary damages, delaying an author's vindication of her right to exclude others from use is especially damaging where the bulk of the public's interest is concentrated. *See, e.g., Hounddog Prods., L.L.C. v. Empire Film Grp., Inc.*, 826 F. Supp. 2d 619, 632-33 (S.D.N.Y. 2011).

Injunctive relief has come to the forefront for combatting infringement in the Internet age. Often, third party Internet providers, such as domain name registrars and content delivery networks that power and host anonymous scofflaw websites, are the only entities within the power of any court. These actors can only be reached by enforcing injunctions issued against the primary actors against them as well. *See, e.g., Arista Records, LLC v. Tkach*, 122 F. Supp. 3d 32, 39 (S.D.N.Y. 2015).

Respondents' view would ensure that willful infringers of otherwise timely-registered works could act with impunity without threat of injunctive relief during the most valuable part of a newly published work's sales cycle. Where such infringers were online, they could simply disappear before the Copyright Office finished processing the appropriate

registrations, having skimmed the cream from the work.[5]

III. WAITING ON ACTION FROM THE COPYRIGHT OFFICE IS NOT JUDICIALLY EFFICIENT.

By reversing the Eleventh Circuit's Order, and adopting the approach espoused by Petitioner, Nimmer, and the *amici*, this Court will cause federal courts to avoid unnecessary judicial labor and waste of resources.

Many courts adopting the "registrant" approach have recognized that "construing the statute this way leads to an inefficient and peculiar result[,]" as it "makes little sense to dismiss a case (which will likely be refiled in a matter of weeks or months) simply because the Copyright Office has not made a prompt decision that will have no substantive impact on whether or not a litigant can ultimately proceed." *Cosmetic Ideas, Inc.*, 606 F.3d at 620. *See also Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 366 (5th Cir. 2004) *abrogated by*

---

[5] As troubling as the delay for authors is the fact that infringers would be able to weaponize the infringement process by filing declaratory judgment actions during the period when authors could be blocked from bringing a counterclaim. This would not serve the law's objective to encourage timely registration because such a tactic could be employed even where the rights owner made immediate registration but was not yet issued a certificate.

Reed Elsevier, 559 U.S. at 154 ("technicalities should not prevent litigants from having their cases heard on the merits").

Moreover, to wait for the Copyright Office to issue a registration certificate would be putting form over substance. 97% of all claims are granted by the Copyright Office, and suits can be brought after such rejection. *See* 2009 Annual Report at 4. *See also Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1301 (11th Cir. 2012) (quoting *BUC Int'l Corp. v. Int'l Yacht Council Ltd.*, 489 F.3d 1129, 1142 (11th Cir. 2007)) ("[R]egistration (or a refusal of registration) of a United States work 'is a prerequisite for bringing an action for copyright infringement[.]'").

Finally, adopting the "registrant" approach will not lead to a greater burden on the judiciary. Circuits that have adopted the approach supported by *amici* have not seen a flood of meritless suits for registrations that are denied by the Copyright Office. *See Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 386-87 (5th Cir. 1984); *Cosmetic Ideas*, 606 F.3d at 620-21. District courts that have followed suit similarly have not seen a deluge of meritless suits. *See, e.g., Wilson v. Mr. Tee's*, 855 F. Supp. 679, 682-83 (D.N.J. 1994); *Tang v. Hwang*, 799 F. Supp. 499, 502-03 (E.D. Pa. 1992); *SportsMEDIA Tech. Corp. v. Upchurch*, 839 F. Supp. 8 (D. Del. 1993); *Iconbazaar, L.L.C. v. Am. Online, Inc.*, 308 F. Supp. 2d 630, 634 (M.D.N.C. 2004); *Tri-Marketing v. Mainstream Mktg. Servs., Inc.*, No. 09 Civ. 09-13 (DWF) (RLE), 2009 WL 1408741 (D. Minn. May 19, 2009).

CONCLUSION

The decision of the Eleventh Circuit should be reversed.

Respectfully submitted.

ELEANOR M. LACKMAN
Counsel of Record
LINDSAY W. BOWEN
LINDSAY R. EDELSTEIN
COWAN DEBAETS ABRAHAMS
& SHEPPARD LLP
41 Madison Avenue, 38th Floor
New York, New York 10010
(212) 974-7474
elackman@cdas.com

MARY E. RASENBERGER
AUTHORS GUILD
31 East 32nd Street
New York, New York 10016
(212) 563-5904

Counsel for Amici Curiae

September 4, 2018

APPENDIX

APPENDIX

This amicus brief is joined by the following artists' rights organizations:

APA. American Photographic Artists ("APA") is a trade association of more than 2,000 photographic professionals who promote professional practices, standards, and ethics in the photographic community.

ASMP. American Society of Media Photographers, Inc. ("ASMP") represents the interests of professional photographers whose photographs are created for publication and has approximately 7,000 members. It is the oldest and largest organization of its kind in the world.

GAG. Graphic Artists Guild ("GAG") is a national union of graphic artists dedicated to promoting and protecting the social, economic and professional interests of its members. GAG's members include graphic designers, web designers, digital artists, illustrators, cartoonists, animators, art directors, surface designers, and various combinations of these disciplines.

The Guild. The Dramatists Guild of America (the "Guild") is the only professional organization

promoting the interests of playwrights, composers, lyricists, and librettists writing for the stage. Established over eighty years ago for the purpose of aiding dramatists in protecting both the artistic and economic integrity of their work, the Guild continues to educate, and advocate on behalf of, its over 6,000 members. The Guild believes a vibrant, vital theater is an essential element of this country's ongoing cultural debate, and seeks to protect those individuals who write for the theater to ensure its continued success.

HWA. The Horror Writers Association ("HWA") is a non-profit organization dedicated to promoting and educating the public on the horror genre, as well as offering assistance and resources to writers within the genre. Founded in 1985, the organization has grown from a handful of influential writers to over 1,500 members in 27 countries. HWA also sponsors the annual Bram Stoker Awards for superior achievement in horror and dark fantasy, and hosts StokerCon each year, as well. For more information, please visit www.horror.org.

NANPA. North American Nature Photography Association ("NANPA") is a trade organization with approximately 2,300 members involved in all aspects of nature photography.

NASW. In 1934, a dozen pioneering science reporters established the National Association of Science Writers ("NASW"), at a meeting in New York.

They wanted a forum in which to join forces to improve their craft and encourage conditions that promote good science writing. The association was formally incorporated in 1955 with a charter to "foster the dissemination of accurate information regarding science through all media normally devoted to informing the public." Over the years, its officers have included both freelancers and employees of most of the major newspapers, wire services, magazines, and broadcast outlets in the country. Today, NASW has 2,290 members and 301 students. Above all, NASW fights for the free flow of science news.

NPPA. The National Press Photographers Association ("NPPA") is a 501(c)(6) non-profit organization dedicated to the advancement of visual journalism in its creation, editing and distribution. NPPA's approximately 6,000 members include television and still photographers, editors, students and representatives of businesses that serve the visual journalism industry. Since its founding in 1946, the NPPA has vigorously promoted and defended the rights of photographers and journalists, including intellectual property rights and freedom of the press in all its forms, especially as it relates to visual journalism. The submission of this brief was duly authorized by Mickey H. Osterreicher, its General Counsel.

PPA. The Professional Photographers of America ("PPA") is the largest and longest-standing nonprofit photography trade association with a 150-year history. It currently helps 30,000-plus professionals elevate their craft and grow their businesses with resources, protection, and education, all under PPA's core guiding principle of closing the gap between what photographers do as artists and entrepreneurs and what consumers want.

SFWA. Science Fiction and Fantasy Writers of America ("SFWA") is the national organization for professional authors of science fiction, fantasy, and related genres. Founded in 1965, SFWA is a non-governmental, California 501(c)(3) not for profit member organization. SFWA informs, supports, promotes, defends, and advocates for its 1,900 members, the majority of whom are professional freelance authors of novels and/or short fiction who have met the criteria for active membership: paid publication of one long or three short works meeting the organization's professional standards.

SGA. The Songwriters Guild of America ("SGA") is the nation's oldest and largest organization run exclusively by and for songwriters, with more than 5,000 members nationwide and over seventy-five years advocating for songwriters' rights. It is a voluntary association of songwriters, composers, and the estates of deceased members. SGA provides a variety of services to members, including contract

advice, copyright renewal and termination filings, and royalty collection and auditing to ensure that members receive proper compensation for their creative efforts. SGA's efforts on behalf of all U.S. songwriters include advocacy before regulatory agencies and Congress, and participating as amicus in litigation of significance to the creators of the American canon of popular music.

TAA. The Textbook & Academic Authors Association ("TAA") is the only nonprofit membership association dedicated solely to assisting authors of scholarly books, textbooks, and journal articles. Formed in 1987, the TAA has over 2,000 members, primarily consisting of authors or aspiring authors of scholarly books, textbooks, and academic articles. Many of the TAA's members serve on college or university faculties. TAA's mission is to support textbook and academic authors in the creation of top-quality educational and scholarly works that stimulate the love of learning and foster the pursuit of knowledge. TAA's activities including: organizing writing workshops on campuses throughout the United States; holding an Annual Authoring Conference; publishing a newsletter; running webinars; and maintaining a website and other resources to provide members with information on tax, copyright, and royalty matters. TAA also works to foster greater public appreciation of the importance of scholarly authors to education and to the advancement of knowledge.

No. 17-571

IN THE
Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,

v.

WALL-STREET.COM, LLC,
Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Eleventh Circuit

BRIEF OF *AMICUS CURIAE*
THE COPYRIGHT ALLIANCE
IN SUPPORT OF PETITIONER

J. Matthew Williams
Counsel of record
Eric J. Schwartz
Mitchell Silberberg &
Knupp LLP
1818 N St., NW, 7th Floor
Washington, DC 20036
Tel: (202) 355-7900
Email: mxw@msk.com

Counsel for Amicus Curiae

TABLE OF CONTENTS

Page

INTERESTS OF *AMICUS CURIAE* 1

SUMMARY OF ARGUMENT 4

ARGUMENT 7

I. The Better Reading Of The Statutory Language Favors The Application Rule. .. 7

II. The Certificate Rule Harms Authors And Other Copyright Owners. 10

III. The Application Rule Gives Congress' Objectives Effect. 19

IV. The Certificate Rule Is Not Necessary To Satisfy The Objective Of Allowing The Register Of Copyrights To Advise Courts In Infringement Actions. 23

V. The Policies Underlying The Copyright Act Favor The Application Rule. 27

CONCLUSION 29

TABLE OF AUTHORITIES

Page(s)

CASES

A & M Records Inc. v. Napster, Inc.,
239 F.3d 1004 (9th Cir. 2001).....11

Anton Sport, Inc. v. Monkey Boy Graphix Inc.,
No. CV 08-377-PHX-ROS, 2008 WL 11339089 (D. Ariz. July 22, 2008).....17

Application Sci. & Tech., LLC v. Statmon Tech. Co.,
No. 05 C 6864, 2006 U.S. Dist. LEXIS 35885 (N.D. Ill. Apr. 21, 2006).....17

Balzer & Assocs., Inc. v. Union Bank & Tr. Co.,
No. 3:09CV283-HEH, 2009 WL 1675707 (E.D. Va. June 15, 2009).....11

Cabell v. Zorro Prods. Inc.,
No. 5:15-cv-00771-EJD, 2018 WL 2183236 (N.D. Cal. May 11, 2018).....18

Coles v Wonder,
283 F.3d 798 (6th Cir. 2002).....20

Cosmetic Ideas, Inc. v. IAC/Interactive Corp.,
606 F.3d 612 (9th Cir. 2010).....6, 13, 14, 24

TABLE OF AUTHORITIES
(continued)

Page(s)

Data Gen. Corp. v. Grumman Sys. Support Corp.,
36 F.3d 1147 (1st Cir. 1994) 20

Eldred v. Ashcroft,
537 U.S. 186 (2003) 27

Epic Games, Inc. v. Altmeyer,
No. 08-CV-0764-MJR, 2008 WL 4853634
(S.D. Ill. Nov. 5, 2008) 12

Fourth Estate Pub. Benefit Corp. v. Wall-Street.com,
138 S. Ct. 2707 (2018) 23

Fourth Estate Pub. Benefit Corp. v. Wall-Street.com,
856 F.3d 1338 (11th Cir. 2017) 22

Gerig v. Krause Publ'ns, Inc.,
33 F. Supp. 2d 1304 (D. Kan. 1999) 13

Golan v. Holder,
565 U.S. 302 (2012) 9, 27

Harper & Row, Publishers, Inc. v. Nation Enters.,
471 U.S. 539 (1985) 12

TABLE OF AUTHORITIES
(continued)

Page(s)

Int'l Kitchen Exhaust Cleaning Ass'n. v. Power Washers of N. Am.,
81 F. Supp. 2d 70 (D.D.C. 2000).....10

La Resolana Architects, PA v. Clay Realtors Angel Fire,
416 F.3d 1195 (10th Cir. 2005).....11

Latin American Music Co. v. ASCAP,
642 F.3d 87 (1st Cir. 2011).....15

Lions Gate Films Inc. v. Does,
No. 2:14-cv-06033-MMM, 2014 WL 3895240 (C.D. Cal. Aug. 8, 2014).....12

Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.,
315 F. Supp. 2d 1053 (C.D. Cal. 2004).....10

Mazer v. Stein,
347 U.S. 201 (1954).....27

Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.,
545 U.S. 913 (2005).....11

Petrella v. Metro-Goldwyn-Mayer, Inc.,
134 S. Ct. 1962 (2014).....13

TABLE OF AUTHORITIES
(continued)

Page(s)

Reed Elsevier, Inc. v. Muchnick,
559 U.S. 154 (2010).....9, 11, 18, 19

Scepter, Inc. v. Metal Bulletin Ltd.,
165 F. Supp. 3d 680 (M.D. Tenn. 2016).....18

Sega Enters. Ltd. v. MAPHIA,
857 F. Supp. 679 (N.D. Cal. 1994).....12

Stuart Weitzman, LLC v. Microcomputer Res., Inc.,
542 F.3d 859 (11th Cir. 2008).....17, 18

Syntek Semiconductor Co. v. Microchip Tech.,
307 F.3d 775 (9th Cir. 2002).....23

Tavory v. NTP, Inc.,
495 F. Supp. 2d 531 (E.D. Va. 2007).....20

Torres-Negron v. J & N Records, LLC,
504 F.3d 151 (1st Cir. 2007).....20

Touchpoint Commc'ns., LLC v. Dentalfone, LLC,
No. 3:15-cv-05240-JRC, 2016 WL 524260
(W.D. Wash. Feb. 10, 2016).....18

TABLE OF AUTHORITIES
(continued)

Page(s)

Vacheron & Constantin-Le Coutre Watches, Inc. v. Bernus Watch Co., 260 F.2d 637 (2d Cir. 1958) 9

Williams v. Gaye, 885 F.3d 1150 (9th Cir. 2018) 20

STATUTES AND REGULATIONS

17 U.S.C.
- § 102 21
- § 408 21
- § 408(f)(2) 12
- § 408(f)(3) 13
- § 410 24
- § 410(b) 22
- § 410(c) 6, 15
- § 411(a) ..... *passim*
- § 411(c) 8
- § 412 ..... 6, 15, 22
- § 502 11
- § 504 15
- § 507 13
- § 508 ..... 6, 25
- § 512(g)(2) 19

37 C.F.R.
- § 201.3(c) 13
- § 201.3(d) 5, 25
- § 202.16 12

TABLE OF AUTHORITIES
(continued)

Page(s)

OTHER AUTHORITIES

BRUCE KELLER & JEFFREY CUNARD, COPYRIGHT LAW: A PRACTITIONER'S GUIDE (Keith Voelker, 2d ed. 2017) 19, 21

Copyright Alliance, *Letter from Keith Kupferschmid on U.S. Copyright Office Modernization Efforts and Appropriations* (Apr. 15, 2016), https://copyrightalliance.org/wp-content/uploads/2016/10/041516-Copyright-Alliance-Letter-USCO-Appropriations.pdf 3

Copyright Alliance, *Statement of Keith Kupferschmid before the House Admin. Comm. on Improving Customer Service for the Copyright Community* (Dec. 2, 2015), https://copyrightalliance.org/wp-content/uploads/2016/08/copyright_alliance_testimony_on_usco_it_systems_hearing_in_house_admin_com_dec_2_2015_0.pdf 3

Copyright Alliance, *Statement of Keith Kupferschmid before the House Comm. on Appropriations Subcomm. on Legislative Branch* (Apr. 17, 2018), https://copyrightalliance.org/wp-content/

TABLE OF AUTHORITIES
(continued)

Page(s)

uploads/2018/04/House-Leg-Branch-Appropration-Testimony.pdf 3

Copyright Alliance, *Statement of Keith Kupferschmid before the House Comm. on Appropriations Subcomm. on Legislative Branch* (May 3, 2017), https://copyrightalliance.org/wp-content/uploads/2017/05/House-Leg-Branch-Approp-hrg-testimony-May-20171.pdf 3

Copyright Alliance, *US Copyright Office Modernization*, https://copyrightalliance.org/policy/position-papers/copyright-office-modernization/ 3

Copyright Office Fees: *Notice of Proposed Rulemaking*, 83 Fed. Reg. 24,054 (May 24, 2018) 24

Form AO121, Report on the Filing or Determination of an Action or Appeal Regarding a Copyright, http://www.uscourts.gov/sites/default/files/ao121.pdf 25

H.R. REP. NO. 2419 (1956) 13

H.R. REP. NO. 94-1476 (1976) 8, 9, 14

TABLE OF AUTHORITIES
(continued)

Page(s)

2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (Matthew Bender 2018) 10, 16, 23, 26

9 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (Matthew Bender 2018), App. 15-153 8

I PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT (Aspen 2018) 10, 27

Press Release, Office of the United States Trade Representative, USTR Releases 2018 Special 301 Report on Intellectual Property Rights (Apr. 2018) 27

S. REP. NO. 85-1014 (1957) 13

S. REP. NO. 94-473 (1975) 8, 13

S. REP. NO. 105-190 (1998) 28

Statement of Marybeth Peters, The Register of Copyrights before the Subcommittee on Courts and Intellectual Property Committee on the Judiciary, United States House of Representatives, 105th Congress, 1st Sess., Sept. 11, 1997, No Electronic Theft (NET) Act of 1997 (H.R. 2265) 28

TABLE OF AUTHORITIES
(continued)

Page(s)

Supplementary Register's Report on the General Revision of the U.S. Copyright Law, H.R. Comm. Print, 89th Cong., 1st Sess. 124 (1965) 8

Trac Reports, Inc., *Fewer Copyright Infringement Lawsuits Filed* (2017), http://trac.syr.edu/tracreports/civil/483/ 25

U.S. Copyright Office, *Annual Report* (2017) 19, 25

U.S. Copyright Office, *Archive of Amicus Briefs*, https://www.copyright.gov/rulings-filings/briefs/ 25

U.S. Copyright Office, *Archive of Legal Filings*, https://www.copyright.gov/rulings-filings/411/ 25

U.S. Copyright Office, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf 2, 5, 26

U.S. Copyright Office, *Remedies for Copyright Small Claims*, https://www.copyright.gov/docs/smallclaims/ 16

TABLE OF AUTHORITIES
(continued)

Page(s)

U.S. GENERAL ACCOUNTING OFFICE, GAO/AFMD-83-113, IMPROVING PRODUCTIVITY IN COPYRIGHT REGISTRATION (1982) 4

United States District Courts: *National Judicial Caseload Profile*, http://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2018.pdf 26

INTERESTS OF *AMICUS CURIAE*[1]

The Copyright Alliance is a nonprofit, nonpartisan, 501(c)(4) membership organization dedicated to serving as the unified voice of the copyright community. It represents the interests of hundreds of thousands of individuals and organizations across the spectrum of copyright disciplines, including authors, photographers, performers, artists, software developers, musicians, journalists, directors, songwriters, game designers and many other individual creators. The Copyright Alliance also represents the interests of book publishers, motion picture studios, software companies, music publishers, sound recording companies, sports leagues, broadcasters, guilds, unions, newspaper and magazine publishers, and many more organizations.

The individual creators and producing organizations represented by the Copyright Alliance rely on copyright law to protect their originality, efforts, and investments in the creation and distribution of copyrighted works to the public for educational, commercial and entertainment purposes. Accordingly, Copyright Alliance members are frequently plaintiffs in copyright infringement

---

[1] No party or counsel for any party authored any part of this brief or made a monetary contribution intended to fund the preparation and submission of this brief. All parties consent to *Amicus* filing this brief.

cases and other cases involving copyrighted works, seeking to protect their ownership rights and investments. However, Copyright Alliance members are also frequently defendants in such cases. For that reason, they bring a balanced and experienced perspective to the issue presented.

Amicus has a particular interest in the resolution of the question presented in light of the lengthy pendency times for registration applications, which results from resource constraints and the lack of modernization of the Copyright Office and its information technology systems.[2] The Copyright Alliance has testified before multiple Congressional committees seeking to support the Copyright Office's efforts to modernize, increase its funding, and separate its own governance from that of the Library of Congress, whose interests and priorities frequently

---

[2] The Register acts on applications submitted online in cases where no additional correspondence is required between the Copyright Office and the applicants (approximately 66% of applications) within three to eleven months, seven months on average; paper applications without correspondence (approximately 3% of applications) take two to sixteen months, nine on average; web applications with correspondence (approximately 30% of applications) take three to sixteen months, nine on average; and paper applications with correspondence (approximately 2% of applications) take four to twenty-eight months, sixteen months on average. U.S. Copyright Office, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf.

do not align with those of the Copyright Office.[3] The Copyright Alliance applauds this Court's grant of *certiorari* here to resolve the split in the Courts of Appeals regarding whether 17 U.S.C. § 411(a) shuts the courthouse door on any plaintiff whose registration application has not yet been acted upon by the Register. An application of the statute consistent with its language and Congress' intent favors the Application Rule (*i.e.*, allowing a plaintiff

---

[3] *E.g.*, Copyright Alliance, *US Copyright Office Modernization*, https://copyrightalliance.org/policy/position-papers/copyright-office-modernization/ (last visited Aug. 24, 2018); Copyright Alliance, *Statement of Keith Kupferschmid before the House Comm. on Appropriations Subcomm. on Legislative Branch* (Apr. 17, 2018), https://copyrightalliance.org/wp-content/uploads/2018/04/House-Leg-Branch-Appropration-Testimony.pdf; Copyright Alliance, *Statement of Keith Kupferschmid before the House Comm. on Appropriations Subcomm. on Legislative Branch* (May 3, 2017), https://copyrightalliance.org/wp-content/uploads/2017/05/House-Leg-Branch-Approp-hrg-testimony-May-20171.pdf; Copyright Alliance, *Statement of Keith Kupferschmid before the House Admin. Comm. on Improving Customer Service for the Copyright Community* (Dec. 2, 2015), https://copyrightalliance.org/wp-content/uploads/2016/08/copyright_alliance_testimony_on_usco_it_systems_hearing_in_house_admin_com_dec_2_2015_0.pdf; Copyright Alliance, *Letter from Keith Kupferschmid on U.S. Copyright Office Modernization Efforts and Appropriations* (Apr. 15, 2016), https://copyrightalliance.org/wp-content/uploads/2016/10/041516-Copyright-Alliance-Letter-USCO-Appropriations.pdf. The Copyright Alliance also supported the Copyright Office for the Digital Economy Act and the Register of Copyrights Selection and Accountability Act of 2017.

to file suit once a complete application is submitted). Moreover, the Application Rule gives effect to the purposes of the Copyright Act, including by providing copyright owners with the ability to enforce their rights in timely and meaningful ways while maintaining incentives to register works and preserving the benefit to the lower courts of the Register's input in cases where she determines she should intervene.

SUMMARY OF ARGUMENT

The Application Rule (i) is the better application of the statutory text and history; (ii) avoids the significant harms that would be worked by the Certificate Rule (*i.e.*, requiring that Office action be completed prior to the filing of a complaint); (iii) preserves Congress' intent to incentivize submissions of application information and deposit copies; (iv) has no impact on the courts' access to advice from the Register of Copyrights; and (v) furthers Congress' objective of providing effective, enforceable, exclusive rights to copyright owners, so that they can pursue immediate relief for infringements.

In 1981, the Copyright Office took five to six weeks to issue or deny a registration certificate. U.S. GENERAL ACCOUNTING OFFICE, GAO/AFMD-83-113, IMPROVING PRODUCTIVITY IN COPYRIGHT REGISTRATION 1 (1982). And its leadership at that time acknowledged that even that processing period

was too long – something to strive to reduce. *Id.* Now, applications remain pending for many months, not weeks. U.S. Copyright Office, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf.

The current time for the Copyright Office to process an application (*i.e.*, seven months for an average online application and nine months for an average paper application) is far too extended for a copyright owner to wait for a certificate before filing a lawsuit. An author, especially a small business or individual creator, should not be forced to pay a steep administrative tax – which is approximately twenty times the normal fee, 37 C.F.R. § 201.3(d), and must be paid in addition to that fee – to expedite her application before filing suit against infringers. Even waiting two weeks for the Copyright Office to process an expedited application could result in massive infringement occurring before injunctive relief would become available. Fast-paced infringement in the digital environment often causes significant harm in very little time. Once she has submitted a complete registration application, bureaucratic processes should not stymie an author's efforts to protect her rights. This is especially true given that it is only U.S. authors, not foreign authors, who are shut out of court by the Certificate Rule. 17 U.S.C. § 411(a).

Congress' policy objectives of incentivizing the filing of registration applications – to populate the public catalogue of information concerning copyright

ownership and to provide deposit copies to the Library of Congress – are met by requiring the submission of a complete registration application prior to the filing of an infringement lawsuit. *Cosmetic Ideas, Inc. v. IAC/Interactive Corp.*, 606 F.3d 612, 620 (9th Cir. 2010). Congress intended other provisions of the Copyright Act to incentivize copyright owners to submit applications soon after the creation or publication of their works by, for example, conditioning the availability of statutory damages and attorney's fees on applying for registration prior to initiation of infringement and providing *prima facie* validity to the facts stated in a registration certificate with an effective date of five years from publication. *See* 17 U.S.C. §§ 410(c), 412. Those provisions remain in force under the Application Rule.

Moreover, for multiple reasons, the Application Rule preserves the Register's ability to advise the courts during infringement actions. For example, the Copyright Office, which intervenes in cases very infrequently, is notified by clerks of courts when plaintiffs file infringement lawsuits. 17 U.S.C. § 508. Thus, the Register, if she is inclined to have an opportunity to weigh in early during litigation, could simply expedite review of every application that is at issue in pending litigation. The cost to the Copyright Office for expediting applications is virtually non-

existent.[4] Or, if the Register chooses not to voluntarily expedite applications, courts could stay cases or rely on the doctrine of primary jurisdiction to create time to request advice from the Register.

The negligible benefits, if any, of the Certificate Rule pale in comparison to the countervailing harms it would cause. The underlying policies of the Copyright Act strongly favor adoption of the Application Rule.

ARGUMENT

I. The Better Reading Of The Statutory Language Favors The Application Rule.

As more fully articulated in the brief of Petitioner, the better reading of the statutory text favors the Application Rule because the applicable provision focuses on determining whether the applicant has taken all steps available to her to obtain a registration. Section 411(a) states: "[N]o civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim ***has been made*** in accordance with this title." Of course, the use of the passive voice in the provision begs the question of ***who*** must have made the registration. While section 411(a) does not itself expressly answer this question,

---

[4] *See* note 12, *infra* regarding the high fees applicants must pay associated with expedited registration.

other provisions within the Copyright Act – indeed, within the same section – refer to ***copyright owners*** making registrations. *E.g.*, 17 U.S.C. § 411(c) (emphasis added) (permitting an action for infringement of the copyright in "a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission" if, among other requirements, "***the copyright owner . . . makes registration*** for the work within three months after its first transmission.").

This reading is supported by the legislative history, which repeatedly references copyright owners making registrations. *E.g.*, H.R. REP. NO. 94-1476, at 157 (1976) ("Under the bill, as under the law now in effect, ***a copyright owner who has not registered his claim*** can have a valid cause of action against someone who has infringed his copyright, but he cannot enforce his right in the courts until ***he has made*** registration."); S. REP. NO. 94-473, at 139 (1975) (same); *Id.* at 135 ("[R]egistration of a claim of copyright in any work ... ***can be made voluntarily by 'the owner of copyright*** or of any exclusive right in the work' at any time during the copyright term."); *Supplementary Register's Report on the General Revision of the U.S. Copyright Law*, H.R. Comm. Print, 89th Cong., 1st Sess. 124 (1965), in 9 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, App. 15-153 ("***[H]e must register his***

claim before he can enforce his rights in the courts.").[5]

Opinions from this Court have similarly referred to copyright owners registering their works. *E.g.*, *Golan v. Holder*, 565 U.S. 302, 314 n.11 (2012) ("The Copyright Act retains . . . incentives for ***authors to register*** their works . . . ."); *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 171 (2010) (Ginsburg, concurring) (section 411(a) "***instructs authors to register their copyrights*** before commencing suit for infringement").

Given all of the foregoing, the better reading of the phrase "has been made" is "has been made by the applicant." After paying the fee, filing a proper registration form, and providing a deposit copy to the Copyright Office, there are no further actions an applicant can take to obtain a registration. Therefore, under the best application of the statute, the registration requirement is satisfied by filing a complete application. Moreover, as discussed further below, the Application Rule is consistent with Congress' intent and policy objectives relating to the

---

[5] The fact that Congress was acting to overturn the Second Circuit's *Vacheron & Constantin-Le Coutre Watches, Inc. v. Bernus Watch Co.*, 260 F.2d 637 (2d Cir. 1958), decision, which prevented plaintiffs from suing infringers after the Register's denial of an application, is further evidence that Congress did not want the actions of the Register to determine when, and whether, a plaintiff had access to the courts. *See* H.R. REP. NO. 94-1476, at 157.

practical impact the Certificate Rule would have on creators and copyright owners.

II. The Certificate Rule Harms Authors And Other Copyright Owners.

Courts on both sides of the divide have acknowledged that the Application Rule generates better policy outcomes. *See, e.g., Int'l Kitchen Exhaust Cleaning Ass'n. v. Power Washers of N. Am.*, 81 F. Supp. 2d 70, 72 (D.D.C. 2000) (following Application Rule: "To best effectuate the interests of justice and promote judicial economy, the court endorses the position that a plaintiff may sue once the Copyright Office receives the plaintiff's application, work, and filing fee."); *Loree Rodkin Mgmt. Corp. v. Ross-Simons, Inc.*, 315 F. Supp. 2d 1053, 1056-57 (C.D. Cal. 2004) (following Certificate Rule but calling it an "inefficient and peculiar result") (quoting *Ryan v. Carl Corp.*, No. C 97-3873 FMS, 1998 WL 320817, at *3 (N.D. Cal. June 15, 1998)).

Leading copyright commentators agree that the Application Rule is the better reading of the statute. 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][3][b][ii] (Matthew Bender 2018) ("Given that the claimant has submitted an application that has yet to be acted upon at that juncture has done all that she can do, and will ultimately be allowed to proceed regardless of how the Copyright Office treats her application, it makes little sense to create a period of 'legal limbo' in which suit

is barred."); I PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 3.15 (Aspen 2018) ("The application approach is the better rule."). In part, this conclusion stems from the needless and harmful impacts felt by copyright owners under the Certificate Rule. These harms include:

1. A temporary restraining order or preliminary injunction, *see* 17 U.S.C. § 502, would likely be unavailable to an author while she awaited action from the Register, which would be a problem despite the availability of expedited application processing. *See La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1204 (10th Cir. 2005), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) ("Every remedy outlined in Title 17, including injunctions, is conditioned upon a copyright owner having registered the copyright."); *Balzer & Assocs., Inc. v. Union Bank & Tr. Co.*, No 3:09CV283-HEH, 2009 WL 1675707, at *4-5 (E.D. Va. June 15, 2009) (dismissing request for injunctive relief due to lack of registration).[6]

Millions of infringing copies or performances of a work can take place in days, or even minutes. *See Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 923 (2005); *A & M Records, Inc. v.*

---

[6] *La Resolana Architects* and *Balzer*, to the extent they treated section 411(a) as a jurisdictional requirement, are inconsistent with this Court's later opinion in *Muchnick*.

Napster, Inc., 239 F.3d 1004, 1019 (9th Cir. 2001). Accordingly, even if a copyright owner makes registration of her work on the first day of publication, massive amounts of infringement can occur before she can obtain a registration certificate.

This problem is of unique concern in cases of pre-release piracy, where a work has not yet hit the legitimate market but is already being pirated at a rapid pace. *See, e.g., Sega Enters. Ltd. v. MAPHIA*, 857 F. Supp. 679, 689 (N.D. Cal. 1994) (injunction issued against, *inter alia*, online distribution of unreleased video games); *Lions Gate Films, Inc. v. Does*, No. 2:14-cv-06033-MMM, 2014 WL 3895240, at *2, 5-7 (C.D. Cal. Aug. 8, 2014) (injunction issued against online distribution of millions of copies of the unreleased movie "Expendables 3"); *Epic Games, Inc. v. Altmeyer*, No. 08-CV-0764-MJR, 2008 WL 4853634, at *6 (S.D. Ill. Nov. 5, 2008) (discussing the "immediate irreparable harm" caused by Defendant selling advanced copies of Plaintiff's copyrighted video game prior to the release of the game); *see also Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985) (involving infringement of biography of President Gerald Ford prior to its publication).

While some categories of copyrighted works are eligible for pre-registration, not all categories of works are. *See* 37 C.F.R. § 202.16 (covering, for example, only "advertising or marketing photographs," and not other photographs); 17 U.S.C. § 408(f)(2) (instructing Register to issue regulations

to define "class[es] of works that . . . had a history of infringement prior to authorized commercial distribution"). And, even if all works could be pre-registered, there is no purpose in slamming the courthouse door on authors who elect not to register prior to publication, which results in them having to file two applications, rather than one. *See* 17 U.S.C. § 408(f)(3) (requiring second registration application to be submitted "[n]ot later than 3 months after the first publication of a work preregistered . . ."); *see also* 37 C.F.R. § 201.3(c) (fee for pre-registration application is $140, four times the standard fee).

2. A plaintiff could lose her chance to sue entirely if the statute of limitations, 17 U.S.C. § 507, were to expire before the Register took action on an application. *Cosmetic Ideas*, 606 F.3d at 620-21. At least one court, *Gerig v. Krause Publ'ns, Inc.*, 33 F. Supp. 2d 1304, 1306 (D. Kan. 1999), has concluded that a case may be back-dated to the effective date of a registration for statute of limitations purposes, even if the case could not be filed until the limitations period technically ended. But there is no guarantee that such an equitable approach would become widespread.

In 1957, when Congress debated the statute of limitations period to include in a revision of the 1909 Copyright Act, Congress was considering a number of different lengths, ranging from one year to eight years. *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 (2014) (citing H.R. REP. NO. 2419, at 2

(1956)); *see generally* S. REP. NO. 85-1014 (1957). It is significant that a two-year statute of limitations was considered, and that Congress specifically chose three years to provide injured parties with enough time to commence actions. This implies that Congress did not believe that a two-year period was adequate.

In 1976, Congress decided to retain the three-year period because the 1957 legislation "represent[ed] a reconciliation of views." S. REP. NO. 94-473, at 146. Yet, in practice, the three-year statute of limitations, combined with adherence to the Certificate Rule, would often create a *de facto* two-year statute of limitations because applications often remain pending at the Copyright Office for a year or more.[7] As the Ninth Circuit stated, "[t]his result does not square well with § 410(d)'s mandate that an application's effective registration date should be the day that a completed application is received." *Cosmetic Ideas*, 606 F.3d at 620; *see also* H.R. REP. NO. 94-1476, at 157 (noting that section 410(d) was designed to "take[] account of the inevitable timelag between receipt of the application and other material and the issuance of the certificate . . . .").

3. Plaintiffs could lose access to evidence while they lack opportunity to pursue discovery. Witnesses could die; documents could be deleted or

---

[7] *See* note 2, *supra*.

destroyed; and memories could fade while a plaintiff awaited action by the Register.

4. Plaintiffs who have not submitted registration applications until the moment arrives to file lawsuits would frequently, although not always, already be precluded from seeking statutory damages and attorneys' fees, and, in some instances, would not receive any evidentiary benefit from the registration certificate. *See* 17 U.S.C. § 410(c) (denying *prima facie* weight to registrations not applied for within five years of publication); 17 U.S.C. § 412 (limiting availability of remedies where infringement began prior to the effective date of a registration certificate for unpublished works or prior to the effective date of a registration certificate for published works if the effective date is not within three months of publication). Given the cost of litigation, including the expense of proving actual damages and ill-gotten profits, 17 U.S.C. § 504, and that attorneys' fees are available to defendants regardless of the plaintiff's registration status of a work, *Latin American Music Co. v. ASCAP*, 642 F.3d 87, 90 (1st Cir. 2011), such plaintiffs are already at a disadvantage. Forcing them to pay an expedited fee or to wait months to sue makes matters even worse and could discourage the filing of meritorious claims, especially for individual creators of multiple, infringed works where the expedited registration fees can quickly overwhelm any possible economic returns in litigation.

As the Copyright Office itself has explained, such challenges have a big impact on individual authors and small businesses.[8]

> [W]hile a copyright owner may want to stop an infringement that has caused a relatively small amount of economic damage, that owner may be dissuaded from filing a lawsuit because the prospect of a modest recovery may not justify the potentially large expense of litigation. While the Act offers the possibility of statutory damages and attorney's fees, these benefits are not available in all cases and parties may not recover them until after the copyright owner has engaged in a long court battle that requires payment of significant up-front costs.[9]

U.S. Copyright Office, *Remedies for Copyright Small Claims*, https://www.copyright.gov/docs/smallclaims/.

---

[8] Owners of large portfolios of copyrighted works would also be harmed by the Certificate Rule, given the difficulties and costs associated with registering each work in such portfolios.

[9] The Copyright Alliance supports the Copyright Alternative in Small-Claims Enforcement (CASE) Act of 2017, which would create of a small claims board to be housed at the Copyright Office to help to alleviate some of these problems.

5. Authors who are U.S. nationals would be at a distinct disadvantage to authors who are foreign nationals, and who need not register their copyrighted works prior to filing suit in U.S. courts. *See* 17 U.S.C. § 411(a) (limiting registration requirement to "United States work[s]"); 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][1][b][ii]. This peculiar scenario, which resulted from Congress' approach to implementing the Berne Convention on the Protection of Literary and Artistic Works' prohibition on statutory formalities in 1989, *id.* at § 7.16[B][6][c], is less perplexing when the Application Rule allows U.S. authors into court after submitting completed applications.

6. Would-be plaintiffs would potentially be at a disadvantage to potential defendants, who, in some courts, could file for declaratory relief without regard to a work's registration status. *Compare Application Sci. & Tech., LLC v. Statmon Tech. Co.*, No. 05 C 6864, 2006 U.S. Dist. LEXIS 35885, at *2 (N.D. Ill. Apr. 21, 2006) (holding no registration required to seek declaration of non-infringement), and *Anton Sport, Inc. v. Monkey Boy Graphix Inc.*, No. CV 08-377-PHX-ROS, 2008 WL 11339089, at *1–2 (D. Ariz. July 22, 2008) (same), *with Stuart Weitzman, LLC v. Microcomputer Res., Inc.*, 542 F.3d 859, 863 (11th Cir. 2008), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) (requiring

registration).[10] Potential defendants would thereby gain a "leg up" in selection of the litigation's forum and the procedural posture of the case, in which the defendant and potential counterclaimant could be barred from filing compulsory counterclaims for months (potentially resulting in waiver of those claims). *See Touchpoint Commc'ns., LLC v. Dentalfone, LLC*, No. 3:15-cv-05240-JRC, 2016 WL 524260, at *4 (W.D. Wash. Feb. 10, 2016) (referring to an infringement claim as a compulsory counterclaim to a declaratory judgment complaint seeking a declaration of non-infringement); *Cabell v. Zorro Prods. Inc.*, No. 5:15-cv-00771-EJD, 2018 WL 2183236, at *17 n. 12 (N.D. Cal. May 11, 2018) ("The Court also notes that, because Defendants did not counterclaim for infringement, it may be that they have forever abandoned their ability to bring these claims."); *Scepter, Inc. v. Metal Bulletin Ltd.*, 165 F. Supp. 3d 680, 687 (M.D. Tenn. 2016) (citing *Meathe v. Ret*, 547 Fed. Appx. 683, 687 (6th Cir. 2013), which states that "a claim for infringement is a compulsory counterclaim in a suit for declaratory judgment of non-infringement.") (internal quotations omitted).

7. If a copyright owner informs an online service provider that user-uploaded content is infringing and the user disputes that assertion, the service provider may elect not to disable access to the

---

[10] *Stuart Weitzman* is, in part, inconsistent with this Court's opinion in *Muchnick*, which held that section 411(a) is not jurisdictional.

content if the copyright owner does not file a complaint against the infringer within fourteen business days. 17 U.S.C. § 512(g)(2). Under the Certificate Rule, the copyright owner might not be able to file a complaint within fourteen days, depending on whether the Register takes action on a pending application.

III. The Application Rule Gives Congress' Objectives Effect.

Congress adopted the requirement, embodied in section 411(a), that authors of U.S. works register those works before filing infringement actions, not to benefit defendants (*i.e.*, potential infringers), but instead to serve "broader public and governmental interests[.]" Brief for the United States as *Amicus Curiae* Supporting Vacatur and Remand, at 11, *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) (No. 08-103). Each of these public and governmental interests is given full effect by the Application Rule.

1. One purpose of section 411(a) is to incentivize depositing copies of works for the collection of the Library of Congress. BRUCE KELLER & JEFFREY CUNARD, COPYRIGHT LAW: A PRACTITIONER'S GUIDE § 5:3 (Keith Voelker, 2d ed. 2017) (citing legislative history). The estimated value of deposits received in 2017 was $40,821,089. U.S. Copyright Office, *Annual Report* 19 (2017) ("2017 Annual Report").

These deposits not only enable the Library to serve as the nation's leading archive of published works, but also provide valuable evidence in litigation. *See, e.g.*, *Williams v. Gaye*, 885 F.3d 1150, 1169 (9th Cir. 2018), *modified by* 895 F.3d 1106 (9th Cir. 2018) (discussing centrality of deposit copy in case involving alleged infringement of musical composition); *Coles v Wonder*, 283 F.3d 798, 802 (6th Cir. 2002) (where plaintiff's deposit copy was an attempt at recreating a work he allegedly created years earlier, he could not prove defendant could have accessed the work prior to creating the allegedly infringing work); *Data Gen. Corp. v. Grumman Sys. Support Corp.*, 36 F.3d 1147, 1161–62 (1st Cir. 1994), *abrogated in part by Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) (citing legislative history for the assertion that the "key purpose" of the deposit requirement "is to prevent confusion about which work the author is attempting to register"); *Torres-Negron v. J & N Records, LLC*, 504 F.3d 151, 163–64 (1st Cir. 2007) (concluding that a reconstruction, created without direct access to the original, "cannot constitute a 'copy' sufficient to satisfy the deposit copy requirement", and "[s]ubmission of a reconstruction with a copyright registration application results in an incomplete application"); *Tavory v. NTP, Inc.*, 495 F. Supp. 2d 531, 536 (E.D. Va. 2007), *affirmed by* 297 F. App'x 976 (Fed. Cir. 2008) (finding that the deposit requirement serves a "gatekeeping" and "evidentiary" function and that the "copies that are submitted . . . with an application for registration then become part

of a record by which claims of infringement are tested").

This purpose is fully vindicated by the Application Rule. So long as plaintiffs continue to file registration applications prior to filing lawsuits, as they must under the Application Rule, the Library will continue to receive deposits for its collections and litigants and courts will continue to have access to deposit copies during litigation. Indeed, the Certificate Rule could actually decrease the number of applications filed and deposits submitted because copyright owners might elect not to enforce their rights at all if they cannot pursue enforcement actions quickly and in a cost-effective manner.

2. A second purpose of section 411(a) is to incentivize copyright registration, which is permissive, not mandatory, under the Copyright Act. 17 U.S.C. §§ 102, 408. The availability of copyright registrations via their inclusion in the Copyright Office's online and hard-copy files, increases public access to information concerning copyrighted works. BRUCE KELLER & JEFFREY CUNARD, COPYRIGHT LAW: A PRACTITIONER'S GUIDE § 5:3 (citing legislative history).

The Application Rule provides a strong incentive to provide ownership information in registration applications by requiring their submission prior to a plaintiff initiating a lawsuit. The Certificate Rule, on the other hand, could result

in a decrease in the number of applications filed, where the substantial delay in receiving a registration certificate renders enforcement a less effective or prohibitively expensive remedy.

3. Supporters of the Certificate Rule maintain that Sections 507(b) and 411(a), considered together, "reflect a statutory plan to encourage registration." *See Fourth Estate Pub. Benefit Corp. v. Wall-Street.com*, 856 F.3d 1338, 1342 (11th Cir. 2017) ("[A]n owner who files an application late in the statute of limitations period risks losing the right to enforce his copyright . . . . But this potential loss encourages an owner to register his copyright soon after he obtains the copyright and before infringement occurs."). However, other provisions in the copyright law, including increased available remedies and *prima facie* evidence for timely certificates, are more effective incentives to register early. *E.g.*, 17 U.S.C. §§ 410(b) (registration certificate credited as *prima facie* evidence if dated within five years of publication), 412 (advanced remedies available if registration made prior to commencement of infringement for unpublished works or within three months of publication for published works). These incentives apply in exactly the same manner, regardless of whether the Application Rule or the Certificate Rule applies, because they are based on when the application was filed, not when it was issued. Therefore, adopting the Certificate Rule would do nothing to further

encourage authors who are not otherwise already spurred by these stronger incentives to register.

IV. The Certificate Rule Is Not Necessary To Satisfy The Objective Of Allowing The Register Of Copyrights To Advise Courts In Infringement Actions.

The United States' *amicus* brief at the petition stage advocated that one objective of section 411(a) that is not satisfied by submission of a registration application and deposit is the timely provision to a court of the Register's conclusion regarding the registerability and/or copyrightability of a work by a claimant. Brief for the United States as *Amicus Curiae* Supporting Grant of *Certiorari*, at 12, 14-15, 21-22, *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com*, 138 S. Ct. 2707 (2018) (No. 17-571). However, there are multiple reasons why this objective does not justify adopting the Certificate Rule.

1. Courts may, when appropriate, stay cases and/or request the Register's opinions. 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[b][3][b][vi] (discussing stays); BRUCE KELLER & JEFFREY CUNARD, COPYRIGHT LAW: A PRACTITIONER'S GUIDE § 5:3.1 (discussing doctrine of primary jurisdiction); *Syntek Semiconductor Co. v. Microchip Tech.*, 307 F.3d 775, 780 (9th Cir. 2002) ("Primary jurisdiction is not a doctrine that implicates the subject matter jurisdiction of the

federal courts. Rather, it is a prudential doctrine under which courts may, under appropriate circumstances, determine that the initial decision-making responsibility should be performed by the relevant agency rather than the courts.").

There may be few cases where courts elect this approach given that, even in cases where courts do have the benefit of knowing the Register's views, either because she has acted on an application or intervened in a case, courts always conduct their own assessment of the case. *See Cosmetic Ideas*, 606 F.3d at 621, n. 13 ("After the Register's determination, the courts are empowered to review any denial of a certificate, and approval by the Register gives an applicant only *prima facie* evidence of copyright, leaving the courts to make the ultimate determination in either instance.").[11] This approach makes sense given that the review process involved in assessing registration applications is not extensive. *See id.* ("The Register looks only to ensure that the material deposited is 'copyrightable subject matter' and that the legal and formal requirements of the Title have been met.").

---

[11] Of course, where a registration certificate has an effective date within five years of first publication of a work, courts are obligated to treat it as *prima facie* evidence of any fact stated on the certificate. 17 U.S.C. § 410. The outcome of this appeal will not alter that fact.

Nevertheless, in cases involving close questions where the Register has not elected to intervene prior to taking action on an application, courts remain free to seek her advice.

2. Every plaintiff – not only plaintiffs required to do so by section 411(a) – must notify the Copyright Office when an infringement case is filed. 17 U.S.C. § 508; Form AO121, Report on the Filing or Determination of an Action or Appeal Regarding a Copyright, http://www.uscourts.gov/sites/default/files/ao121.pdf. These notices provide the Register with opportunities to move applications to the front of the line; to take action; and to decide whether to intervene.[12]

3. In 2017, fewer than 3,500 copyright infringement cases were filed. Trac Reports, Inc., *Fewer Copyright Infringement Lawsuits Filed* (2017), http://trac.syr.edu/tracreports/civil/483/. The Copyright Office rarely intervenes or receives requests to provide advice to courts.[13] It appears that

---

[12] The Copyright Office already has a process to allow litigants to expedite the processing of their applications. While the Copyright Office charges a steep fee of $800 per work (37 C.F.R. § 201.3(d)) – which it intends soon to increase to $1,000 – the reported internal cost to the Copyright Office of expediting a registration is only $67. *See Copyright Office Fees: Notice of Proposed Rulemaking*, 83 Fed. Reg. 24,054, 24,054, 24,059 (May 24, 2018).

[13] Last year, the Copyright Office received only three requests from courts for advice on registration issues. 2017 Annual

the Copyright Office did not affirmatively intervene in ***any*** case in 2017. This fact, combined with the low percentage of registration denials, puts the circumstances in perspective.

In 2017, the Copyright Office received 539,662 registration applications, and only denied close to 18,000 (3% of the total; and, of these "denials" many are likely due to incomplete applications – improper fees, no deposit copies – rather than substantive legal issues). In 2016, the Copyright Office received 533,606 claims and denied only 12,656 claims. A much smaller number of the denied applications concerned works involved in infringement suits. Thus, even if the Register were to elect not to voluntarily move works involved in infringement suits to the front of the application line, it is unlikely very many of those applications would eventually be denied or involve an issue the Register would need to intervene to address.

4. Current application processing time is, on average, seven months for online claims and nine months for paper claims. U.S. Copyright Office, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf. Median federal court litigation takes

---

Report at 8. *See also* U.S. Copyright Office, *Archive of Legal Filings*, https://www.copyright.gov/rulings-filings/411/; U.S. Copyright Office, *Archive of Amicus Briefs*, https://www.copyright.gov/rulings-filings/briefs/.

10.1 months for disposition, and the period of months to reach a trial is 26.3. *United States District Courts: National Judicial Caseload Profile*, http://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2018.pdf

In many cases, therefore, courts will have the benefit of the Copyright Office's views on a registration application prior to issuance of a judgment, even under the Application Rule. "[T]he pace of litigation entails that the Copyright Office will typically have granted or refused registration during its pendency." 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][1][a][i].

V. The Policies Underlying The Copyright Act Favor The Application Rule.

Enforceable, exclusive rights incentivize creativity and the dissemination of works. *Golan v. Holder*, 565 U.S. 302, 326 (2012); *Mazer v. Stein*, 347 U.S. 201, 219 (1954). They also enable recoupment of investments. *Eldred v. Ashcroft*, 537 U.S. 186, 207 (2003) (describing Congress' rationale for extending copyright terms).

Reality has proven the wisdom of these policy determinations. Industries driven by the production of copyrighted works greatly benefit the U.S. economy. Press Release, Office of the United States Trade Representative, USTR Releases 2018 Special 301 Report on Intellectual Property Rights (Apr.

2018) (statement of Robert Lighthizer: "The ideas and creativity of American entrepreneurs fuel economic growth and employ millions of hardworking Americans.").

Creators and innovators thus deserve, and require for creative and financial success, protection from free-riding. I PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 1.13 ("[T]he continual expansion of exclusive rights . . . reflects Congress' awareness of the need to bring new technological uses of copyrighted works under copyright control if the law is to continue to encourage investment in creative effort."); *id.* at § 1.13.2.3.

These policies require even stronger rights and more rapid enforcement actions in the digital age. *See* S. REP. NO. 105-190, at 8 (1998) ("Due to the ease with which digital works can be copied and distributed worldwide virtually instantaneously, copyright owners will hesitate to make their works readily available on the Internet without reasonable assurance that they will be protected against massive piracy."); Statement of Marybeth Peters, The Register of Copyrights before the Subcommittee on Courts and Intellectual Property Committee on the Judiciary, United States House of Representatives, 105th Congress, 1st Sess., Sept. 11, 1997, No Electronic Theft (NET) Act of 1997 (H.R. 2265) ("Copyright owners today lose substantial sums of money to piracy. The advent of digital technology has the potential to exacerbate greatly the impact of piracy,

as it allows users to make multiple perfect copies in an instant, without requiring a major investment in physical manufacturing and distribution facilities.").

As described *supra* in section II, the Application Rule vindicates this purpose by ensuring meaningful and timely access to judicial enforcement remedies. In contrast, the Certificate Rule creates a road block to rapid enforcement of exclusive rights, thereby undermining the very purposes of the statute of which section 411(a) is one part.

CONCLUSION

Amicus respectfully submits that the Court should reverse the Eleventh Circuit's affirmance of the trial court's dismissal.

Respectfully submitted,
J. Matthew Williams
Counsel of record
Eric J. Schwartz
Mitchell Silberberg &
Knupp LLP
1818 N St., NW, 7th Floor
Washington, DC 20036
Tel: (202) 355-7900
mxw@msk.com

Counsel for Amicus Curiae

No. 17-571

IN THE

Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,

Petitioner,

v.

WALL-STREET.COM, LLC, *et al.*,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

BRIEF OF AMICUS CURIAE THE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER

NOEL M. COOK
OWEN WICKERSHAM & ERICKSON, P.C.
455 Market Street, Suite 1910
San Francisco, CA 94105
(415) 882-3200

LAWRENCE K. NODINE
Counsel of Record
BALLARD SPAHR LLP
999 Peachtree Street
Atlanta, Georgia 30309
(678) 420-9300
nodinel@ballardspahr.com

JASON P. BLOOM
HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219
(214) 651-5000

Counsel for Amicus Curiae The International Trademark Association

283167

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES ii

INTEREST OF THE AMICUS CURIAE 1

SUMMARY OF ARGUMENT 6

ARGUMENT 7

A. Because the meaning of Section 411(a) is unclear, the Court should construe the statute to be consistent with the intent of Congress to adhere to international treaties, in this case Berne. 7

B. The registration interpretation is contrary to Berne. 9

C. The registration interpretation deprives copyright owners of important enforcement rights. 14

D. Requiring the issuance or denial of a registration decision is bad policy and makes no practical sense. 20

E. The plain language of the Copyright Act supports the application interpretation. 24

CONCLUSION 26

TABLE OF AUTHORITIES

Page(s)

Cases

ATCS Int'l LLC v. Jefferson Contracting Corp.,
807 F. Supp. 2d 516 (E.D. Va. 2011) 22

Benz v. Compania Naviera Hidalgo, S.A.,
353 U.S. 138, 77 S. Ct. 699, 1 L. Ed. 2d 709 (1957) 9

Clonus Assocs. v. DreamWorks, LLC, 417 F. Supp. 2d 248 (S.D.N.Y. 2005) 19

Garcia v. Google, Inc.,
786 F.3d 733 (9th Cir. 2015) 19

Golan v. Holder,
565 U.S. 302, 132 S. Ct. 873, 181 L. Ed. 2d 835 (2012) 8

Murray v. Schooner Charming Betsy,
6 U.S. (2 Cranch) 64 (1804) 8

Petrella v. Metro-Goldwyn-Mayer, Inc.,
134 S. Ct. 1962, 188 L. Ed. 2d 979 (2014) 17

Robinson v. Shell Oil Co.,
519 U.S. 337, 117 S. Ct. 843, 136 L. Ed. 2d 808 (1997) 7

Subafilms, Ltd. v. MGM-Pathe Commc'ns Co., 24 F.3d 1088 (9th Cir. 1994) (en banc) 8

Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc., 618 F.3d 417 (4th Cir. 2010) 22

Vimar Seguros y Reaseguros, S.A. v. M/V Sky Reefer, 515 U.S. 528, 115 S. Ct. 2333, 132 L. Ed. 2d 462 (1995) 9

Washingtonian Publ'g Co. v. Pearson, 306 U.S. 30, 59 S. Ct. 397, 83 L. Ed. 470 (1939) 13

Statutes

Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541 (17 U.S.C. 101 *et seq.*) ..... *passim*

15 U.S.C. § 1125 14

17 U.S.C. § 302(a) 11, 13, 25

17 U.S.C. § 408(a) 11, 13, 25

17 U.S.C. § 410(c) 22

17 U.S.C. § 411(a) ..... *passim*

17 U.S.C. § 507 17

Other Authorities

Annual Report 4,
https://www.copyright.gov/reports/annual/2017/ar2017.pdf 21

Fees,
https://www.copyright.gov/about/fees.html#handling (last visited August 31, 2018) 13

INTA Mission Statement,
http://www.inta.org/Governance/Pages/StrategicPlan.aspx 3

Melville B. Nimmer, NIMMER ON COPYRIGHT, § 7.16[B][3][b][ii] 21

Note, *The Charming Betsy Canon, Separation of Powers, and Customary International Law*, 121 Harv. L. Rev. 1215, 1215 (2008) 8

Registration Processing Times,
https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (last visited August 31, 2018) 12, 23

Restatement (Third) of the Foreign Relations Law of the United States § 114 (1987) 8

S. Ct. R. 37.6 1

Sandra Edelman & Fara Sunderji, *Delay in Filing Preliminary Injunction Motions: 2015 Edition*, 105 THE TRADEMARK REPORTER 1012 (2015) 19

Special Handling, https://www.copyright.gov/help/faq/faq-special.html (last visited August 31, 2018) 18

Sterling On World Copyright Law [2015] - Protection Criteria mn. 7.86 10

U.S. Courts, *United States District Courts—National Judicial Caseload Profile* 1 (June 2018), http://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2018.pdf (last visited August 31, 2018) 23

AMICUS CURIAE BRIEF OF THE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER

The undersigned amicus curiae respectfully submits this brief in support of Petitioner.[1]

INTEREST OF THE AMICUS CURIAE

Founded in 1878, amicus curiae The International Trademark Association (INTA) is a not-for-profit organization dedicated to serving its members and society as a trusted and influential advocate for the economic and social value of brands. It supports the advancement of trademarks and related intellectual-property concepts as essential elements of trade and commerce. INTA has more than 7,200 members in 191 countries. Its members include intellectual property owners as well as law firms and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks and related intellectual property. All INTA members share the goal of promoting an understanding of the

---

[1] Both Petitioner and Respondent have filed blanket consents to the filing of amicus briefs in support of either party. This brief was authored solely by INTA and its counsel. No party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than amicus curiae, its members, and its counsel made such a monetary contribution to its preparation or submission. *See* S. Ct. R. 37.6.

essential role that brands and related intellectual property play in fostering effective commerce, fair competition, and informed decision-making by consumers.

INTA (formerly known as the United States Trademark Association) was founded in part to encourage the enactment of federal trademark legislation after the invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has been instrumental in making recommendations and assisting legislators in connection with almost all major trademark legislation and, more recently, legislation involving other forms of intellectual property. INTA also participates as amicus curiae in numerous cases involving significant trademark and related intellectual property issues. INTA members are frequent parties in a wide variety of intellectual property-related litigation as both plaintiffs and defendants.

INTA has a particular interest in this case because the question presented – whether a copyright owner may commence an infringement suit after delivering the proper deposit, application, and fee to the Copyright Office, but before the Register of Copyrights has acted on the application – concerns imposing additional burdens on INTA members and other intellectual property owners before they may enforce and protect their rights.

Over the years, INTA has expanded from looking at trademark law in isolation to considering how other areas of intellectual property law may complement the protections trademark law provides to brand owners. Its Mission Statement expressly refers to "supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation."[2]

INTA standing committees on copyright and right of publicity, which are comprised of both leading outside counsel and preeminent senior in-house counsel from companies all over the world, have become a critical part of INTA's mission to support intellectual property in order to foster consumer trust, economic growth, and innovation. INTA has extended its reach into these complementary areas of law because it has become increasingly clear that intellectual property issues do not present themselves in neat categories in the real world. To the contrary, it would not be unusual for a party to seek to protect its brand by bringing trademark claims based on a word mark and copyright claims based on infringement of its logo, product packaging, or advertising content. The rule favored by the respondent would delay a brand owner's ability to promptly bring all such related

---

2 INTA Mission Statement, http://www.inta.org/Governance/Pages/StrategicPlan.aspx (last visited August 31, 2018).

claims simultaneously. This is particularly harmful due to the frequent need for immediate injunctive relief.

Finally, INTA is vitally interested in this case because it is an international organization with members around the world. As an international organization, one of INTA's concerns and central policies has always been to promote the harmonization of intellectual property laws. The Berne Convention for the Protection of Literary and Artistic Works ("Berne") fosters and promotes reduced formalities in copyright law, for all signatory nations, such that creators of copyrightable works can more easily protect their rights. Such international harmonization of intellectual property law is critical in today's global economy because works and products are often sold, viewed, read, or otherwise distributed in multiple jurisdictions simultaneously. To have fundamentally different intellectual property regimes in different jurisdictions unnecessarily complicates and burdens the efforts of intellectual property owners and creators to protect their interests and those of the consuming public. The United States is a signatory to Berne, yet the Copyright Act, no matter how interpreted, imposes more burdens on the creators of United States works than creators of foreign works, putting domestic works at a disadvantage. The interpretation that INTA advocates, consistent with the Petitioner's arguments, would minimize this

disadvantage and try to create a more harmonious framework for international copyright protection.

SUMMARY OF ARGUMENT

Because the meaning of 17 U.S.C. § 411(a), providing that lawsuits for infringement of any United States copyright shall not be instituted until "registration of the copyright claim has been made," is ambiguous, it should be interpreted to be consistent with the Berne Convention for the Protection of Literary and Artistic Works ("Berne"), to which the United States acceded in 1988. Article 5(2) of Berne requires that "[t]he enjoyment and the exercise of [copyright] rights shall not be subject to any formality . . . ." In light of the Congressional intent manifested by Congress's accession to Berne, Section 411(a) should be construed to minimize formal obstacles to enforcing copyrights: Registration of a claim to copyright is "made" when an application, deposit, and fee are filed. This interpretation (hereinafter the "application interpretation") best effectuates Congress's intent when it acceded to Berne. By contrast, the interpretation proposed by Respondent (hereinafter the "registration interpretation") requires that a copyright claimant wait many months for the Copyright Office to issue a certificate, as it does 97 percent of the time. This is a meaningless formality that Congress could not have intended.

ARGUMENT

A. Because the Meaning of Section 411(a) Is Unclear, the Court Should Construe the Statute To Be Consistent with the Intent of Congress to Adhere to International Treaties, in this Case Berne.

The meaning of Section 411(a) is ambiguous. Although INTA supports Petitioner's interpretation of Section 411(a), the circuit split on this issue is the best evidence that the meaning of the section is uncertain and that this Court must look to the broader context to discern its meaning.

When, as here, statutory language proves unclear, this Court discerns the statute's meaning by looking to the purpose and "broader context of the statute as a whole." *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341, 117 S. Ct. 843, 136 L. Ed. 2d 808 (1997).

Some circuits have interpreted Section 411(a) to mean that a copyright claimant may file suit upon submitting an application, deposit, and fee to the Copyright Office (the application interpretation), while others have held that a copyright claimant must await the Copyright Office's decision to grant or deny registration, which can take several months, before it may sue (the registration interpretation).

The circuits disagree because the statute is ambiguous. Because the statutory language is uncertain, it should be construed to effectuate the intent Congress expressed when it acceded to Berne's fundamental provision—that there be no formal obstacles to enforcing copyrights.

A 210-year-old canon of statutory construction holds that "an act of Congress ought never to be construed to violate the law of nations if any other possible construction remains." *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804); *see also* Restatement (Third) of the Foreign Relations Law of the United States § 114 (1987); Note, *The Charming Betsy Canon, Separation of Powers, and Customary International Law*, 121 Harv. L. Rev. 1215, 1215 (2008) (discussing the "deeply embedded" canon of construction).

It is important to ensure that the country is engaged in "full participation in the dominant system of international copyright protection." *Golan v. Holder*, 565 U.S. 302, 335, 132 S. Ct. 873, 181 L. Ed. 2d 835 (2012). This includes "exemplary compliance" with the United States' international obligations. *Id. See also Subafilms, Ltd. v. MGM-Pathe Commc'ns Co.*, 24 F.3d 1088, 1097 (9th Cir. 1994) (en banc) (warning about an approach that might "undermine Congress's objective of achieving 'effective and harmonious copyright laws among all nations.'"). Accordingly, judicial rulings that could

ignore our international obligations would undercut the country's positions and the perception that the United States is a trusted partner in multilateral endeavors. *See Vimar Seguros y Reaseguros, S.A. v. M/V Sky Reefer*, 515 U.S. 528, 539, 115 S. Ct. 2333, 132 L. Ed. 2d 462 (1995); *Benz v. Compania Naviera Hidalgo, S.A.*, 353 U.S. 138, 147, 77 S. Ct. 699, 1 L. Ed. 2d 709 (1957) (cautioning against courts "run[ning] interference in such a delicate field of international relations . . . [without] the affirmative intention of the Congress clearly expressed").

The application interpretation, which is more consistent with international copyright law than the registration interpretation, protects the enforcement rights of copyright claimant, and comports with the language and intent of the Copyright Act.

B. The Registration Interpretation Is Contrary to Berne.

(1) Berne stands for the principle of freedom from formalities.

The United States acceded to Berne[3] on October 31, 1988. Berne's principle purpose is

---

[3] Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, completed at PARIS on May 4, 1896, revised at BERLIN on November 13, 1908, completed at BERNE on March 20, 1914,
revised at ROME on June 2, 1928, at BRUSSELS on June 26, 1948, at STOCKHOLM on July 14, 1967, and at PARIS on July 24, 1971, and amended on September 28, 1979.

freedom from formalities. Berne Article 5(2) provides "[t]he enjoyment and the exercise of [copyright] rights shall not be subject to any formality . . . ." The underlying principle is to make the attachment and enforcement of copyright as simple as possible. Consequently, only a small number of countries still require formalities to be fulfilled as a pre-condition of bringing an action.[4]

(2) The registration interpretation is inconsistent with Berne.

The United States was not an initial signatory to Berne. Rather, for more than a century, the United States refused to join Berne, primarily because the United States, unlike other developed countries, required certain formalities as a precondition to copyright protection. Intending to bring United States law into conformity with international norms, Congress amended and modified the Copyright Act so that citizens could enjoy the international benefits of Berne participation.

To that end, Congress included several provisions in the Copyright Act to harmonize it with Berne's purpose and intent. First, the Act provides that copyright protection attaches at the time a work is created, regardless of whether it is registered,

---

[4] *See Sterling On World Copyright Law* [2015] - Protection Criteria mn. 7.86.

omitting administrative formalities for copyright protection. 17 U.S.C. § 302(a) ("[c]opyright in a work . . . subsists from its creation"); 17 U.S.C. § 408(a) ("registration is not a condition of copyright protection"). In addition, Section 411(a), requiring that registration of the copyright claim "has been made" as a prerequisite to suit, specifically exempts foreign works. 17 U.S.C. § 411(a). Therefore, the enforcement obstacles imposed by Section 411(a) (under both the registration and application interpretations) only apply to United States works—owners of foreign works are exempted from even filing an application before filing suit. While Section 411(a)'s exemption of foreign works was intended to comply with Berne's requirements, the registration interpretation adopted by the Eleventh Circuit in the decision below still creates an obstacle for owners of United States works that contravenes Berne's purpose.

The fundamental question for this Court is whether Congress intended that the obstacles that Section 411(a) imposes on United States copyright owners be large (the registration interpretation) or small (the application interpretation). Given Congress's efforts to reduce formalities in compliance with Berne, the answer is the latter—Congress intended to minimize formalities. It is not likely that Congress had the inconsistent intention to minimize (indeed to completely eliminate) obstacles to

enforcing foreign copyrights, but to maximize obstacles to enforcing United States copyrights.

It is more consistent with Berne to conclude that Congress intended to maintain a minimal registration requirement for United States copyrights, as reflected in the application interpretation of Section 411(a). Certainly this interpretation is more consistent with Congress's intent when acceding to Berne and implementing amendments necessary to make that possible. Requiring owners of United States works to even apply for a copyright registration prior to enforcing their rights imposes a formality that contravenes Berne. But, given the minimal application fee and the ease with which an application, deposit, and fee can be submitted to the Copyright Office, the burden of the application requirement is relatively minor and certainly closer to the enforcement rights afforded foreign copyright owners.

By contrast, the registration interpretation of Section 411(a) maximizes the formal barriers to copyright enforcement. This approach is the antithesis of Berne. Requiring a claimant to wait several months or face the financial burden of paying an $800 special handling fee to be able to enforce its rights turns Berne on its head.[5] Further, while

---

[5] *See* Copyright.gov, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-

Sections 302(a) and 408(a) comply with Berne by providing that copyright ownership attaches upon creation of a work (without formalities), the full value and purpose of copyright ownership cannot be achieved if not accompanied by enforcement rights. *See Washingtonian Publ'g Co. v. Pearson*, 306 U.S. 30, 40, 59 S. Ct. 397, 83 L. Ed. 470 (1939) ("Without right of vindication a copyright is valueless.")

The registration interpretation imposes the type of burdensome formalities that Congress intended to eliminate when acceding to Berne. It is unlikely that Congress intended to eliminate formal obstacles for foreign copyright owners while maintaining substantial obstacles for owners of United States works. Rather, it is more plausible that Congress intended that United States works should face only minimal obstacles to enforcement consistent with a registration system. That minimal approach is reflected in the application interpretation of Section 411(a).

---

faqs.pdf (last visited August 31, 2018). *See also* Copyright.gov, *Fees*, https://www.copyright.gov/about/fees.html#handling (last visited August 31, 2018).

C. The Registration Interpretation Deprives Copyright Owners of Important Enforcement Rights.

(1) The registration interpretation creates an obstacle to enforcing copyright interests that is not required to enforce trademark rights.

For brand owners, the registration interpretation is additionally problematic because it imposes obstacles to copyright enforcement that are not present for trademark enforcement. There are many instances, including with respect to logos and designs, when copyright and trademark protection overlap. And, there are other instances, including with respect to counterfeit goods and online infringement, when a party may separately infringe a brand owner's trademark rights (e.g., product packaging or a domain name) and copyright interests (e.g., product manuals or website content). In those instances, brand owners often must assert both copyright and trademark claims.

Although brand owners routinely seek to register their logos and other trademarks with the United States Patent and Trademark Office, registration is not a prerequisite to suit. Rather, brand owners can enforce their common law trademark rights under the Lanham Act without first obtaining, or even applying for, a registration. *See* 15 U.S.C. § 1125. Thus, even if brand owners have not registered their

marks, they have the right to enforce their trademark rights in federal court, including by seeking injunctive relief.

This is not so for copyrights under the registration interpretation. Under that interpretation, copyright owners who have not registered their works must pay a substantial special handling fee to expedite registration or delay their enforcement by several months while waiting for the Copyright Office to grant (or deny) registration. Thus, under the registration interpretation, brand owners needing to quickly enforce their trademark and copyright interests may be barred from doing so, potentially resulting in disadvantageous delay or the pursuit of multiple lawsuits involving overlapping acts of infringement. This approach to enforcement is not only inefficient. It also creates a risk of inconsistent outcomes and may otherwise impact the outcome on the merits.

By contrast, under the application interpretation, brand owners can quickly attain the right to enforce their copyrights by submitting an application, deposit, and fee and thus simultaneously enforce their copyrights and trademarks without unnecessary delay or excessive administrative costs. The application interpretation therefore benefits both brand owners and the efficient administration of justice.

(2) The registration interpretation deprives copyright owners of expeditious enforcement rights.

The registration interpretation harms copyright claimants who need to act quickly when (1) the statute of limitations expires within three years; or (2) irreparable harm caused by infringement requires a temporary restraining order or preliminary injunctive relief. In both cases, a delay of several months (or even several days) can deprive copyright claimants of the ability to enforce their rights. The alternative of paying a hefty fee for special handling discourages enforcement. Non-profit entities, small businesses, and individuals of modest means would feel this loss of enforcement rights most keenly, especially when numerous infringed works require individual registrations (and special handling fees).

(3) The registration interpretation can deprive copyright claimants of the ability to enforce their rights when the expiration of the statute of limitations is approaching.

A critical downside of the registration interpretation is that it may deprive copyright claimants of the ability to enforce their rights when the Copyright Act's three-year statute of limitations will expire during the multi-month period it takes the Copyright Office to make a registration decision.

Copyright claimants in such situations face two problematic options: (1) expedite processing of the application by paying a special handling fee which, at $800, is twice the $400 filing fee for a federal lawsuit (without any in forma pauperis waiver) and nearly 15 times the standard fee for a copyright registration application; or (2) forego their rights to enforce their copyrights. While a special handling fee may be an acceptable cost to some claimants in some situations, such a fee could deter many claimants from enforcing their rights entirely, especially with respect to claimants with limited resources or who are seeking to protect multiple copyrighted works.

The statute of limitations for copyright infringement runs from three years after a claim has accrued. 17 U.S.C. § 507. Accrual occurs when an infringement is discovered. *See Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 n.4, 188 L. Ed. 2d 979 (2014) (noting that nine Courts of Appeals have adopted the discovery rule in copyright infringement cases). This Court held in *Petrella* that a copyright owner can only recover damages for the three-year period leading up to suit. *See id.* at 1973 ("[A] successful [copyright] plaintiff can gain retrospective relief only three years back from the time of suit. No recovery may be had for infringement in earlier years."). Under the registration interpretation, the statute of limitations might run before the Copyright Office makes a registration decision, or damages might be limited

depending on the scope of infringement in the three years prior to a registration decision and concomitant institution of suit. Such a result would be inequitable in light of the fact, as discussed below, that the Copyright Office issues registrations certificates in 97 percent of cases, and claimants have the right to file suit upon the denial of a registration.

Even in cases of special handling, the Copyright Office has no statutory obligation to issue a registration decision within any period of time, and the statute of limitations could run in many cases even when special handling is requested at significant cost.[6]

(4) The registration interpretation could deprive copyright claimants of the ability to promptly obtain temporary restraining orders or preliminary injunctive relief.

The registration interpretation also hurts copyright claimants who need temporary restraining orders or preliminary injunctions to stop irreparable

---

[6] *See* Copyright.gov, *Special Handling*, https://www.copyright.gov/help/faq/faq-special.html (last visited August 31, 2018) ("Once a request for special handling is received and approved, every attempt is made to process the claim or recordation within five working days. However, no guarantee is made that the work can be processed within this time.").

harm caused by copyright infringement. When an infringing advertisement will air in two days or an infringing artwork will be shipped out of the country in four days, even special handling would not allow for a registration decision in time. In such cases, the registration interpretation serves no useful purpose but to deprive copyright owners of their enforcement rights.

Additionally, the delay caused by the registration interpretation could prevent a copyright owner from obtaining injunctive relief. Some courts have held that delay in seeking an injunction counters a finding of irreparable harm in the copyright context. *See Garcia v. Google, Inc.*, 786 F.3d 733, 746 (9th Cir. 2015) (five-month delay in seeking to enjoin video weighed against finding of irreparable harm); *see also Clonus Assocs. v. DreamWorks, LLC*, 417 F. Supp. 2d 248 (S.D.N.Y. 2005) (delay of less than one month, but after film release, weighed against finding of irreparable harm).[7]

Accordingly, by requiring claimants to wait several months for a registration decision before

---

[7] Sandra Edelman & Fara Sunderji, *Delay in Filing Preliminary Injunction Motions: 2015 Edition*, 105 THE TRADEMARK REPORTER 1012 (2015), http://www.inta.org/TMR/Documents/Volume%20105/TMR_Vol105_No5_Edelman_Sunderji.pdf.

filing suit, the registration interpretation could prevent claimants from obtaining preliminary injunctive relief. The application interpretation avoids this result and allows copyright claimants to quickly and effectively enforce their rights, just as Berne and Congress intended.

D. Requiring the Issuance or Denial of a Registration Decision Is Bad Policy and Makes No Practical Sense.

(1) The delay caused by the registration interpretation serves no practical purpose.

The delay (or substantial expense) imposed by the registration interpretation not only contravenes Berne, but it does so without providing any real benefit to copyright owners, the judicial system, or the Copyright Office. Any minimal benefit courts and litigants may derive from knowing the Copyright Office's pre-suit position on copyrightability is outweighed by the burdens imposed by the registration interpretation.

Requiring copyright claimants to wait months to sue (or pay a burdensome special handling fee) serves little purpose because the Copyright Act explicitly permits claimants to file suit whether a registration is granted or denied. See 17 U.S.C. § 411(a). The only distinction is that when a registration is denied, the copyright plaintiff must serve notice of its lawsuit and a copy of the

complaint on the Register of Copyrights, who has the option to intervene on the issue of registrability. *Id.* Because the denial of a registration does not deprive litigants of the right to sue, it makes no practical sense for the pendency of a decision to strip claimants of their enforcement rights. Under the registration interpretation, claimants are not required to wait until a certificate is issued; rather they are forced to wait until the Copyright Office makes a decision. Depriving United States copyright claimants of their enforcement rights based on nothing more than the administrative delays of a government office is inequitable, and contravenes Berne.

The Copyright Office grants copyright registration certificates 97 percent of the time.[8] This statistic demonstrates that the Copyright Office's registration decisions are more an administrative formality than an in-depth legal analysis regarding copyrightability. The 97 percent grant rate calls into question the notion that courts benefit from having the opinion of the Copyright Office before lawsuits begin. On the contrary, at 97 percent, the decision to

---

[8] Melville B. Nimmer, NIMMER ON COPYRIGHT, § 7.16[B][3][b][ii] (citing Brief of the United States, at 4 n.2, *Reed Elsevier, Inc. v. Muchnick* 559 U.S. 154, 130 S.Ct. 1237, 176 L. Ed. 2d 18 (2010)). *See also* U.S. Copyright Office, *Fiscal 2017 Annual Report* 4, https://www.copyright.gov/reports/annual/2017/ar2017.pdf (last visited August 31, 2018).

grant a registration looks like a rubber stamp. This is just the kind of administrative hurdle—imposing great burden but providing little benefit—that Berne seeks to eliminate.

Requiring litigants and courts to wait for the Copyright Office makes even less sense because courts are not bound by the Copyright Office's decisions as to copyrightability. Indeed, a registration decision issued before or within five years of publication of a work is prima facie evidence of the validity of the copyright and facts stated in the certificate. 17 U.S.C. § 410(c). But for works registered more than five years after publication, courts have discretion to decide what, if any, weight should be given to the certificate. *Id.* Even when a registration certificate constitutes prima facie evidence of validity, courts may still reject that finding and find registered material to be uncopyrightable. *See Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 428 (4th Cir. 2010) ("the Copyright Office's practice of summarily issuing registrations . . . counsels against placing too much weight on registrations as proof of a valid copyright"); *see also ATCS Int'l LLC v. Jefferson Contracting Corp.*, 807 F. Supp. 2d 516, 518 (E.D. Va. 2011) ("Under these circumstances, the presumption of copyright validity that attaches to the CSDs by virtue of their registration does not clearly establish a valid, protectable copyright."). Because the Copyright Office's decisions are not

binding on courts, requiring litigants and courts to await those decisions before filing suit makes little practical sense. Moreover, to the extent courts applying the application interpretation would like to know the Copyright Office's position on registrability before making certain rulings in litigation, they are entitled to institute a stay (or delay their ruling) until the Copyright Office renders a decision. The application interpretation thus enables claimants facing a statute of limitations deadline to file suit and preserve their claims without having to wait for a Copyright Office decision.

Also, in most cases where the application interpretation is applied, the Copyright Office will have made a registration decision well before the case reaches trial. On average, civil cases in United States district courts reach trial approximately 27 months after filing.[9] Depending on various factors, the Copyright Office, on average, takes between 7 and 16 months to issue a registration certificate.[10]

Therefore, while it can take considerable time for the Copyright Office to make a registration decision,

---

[9] U.S. Courts, *United States District Courts—National Judicial Caseload Profile* 1 (June 2018), http://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2018.pdf (last visited August 31, 2018).

[10] *See* Copyright.gov, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (last visited August 31, 2018).

when an application is filed shortly before a lawsuit is filed, the Copyright Office would generally make a registration decision well before the average time to trial. In those cases in which the Copyright Office has not yet made a decision before trial, courts are at liberty to continue the trial date, if appropriate, until the Copyright Office makes a decision. In any event, delaying trial is far more equitable than delaying the institution of suit, because, as set forth above, delaying the institution of suit can deprive claimants of their enforcement rights entirely.

E. The Plain Language Of the Copyright Act Supports the Application Interpretation.

The application interpretation is supported by the plain language of the Copyright Act. The Copyright Act provides: "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. § 411(a). Petitioner correctly reads "registration . . . has been made" to mean that an application, deposit, and fee have been filed. This interpretation is buttressed by the fact that the very next sentence of Section 411(a) explicitly provides that an applicant may file suit if the Copyright Office denies its application. 17 U.S.C. § 411(a). Thus, as Petitioner notes, "has been made," under the application interpretation, refers to action by the copyright claimant rather than the Copyright

Office. Otherwise, the Copyright Act is attaching too much consequence to the pace at which the Copyright Office does its job, while depriving even diligent claimants of the ability to control their own destinies. Petitioner's reading, and the application interpretation, logically comport with the language and purpose of the Copyright Act, as well as Berne's purpose and intent.

Interpreting "has been made" to mean the submission of an application, deposit, and fee (the application interpretation) serves the Copyright Act (and Berne's) purpose of removing unnecessary formalities to securing and enforcing copyright interests. The Copyright Act clearly aims to harmonize with Berne by providing that copyright in a work subsists from the time of creation (without the need for registration) and by exempting foreign works from even the application requirement before suit can be filed. *See* 17 U.S.C. § 302(a) ("[c]opyright in a work . . . subsists from its creation"); 17 U.S.C. § 408 (a) ("registration is not a condition of copyright protection."); 17 U.S.C. § 411(a) (excluding foreign works from pre-suit registration requirement). It follows, then, that the Act would not impose on United States copyright owners the unnecessary formality of having to obtain a registration certificate (or denial) before a lawsuit can be instituted. Rather, the accession to Berne reflects Congressional intent to minimize administrative burdens. Accordingly, Section 411(a) logically only

requires the submission of a deposit, application, and fee in order for a party to file suit to enforce its copyrights.

CONCLUSION

The Court should rule in favor of Petitioner.

September 4, 2018

Respectfully submitted,

NOEL M. COOK
OWEN WICKERSHAM & ERICKSON, P.C.
455 Market St., Suite 1910
San Francisco, CA 94105
(415) 882-3200

JASON P. BLOOM
HAYNES AND BOONE, LLP
2323 Victory Avenue,
Suite 700
Dallas, Texas 75219
(214) 651-5655

LAWRENCE K. NODINE
Counsel of Record
BALLARD SPAHR LLP
999 Peachtree Street
Atlanta, Georgia 30309
678-420-9422
nodinel@ballardspahr.com

COUNSEL FOR AMICUS CURIAE
THE INTERNATIONAL TRADEMARK ASSOCIATION

No. 17-571

IN THE

Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,

v.

WALL-STREET.COM, LLC and JERROLD D. BURDEN,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

BRIEF FOR THE NATIONAL MUSIC PUBLISHERS' ASSOCIATION, RECORDING INDUSTRY ASSOCIATION OF AMERICA, AMERICAN SOCIETY OF COMPOSERS, AUTHORS AND PUBLISHERS, BROADCAST MUSIC, INC., NASHVILLE SONGWRITERS ASSOCIATION INTERNATIONAL, AND SONGWRITERS OF NORTH AMERICA, AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

Jacqueline C. Charlesworth
COVINGTON & BURLING LLP
620 Eighth Avenue
New York, NY 10018
(202) 841-1000
jcharlesworth@cov.com

Beth S. Brinkmann
Counsel of Record
Kevin F. King
Rafael Reyneri
COVINGTON & BURLING LLP
850 Tenth Street, NW
Washington, DC 20001
(202) 662-6000
bbrinkmann@cov.com
Counsel for Amici Curiae

September 4, 2018

TABLE OF CONTENTS

TABLE OF AUTHORITIES iii

INTEREST OF *AMICI CURIAE* 1

SUMMARY OF ARGUMENT 3

ARGUMENT 6

I. A COPYRIGHT OWNER THAT COMPLIES WITH THE REGISTRATION REQUIREMENTS OF THE COPYRIGHT ACT IS ENTITLED TO SEEK TIMELY INJUNCTIVE AND OTHER RELIEF IN COURT 6

A. The Ability To Seek Judicial Relief Against Infringers Is An Essential Feature Of The U.S. Copyright System That Congress Did Not Intend To Diminish Based On Administrative Delay. 6

B. Surrounding Provisions Of The Copyright Act Confirm That Registration Is "Made" Under Section 411(a) When A Copyright Owner Delivers The Required Deposit Of The Work And Other Registration Materials To The Copyright Office. 10

II. IN ENACTING SECTION 411(a), CONGRESS SOUGHT TO ENSURE THAT THE COPYRIGHT OFFICE WOULD NOT BE A BARRIER TO A COPYRIGHT OWNER'S RIGHT TO TIMELY JUDICIAL RELIEF AGAINST INFRINGERS 15

A. This Court's Longstanding Presumption In Its *Washingtonian* Opinion Forecloses Respondents' Interpretation. 15

B. Congress' Rejection Of A Pre-Suit Mandamus Requirement In The 1976 Act Validates Petitioner's Reading. 17

III. RESPONDENTS' RULE WOULD DENY COPYRIGHT OWNERS MEANINGFUL PROTECTION OF THEIR STATUTORY RIGHTS 19

A. The Copyright Office Typically Takes Months And Sometimes Years To Carry Out Its Administrative Function And Issue A Certificate. 19

B. To Delay For Months Or Years A Copyright Owner's Right To Seek Injunctive Or Other Judicial Relief Effectively Abrogates That Right. 24

CONCLUSION 27

APPENDIX: DESCRIPTIONS AND INTERESTS OF *AMICI CURIAE* 1a

TABLE OF AUTHORITIES

Page(s)

CASES

Am. Broad. Companies, Inc. v. Aereo, Inc.,
134 S. Ct. 2498 (2014) 16

Cosmetic Ideas, Inc. v. IAC/Interactivecorp,
606 F.3d 612 (9th Cir. 2010) 25

FDA v. Brown & Williamson Tobacco Corp.,
529 U.S. 120 (2000) 8

Feltner v. Columbia Pictures Television, Inc.,
523 U.S. 340 (1998) 24

Roberts v. Sea-Land Servs., Inc.,
566 U.S. 93 (2012) 26

United States v. Hayes,
555 U.S. 415 (2009) 25

Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.,
260 F.2d 637 (2d Cir. 1958) 17

Washingtonian Publishing Co. v. Pearson,
306 U.S. 30 (1939) ..... *passim*

STATUTES

2 U.S.C. § 505 ..... 11, 12

15 U.S.C. § 1173 12

17 U.S.C. § 12 (1939) 17

17 U.S.C. § 102 6

17 U.S.C. § 405 11

17 U.S.C. § 408 ..... *passim*

17 U.S.C. § 410 ..... 8, 9, 10, 18

17 U.S.C. § 411 ..... *passim*

17 U.S.C. § 501 7

17 U.S.C. § 502 24

17 U.S.C. § 507 22

17 U.S.C. § 708 11

45 U.S.C. § 362 12

OTHER AUTHORITIES

37 C.F.R. § 201.3 11

47 Fed. Reg. 19,254 (May 4, 1982) 22

83 Fed. Reg. 24,054 (May 24, 2018) 23

Benjamin Kaplan, *Study No. 17—The Registration of Copyright* (Aug. 1958) 17, 18, 19

Caruthers Berger, *Study No. 18—Authority of the Register of Copyrights to Reject Applications for Registration* (Mar. 1959) 19

Copyright Law Revision, Hearing Before the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary, 89th Cong. (1965) 16

H. Comm. on Appropriations, *FY 2016 Appropriations Questions for the Record* (Mar. 10, 2015) 20

H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. (1976) 8, 9, 18, 20, 24

Oversight of the U.S. Copyright Office: Hearing Before the Subcomm. on Courts, Intellectual Property, and the Internet of the H. Comm. on the Judiciary, 113th Cong. (2014) 20

S. Rep. No. 94-473, 94th Cong., 1st Sess. (1975) 9, 18

U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* 19, 23

U.S. Copyright Office, *Fiscal 2016 Annual Report*, https://www.copyright.gov/reports/annual/2016/ar2016.pdf 20

U.S. Copyright Office, *Fiscal 2017 Annual Report*, https://www.copyright.gov/reports/annual/2017/ar2017.pdf 14

U.S. Copyright Office, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (accessed Aug. 31, 2018) 20

INTEREST OF *AMICI CURIAE*[1]

Amici curiae the National Music Publishers' Association, the Recording Industry Association of America, the American Society of Composers, Authors and Publishers, Broadcast Music, Inc., Nashville Songwriters' Association International, and Songwriters of North America are leading music trade organizations and performing rights societies representing the interests of music publishers, record companies, and individual songwriters and composers. *Amici*'s members, who collectively register tens of thousands of musical works and sound recordings each year with the Copyright Office, have a substantial interest in this case because their copyrighted works are the foundation of their businesses and source of livelihood for individuals who create them. *Amici*'s members depend upon the rights conferred by the Copyright Act—including the right to seek injunctive relief and obtain damages for the unauthorized use of their musical works and sound recordings—to protect the works they create, invest in, license, and distribute.[2]

The question presented in this case bears directly on that interest. The rule advocated by Respondents

---

[1] No party or counsel for any party authored any part of this brief or made a monetary contribution intended to fund the preparation or submission of this brief. All parties have provided blanket consent to the filing of *amicus* briefs.

[2] *Amici* work on behalf of music publishers, record labels, songwriters, and composers to protect, promote, and advance their interests on legislative, litigation, and regulatory matters. The Appendix to this brief provides more detailed descriptions of *Amici*.

and adopted by the Eleventh Circuit below would prohibit a copyright owner from seeking injunctive or other relief until the Copyright Office determines whether to issue a copyright certificate. Under that rule, a copyright owner could not enforce its exclusive rights against ongoing infringement even though the owner has met its statutory obligation to deliver to the Office the work at issue, the application, and the required fee, at which time the Copyright Act deems a copyright registration to be effective. Moreover, Respondents' rule would disable copyright owners' enforcement rights in this way even though the Copyright Act allows an owner to sue regardless of whether the Copyright Office issues a registration certificate.

The Copyright Office operates with a limited budget, staffing, and resources. The Office acknowledges that it typically takes seven to nine months, and sometimes more than two years, for a copyright owner to receive a copyright certificate. In the experience of *Amici*'s members, the delay can be even longer and in some instances may consume most or all of the Copyright Act's three-year limitations period, thereby eliminating altogether a copyright owner's ability to bring an infringement action. Moreover, as also recognized by the Office, the general trend in recent years is that processing times are increasing.

The regime for which Respondents advocate would have a devastating effect on *Amici*'s members and others in the broader music industry, who at least now may be able to bring suit without undue delay in one of the jurisdictions that takes the opposite view. Particularly in the case of recently released songs at the peak of their earning potential, it is critical to be able

to seek prompt judicial intervention against unauthorized uses. Accordingly, *Amici* respectfully submit that the Court should reject Respondents' misguided rule and confirm that a copyright owner may file an action against an infringer once the owner has made registration for the work by depositing the work, along with the application and fee, with the Copyright Office, as Congress intended—and as the Copyright Act, correctly read, provides.

SUMMARY OF ARGUMENT

I. Copyright protection attaches to original works the moment they are fixed in a tangible medium, and does not depend on action by the Copyright Office. Copyrights are not self-enforcing, however, and copyright owners must turn to the courts to enforce their statutory rights. The ability to sue for infringement and obtain injunctive relief is the central statutory mechanism by which the Copyright Act's substantive protection of exclusivity is enforced. Without that ability, a copyright is "of no value." *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30, 39-40 (1939).

Section 411(a) of the Copyright Act is meant to ensure that copyright owners can stop infringement of their works without delay. Section 411(a) permits owners to file an infringement action as soon as "registration ... has been made," and section 408 in turn provides that an owner "may obtain registration" by delivering the required deposit copies of the work, an application, and a fee to the Copyright Office. Surrounding statutory provisions demonstrate that registration is "made" under section 411(a) by the copyright owner such that the owner may sue for

infringement as soon as the owner fulfills section 408's registration requirements, rather than needing to wait for action by the Copyright Office as Respondents contend. For example, section 410(d) makes registration effective on the date when an acceptable deposit of the work, application, and fee are received by the Copyright Office, as determined by the Office or by a court; section 411(a) authorizes copyright owners to sue for infringement whether or not the Copyright Office issues a certificate; and section 411(c) provides added protections when "the *copyright owner* ... *makes registration* for the work." 17 U.S.C. § 411(c) (emphasis added). Congress made other rights, such as entitlement to *prima facie* validity of a copyright, expressly contingent on the Copyright Office's issuance of a certificate, but did not do so in section 411(a). Respondents' attempt to rely, instead, on the Act's preregistration and live-broadcast provisions, *see* 17 U.S.C. §§ 408(f), 411(c), is without merit because that argument fails to account for significant limitations on those procedures.

II. The statutory purpose and legal backdrop against which Congress enacted section 411(a) as part of the Copyright Act of 1976 confirm that Congress intended that copyright owners be able to obtain timely judicial enforcement, including injunctions against ongoing infringers. This Court has long recognized the significance of judicial enforcement to protect copyrights and declared that "forfeiture[]" of a copyright owner's right to sue is "never to be inferred from doubtful language." *Washingtonian*, 306 U.S. at 42. Moreover, Congress designed section 411(a) to overturn, in particular, the rationale of some lower courts

that had required a copyright owner to obtain a certificate from the Register, through mandamus if necessary, before suing for infringement.

III. The Court should reject Respondents' contention that a copyright owner cannot file an infringement suit until the Copyright Office issues a certificate or refuses to do so. There is often a significant time lag between when a copyright owner deposits the required copies of the work, application, and fee to fulfill the registration requirements, and when the Copyright Office issues a certificate or determines that it will not do so. The Office faces human and technological constraints, and acknowledges that administrative delay is typically seven to nine months and can be more than two years in some instances.

Amici's members experience these delays firsthand. In the experience of *Amici*'s members, delays of a year or more are not uncommon, and the processing time for some musical works and sound recordings is so long that it exceeds the Copyright Act's three-year limitations period for infringement suits. As a result, under Respondents' rule, copyright owners would be denied their right to enforce their copyrights against infringers for extended periods, and in some cases would lose the ability to do so altogether. A nonstatutory "special handling" procedure offered by the Copyright Office is no answer because its availability is discretionary, costs hundreds of dollars, and there is no guaranteed turnaround time.

Congress had no reason to expose copyright owners to that sort of legal limbo. On the contrary, its goal in drafting the 1976 Act was to preserve copyright

owners' ability to enforce their statutory rights in a timely manner through judicial intervention against infringers.

ARGUMENT

I. A COPYRIGHT OWNER THAT COMPLIES WITH THE REGISTRATION REQUIREMENTS OF THE COPYRIGHT ACT IS ENTITLED TO SEEK TIMELY INJUNCTIVE AND OTHER RELIEF IN COURT

A. The Ability To Seek Judicial Relief Against Infringers Is An Essential Feature Of The U.S. Copyright System That Congress Did Not Intend To Diminish Based On Administrative Delay.

Copyright attaches to original works the moment they are fixed in a tangible medium, 17 U.S.C. § 102(a), and not as a consequence of any certificate issued by the Copyright Office, *see id.* § 408(a) ("[R]egistration is not a condition of copyright protection"). But copyrights are not self-enforcing. Because copyright owners must sue for infringement to enforce their exclusive statutory rights, the ability to take legal action is the central statutory mechanism by which the Act's substantive protections are enforced. Indeed, as this Court observed nearly 80 years ago in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30, 39-40 (1939), a copyright is of "no value" to its owner if it cannot be effectively enforced in the courts. That principle is particularly true where a work is subject to significant ongoing infringement, as is often the case with newly released recordings in the online

environment. Without the ability to obtain prompt injunctive relief against infringers in such a circumstance, a copyright owner cannot meaningfully enforce its property rights. *See* Part III.B, *infra*.

Section 501(b) of the Copyright Act provides that a copyright owner "is entitled, subject to the requirements of section 411, to institute an action for any infringement of" the owner's rights. 17 U.S.C. § 501(b). Section 411(a), in turn, provides that an infringement suit may be instituted by the owner of a United States work[3] after "preregistration or registration of the copyright claim has been made in accordance with [title 17]." *Id.* § 411(a).[4]

Respondents maintain that a copyright owner's ability to obtain judicial relief, including an injunction to halt ongoing infringement, must await definitive action by the Copyright Office even when the copyright owner has satisfied the requirements for registration. But the text, structure, and purpose of the Copyright Act do not support that interpretation.

The Copyright Act provides that the effective date of a copyright registration is the date on which "an application, deposit [of copy or copies], and fee, which are

---

[3] The copyright owner of a non-U.S. work is not required to register before commencing a legal action. *See* 17 U.S.C. § 411(a) (limiting restriction to "action[s] for infringement of the copyright in any United States work"). As a result, under Respondents' rule, the owners of U.S. works would face significant delays as compared to owners of foreign works in enforcing their rights.

[4] The preregistration procedure, which applies only to incomplete, unpublished works still being "prepared for commercial distribution," 17 U.S.C. § 408(f), is not at issue in this case.

later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration," are received by the Copyright Office. 17 U.S.C. § 410(d). Under this statutory framework, then, either the Copyright Office or a court may make a determination concerning the acceptability of the materials submitted to the Office for registration, with the effective date of the registration being the date as of which compliant materials were received by the Copyright Office.

As this structure and provision for the effective date of registration demonstrate, Congress designed section 410(d) to account for the possibility of refusal as well as "the inevitable timelag" between the copyright owner's fulfillment of registration requirements and the Copyright Office's issuance of a certificate. H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 157 (1976). Because Congress acknowledged the delay and took steps in section 410(d) to alleviate any adverse impact that delay could have on a copyright owner, it would contravene Congress's intent to read in a requirement that would restrict a copyright owner's enforcement rights based on the very administrative delay Congress sought to overcome. *See FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 133 (2000) ("all parts" of a statute should be read together as a "harmonious whole").

Within this framework, the provision of section 411(a) that an infringement action may be instituted once "registration ... has been made" is best understood as referring to action by the copyright owner—i.e., the owner's having fulfilled the requirements for

making registration by depositing the work, and submitting an application and appropriate fee to the Copyright Office. *See* 17 U.S.C. § 408 (owner may obtain registration by delivering such materials to Copyright Office). The House and Senate Judiciary Committee reports accompanying the 1976 Copyright Act both confirm that under section 411(a), a copyright owner "cannot enforce his rights in the courts until *he has made registration*." H.R. Rep. No. 94-1476, 94th Cong., 2d Sess., at 157 (1976); S. Rep. No. 94-473, 94th Cong., 1st Sess., at 139 (1975) (emphasis added). The reports thus plainly indicate that the registration requirement of 411(a) is a responsibility imposed on the copyright owner—not the Copyright Office.

Section 411(a)'s text reflects that approach by affirming a copyright owner's right to sue for infringement notwithstanding the Copyright Office's refusal of registration. Section 411(a) requires that a copyright owner that chooses to proceed in this manner provide notice of the suit to the Register of Copyrights. Section 411(a) does not, however, specify that action by the Copyright Office one way or another is a prerequisite to suit. Nor does it mandate—as Congress could easily have done—that absent a refusal, a certificate of registration is required to sue. Instead, Congress empowered "court[s] of competent jurisdiction" overseeing infringement actions to determine the acceptability of the "application, deposit, and fee" and to confirm a copyright owner's ability to sue as necessary. 17 U.S.C. § 410(d).

In marked contrast to section 411(a), section 410(c) provides that, in certain circumstances, "a certificate

of registration" from the Copyright Office "shall constitute *prima facie* evidence of the validity of the copyright and of the facts stated in the certificate" in an infringement action. 17 U.S.C. § 410(c). While a certificate can thus provide a copyright owner some benefit in litigation, there is no *requirement* that the copyright owner obtain and submit a certificate, or be denied a certificate, before the owner can *file* the suit. Indeed, section 410(c) is compelling proof that, if Congress had intended to require a plaintiff to produce a certificate of registration to sue under section 411(a), it knew how to draft a statute containing such a requirement.

B. Surrounding Provisions Of The Copyright Act Confirm That Registration Is "Made" Under Section 411(a) When A Copyright Owner Delivers The Required Deposit Of The Work And Other Registration Materials To The Copyright Office.

1. Copyright registration is governed as a general matter by section 408 of the Copyright Act, which provides that "the owner of copyright or of any exclusive right in the work *may obtain registration* of the copyright claim by delivering to the Copyright Office the deposit specified by this section, together with the application and fee specified by sections 409 and 708." 17 U.S.C. § 408(a) (emphasis added). This language indicates that a copyright owner makes registration of a work by satisfying three criteria. *First*, the owner must deposit the required copies of the subject work with the Copyright Office, as determined by section 408(b) and regulations thereunder. *See id.* § 408(b).

Second, the owner must file a registration application that provides basic information about the work, such as the name and address of the claimant, the title of the work, and year in which the work was completed. *See id.* § 409. *Third*, the owner must pay the Copyright Office the appropriate registration fee. *See id.* § 708(a)(1); 37 C.F.R. § 201.3.

Section 408(a) speaks in terms of a copyright owner's "obtain[ing]" registration of a work by fulfilling the three requirements, and the interaction of section 408 with section 405(b) shows that registration is "made" in that manner. Section 405(b) immunizes a narrowly defined class of "innocent" infringers from liability for actual or statutory damages. 17 U.S.C. § 405(b). That immunity is limited, however, to "infringing acts committed before receiving actual notice that registration for the work has been made under section 408." *Id.* Section 405(b) thus uses the same syntax as section 411(a)—registration "has been made"—and links that process to section 408, which, as noted, permits copyright owners to obtain registration by depositing copies of the work, filing an application, and paying a fee. That linkage is strong evidence that registration is "made" in the same way for purposes of section 411(a)—i.e., by the copyright owner rather than the Copyright Office.[5]

---

[5] Petitioner's reading of the Copyright Act is consistent with Congress's use of similar language in other statutes to indicate that registration is "made" by filing a document with a government agency or official. For example, 2 U.S.C. § 505 requires United States Senators to "register quarterly with the Secretary of the

Section 408(c)(3) provides additional support for this reading. Section 408(c)(3) explains that "a single renewal registration" for a pre-1978 work "*may be made* for a group of works by the same individual author ... *upon the filing of a single application and fee.*" 17 U.S.C. § 408(c)(3) (emphases added). A copyright owner files an application and pays the fee, such that registration under this provision is "made" by the copyright owner—just as the owner makes registration under section 411(a) by delivering to the Copyright Office the work at issue, an application, and the appropriate fee.

Another subsection of section 411 regarding registration and civil infringement actions further confirms Petitioner's reading of subsection (a). Section 411(c) permits a copyright owner to file suit against an infringer for a work "consisting of sounds, images, or both" that is fixed simultaneously with transmission if, among other things, "*the copyright owner ... makes registration for the work*, if required by subsection (a), within three months after its first transmission." 17 U.S.C. § 411(c) (emphasis added). This provision expressly designates the copyright owner as the party that "makes registration," without

---

Senate" their dissemination of "mass mailings" using the franking privilege. "Such registration shall be made by filing with the Secretary a copy of the matter mailed and" additional information regarding the mailing. *Id.* In other words, the Senator, not the Secretary, "makes" registration. Other statutes likewise speak of "registration" being "made" by the submitting party rather than the recipient. *See, e.g.*, 15 U.S.C. § 1173(a)(4) ("[R]egistration is made" by persons engaged in manufacturing, buying, repairing, and selling "gambling device[s]."); 45 U.S.C. § 362(i) ("[R]egistration is made" by unemployed railroad employees.)

referring to action by the Copyright Office. Moreover, section 411(c) cross-references section 411(a) immediately after, indicating that "the copyright owner ... makes registration for the work," thus offering additional clear proof that Congress intended that the copyright owner, and not the Copyright Office, "makes registration" under section 411(a).

Section 412, as well, employs the phrase "registration is made" to identify action taken by the copyright owner. Section 412 limits the remedies available in infringement suits in some circumstances; it mandates that a court may not award statutory damages or attorney's fees for any infringement that "commenced after first publication of the work and before the effective date of its registration, unless such *registration is made* within three months after the first publication of the work." *Id.* § 412(2) (emphasis added). Apart from negating the right to bring timely action to address infringement, to say that "registration is made" only after the Copyright Office issues a certificate would undermine the ability of a copyright owner to seek statutory damages and attorneys' fees even when the owner has promptly submitted its registration materials upon publication—directly contrary to Congress' design.

2. Respondents' suggestion that section 408(f)'s preregistration provision and section 411(c)'s live broadcast provision mitigate the severe consequences of their statutory interpretation is misleading and not borne out by experience.

Section 408(f) permits preregistration of certain categories of unpublished works in the Register's discretion while the works are "being prepared for commercial distribution." Section 411(c) authorizes injunctive relief in the case of live broadcasts that are fixed simultaneously with transmission. These provisions exclude finished and published works, which account for the vast majority of works that copyright owners seek to register, from their specialized procedures. Notably, only a tiny fraction—0.17 percent—of all registrations processed by the Copyright Office in 2017 were preregistrations. *See* U.S. Copyright Office, Fiscal 2017 Annual Report, https://www.copyright.gov/reports/annual/2017/ar2017.pdf. Moreover, both provisions are conditioned upon follow-up registration by the copyright owner. Indeed, section 411(c) requires that the owner "mak[e] registration for the work, if required by subsection (a), within three months after its first transmission." 17 U.S.C. § 411(c). Under Respondents' reading of the statute, it is unlikely that an owner could successfully "make registration" within the three-month window given the current lag time at the Copyright Office. *See* Part III.A, *infra*.

II. IN ENACTING SECTION 411(a), CONGRESS SOUGHT TO ENSURE THAT THE COPYRIGHT OFFICE WOULD NOT BE A BARRIER TO A COPYRIGHT OWNER'S RIGHT TO TIMELY JUDICIAL RELIEF AGAINST INFRINGERS

A. This Court's Longstanding Presumption In Its *Washingtonian* Opinion Forecloses Respondents' Interpretation.

Congress enacted the Copyright Act of 1976 against the backdrop of this Court's decision in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939), which established a strong presumption in favor of interpreting the Copyright Act to preserve a copyright owner's exclusive rights.

In *Washingtonian*, the Court addressed the requirements for filing an infringement suit under an earlier statutory framework, the Copyright Act of 1909. *See* 306 U.S. at 36-42. The defendant in *Washingtonian*, an alleged infringer of magazine articles, argued that the plaintiff's suit could not proceed because the plaintiff had not deposited copies of the articles "promptly" with the Copyright Office, as required under that earlier statute, but instead had waited until 14 months after publication. *See id.* at 35-36. Although the plaintiff deposited the required copies before filing suit, the defendant maintained that plaintiff's delay foreclosed the action. *See id.* at 39.

The Court rejected that argument. Observing that "promptly" was not defined in the 1909 Act, the Court

declared that "forfeiture[]" of a copyright owner's right to sue is "never to be inferred from doubtful language." *Id.* at 42. Although there were "[p]lausible arguments" for the defendant's reading of the statute, mere plausibility was not enough to preclude copyright owners from enforcing their exclusive rights, the value of which "depended upon the possibility of enforcement." *Id.* at 39.

Congress was aware of the *Washingtonian* decision in crafting the 1976 Act,[6] and legislated against the backdrop of *Washingtonian*'s clear-statement rule in enacting section 411(a). *Cf. Am. Broad. Companies, Inc. v. Aereo, Inc.*, 134 S. Ct. 2498, 2505 (2014) (interpreting other provisions of the 1976 Copyright Act enacted by Congress in response to this Court's decisions in *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390 (1968), and *Teleprompter Corp. v. Columbia Broad. Sys., Inc.*, 415 U.S. 394 (1974)).

Here, where the language of the statute as a whole supports Petitioner's reading, it would be especially unfaithful to Congress' purpose to read into section 411(a) a forfeiture of the essential rights of copyright on account of administrative delay by the Copyright Office. Such an encroachment on a copyright owner's intellectual property is neither mandated by section 411(a)'s text nor consistent with the Act's overall structure or purpose. As in *Washingtonian*, the Court should instead interpret section 411(a) to preserve the

---

[6] *See, e.g.*, Copyright Law Revision, Hrg. Before the Subcomm. on Patents, Trademarks, and Copyrights of the S. Comm. on the Judiciary, 89th Cong., 1st Sess., at 101 (Aug. 1965) (statement of John Schulman, Chairman for Revision of Copyright Law, American Bar Association) (discussing *Washingtonian*).

ability of copyright owners to enforce their exclusive rights. *See* 306 U.S. at 42.

B. Congress' Rejection Of A Pre-Suit Mandamus Requirement In The 1976 Act Validates Petitioner's Reading.

In the Copyright Act of 1909, Congress had provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until" the statute's requirements for "deposit of copies and registration of such work have been complied with." 17 U.S.C. § 12 (1939). Some courts interpreted this precursor to section 411(a) as barring a copyright owner from suing for infringement if the Copyright Office refused to register the work (or works) at issue, including the Second Circuit in *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 640-41 (2d Cir. 1958). Under the rationale of *Vacheron*, a copyright owner was required to first bring a separate mandamus action against the Register to compel issuance of a certificate of registration before filing an infringement action. *See id.*

Congress paid close attention to the *Vacheron* outcome in crafting the 1976 Act. A study on copyright registration authorized by Congress to aid in overhauling the Copyright Act, explained that *Vacheron* "appear[ed] to go the whole way in holding that the plaintiff cannot maintain an infringement action without having procured a registration certificate." Benjamin Kaplan, *Study No. 17—The Registration of Copyright* at 31 n.* (Aug. 1958). Professor Kaplan expressed concern with such an approach: "Surely [the

prerequisite of deposit and registration] cannot mean that a claimant is altogether barred from an infringement action where the Register has wrongfully refused to issue a certificate; for it is agreed that the Register's determination is not conclusive." *Id.*

Congress responded to this concern by "alter[ing] the [then-] present law as interpreted in [*Vacheron*]." H.R. Rep. No. 94-1476, at 157 (citing *Vacheron*, 260 F.2d at 237). To ensure that copyright owners would not lose valuable rights as a consequence of the Copyright Office's administrative role, the 1976 Act altered the 1909 Act rule by expressly permitting copyright owners to sue for infringement without a certificate in hand. *See* 17 U.S.C. § 411(a); *see also* H.R. Rep. No. 94-1476, at 157. The effective date of registration was established as the date on which the required application, deposit of the work, and fee were submitted to the Office, as determined either by the Register or "a court of competent jurisdiction." 17 U.S.C. § 410(d). With these changes, Congress intended to address not only "the possibility that a court might later find the Register wrong in refusing registration," but also "the inevitable timelag between receipt of the application and other material and the issuance of [a] certificate." *See* H.R. Rep. No. 94-1476, at 157; S. Rep. No. 94-473, at 139.

Congress' rejection of the *Vacheron* approach underscores the considered judgment that the Copyright Office is not a gatekeeper for the judicial enforcement of copyrights. Although the Copyright Office plays an important role in administering the Copyright Act, its function regarding registration is a limited one. Unlike the Patent Office, the Copyright Office does not

compare or assess the work deposited against prior material. As explained by Professor Kaplan in reporting to Congress, "the [copyright] examiner does not and cannot investigate at large .... He is certainly not expected to check whether the work duplicates a previously copyrighted work or a work in the public domain." Kaplan at 35; *see* Caruthers Berger, *Study No. 18—Authority of the Register of Copyrights to Reject Applications for Registration*, at 94 (Mar. 1959) ("The functions of the Register in regard to the registration of claims may be characterized as ministerial."); *see also, e.g.*, Compendium of U.S. Copyright Office Practices §§ 309.1 (Office "will not compare the deposit copy(ies) with other works" in determining whether a work is copyrightable); 309.2 ("Ordinarily, the Office will not conduct its own factual investigation to confirm the truth of the statements made in the application.").

III. RESPONDENTS' RULE WOULD DENY COPYRIGHT OWNERS MEANINGFUL PROTECTION OF THEIR STATUTORY RIGHTS

A. The Copyright Office Typically Takes Months And Sometimes Years To Carry Out Its Administrative Function And Issue A Certificate.

Due to the human and technological constraints of the Copyright Office, the gap between when a copyright owner submits its registration materials to the Office and the Office's issuance of a certificate of registration is significant—a span of seven to nine months on average and more than two years in some

instances. *See* U.S. Copyright Office, *Registration Processing Times*, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (accessed Aug. 31, 2018). As noted above, Congress recognized a "time-lag" in the registration function when it enacted the 1976 Act, H.R. Rep. No. 94-1476, at 157, and delays remain "a source of constant concern" today. *Oversight of the U.S. Copyright Office: Hearing Before the Subcomm. on Courts, Intellectual Property, and the Internet of the H. Comm. on the Judiciary*, 113th Cong. 8-9 (2014) (statement of Maria Pallante, Register of Copyrights).

The lag time has been increasing in recent years. Between 2012 and 2015, the average processing time from online submission to issuance of a certificate rose from 3.1 months to 4.4 months, while the average processing time for paper submissions rose from 4.8 months to 13.5 months. *FY 2016 Appropriations Questions for the Record*, H. Comm. on Appropriations (Mar. 10, 2015). The current processing of online submissions averages from seven to nine months and for paper submissions is from nine to 16 months. *See Registration Processing Times, supra*, at 1. Consistent with this trend, the Copyright Office began fiscal year 2016 with 249,000 open claims in the online registration system but ended the year with more than 316,000 claims in the system. *See Fiscal 2016 Annual Report*, Copyright Office, https://www.copyright.gov/reports/annual/2016/ar2016.pdf.

Amici's members experience these delays firsthand. Music publishers and record companies expend significant resources to register copyrights for musical works and sound recordings, which constitute

the core assets of and sources of income for the creators they represent. Individual songwriters and composers, as well, need to register their works to ensure enforceability of their copyrights. And the wait from the time of submission to issuance of certificate can be daunting. In the experience of *Amici*'s members, delays of a year or more are not uncommon.

To cite recent examples, on April 11, 2017, a music publisher submitted its registration materials for a musical work written by Justin Timberlake and four other songwriters titled "Hair Up." *See* Copyright Office, Case No. 1-4853126911.[7] Although the registration submission included the required payment, deposit of the work, and application, the Office still has not issued a certificate of registration or refused to do so—a delay of 14 months and counting. Similarly, registration materials for a musical work titled "#1 Record for Christmas" by Neil Diamond were submitted to the Copyright Office on February 2, 2017, with all of the statutory requirements completed on that date. *See* Copyright Office, Case No. 1-4399057193. The certificate of registration has yet to be issued—a delay of more than 16 months.

Indeed, the administrative delay at the Copyright Office sometimes exceeds the three-year limitations period to sue for infringement, and could eliminate a

---

[7] All references to matters pending before the Copyright Office are based on records from the Office's eCO electronic registration system.

copyright owner's right to sue altogether if Respondents' interpretation of section 411(a) were adopted.[8] For instance, a music publisher submitted its application and fee for "Just Another Dude," a musical work by David Julca and three other songwriters, on August 17, 2015, and submitted the deposit required by section 408(a) shortly thereafter. Nevertheless, more than three years later, neither a certificate nor a refusal has issued. *See* Copyright Office, Case No. 1-2645541581.

Amici's members who register sound recordings report similar experiences. Depending upon whether the sound recording deposit is provided in a digital or physical format, the typical delay for issuance of a certificate ranges from five to 11 months, but—as in the case of musical works—can sometimes exceed three years. The wait time with respect to the album art accompanying a physical product, which is also eligible for registration, can be lengthier than that for the music.

Although the Copyright Office offers a "special handling" procedure for an added fee to expedite its administrative function, that does not solve the problem. The "special handling" accommodation is not a statutory requirement, but rather a voluntary procedure implemented by the Office and made available "at the discretion of the Register of Copyrights in a limited number of cases." *Policy Decision Announcing Fee for Special Handling of Applications for Copyright Registration*, 47 Fed. Reg. 19,254 (May 4, 1982); *see*

---

[8] "No civil action shall be maintained under the provisions of [Title 17] unless it is commenced within three years after the claim accrued." 17 U.S.C. § 507(b).

also Copyright Office Compendium § 623.2 (special handling request may be denied). The Copyright Office may refuse a "special handling" request if it deems the request insufficiently justified or simply because it lacks the capacity based on workload to expedite the process. *Copyright Office Compendium* § 623.2. Moreover, the procedure does not ensure that a copyright owner will receive a response within a particular time; the Office attempts to process expedited requests within five working days, but it expressly disclaims any guarantee that it will meet that target and is not under any obligation to do so. *See id.* § 623.4.

The fee for "special handling" (which is in addition to the regular registration fee) is currently $800, and the Copyright Office recently proposed to raise it to $1,000. 83 Fed. Reg. 24,054, 24,060 (May 24, 2018). In the current online environment, digital song files can be readily and rapidly distributed without authorization to others via the Internet. A single infringer may be infringing hundreds or even thousands of works of a record company or music publisher, many of them still awaiting a registration certificate. "Special handling" may be prohibitively expensive in such a case. Moreover, the cost of paying an additional $800 or $1000 per registration to file suit for an injunction may be beyond the reach of smaller publishers or labels, to say nothing of individual music creators. But even if it is feasible for a copyright owner to pay the required fees, the Copyright Office may lack the capacity to handle a large number of requests in an expedited fashion.

B. To Delay For Months Or Years A Copyright Owner's Right To Seek Injunctive Or Other Judicial Relief Effectively Abrogates That Right.

The right of a copyright owner to seek judicial relief against infringement is perhaps the most fundamental right recognized under copyright law. Since at least 1710, with the Statute of Anne, the first English copyright statute, copyright owners have been afforded the right to sue for infringement of their works. *See Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 349-50 (1998). In the United States, this right has been recognized since before the adoption of the Constitution, and it has been part of federal copyright law since the first federal copyright statute, the Copyright Act of 1790. *See id.* The need to afford copyright owners the right to seek judicial relief is obvious—a copyright lacks value if its creator cannot enforce it through the courts against infringers. *See Washingtonian*, 306 U.S. at 40 ("Without right of vindication a copyright is valueless."). Injunctive relief against ongoing infringement is particularly significant to protect the exclusivity of a copyright. *See* 17 U.S.C. § 502(a) (court may award injunction to "prevent or restrain infringement of a copyright").

Congress enacted section 411(a) and other provisions of the Act as incentives for copyright owners to register their works under a voluntary system and to ensure a flow of deposit materials to the Library of Congress. *See* H.R. Rep. No. 94-1476, at 150 (finding that the 1976 Act's various "increased inducements for voluntary registration and deposit" would result in

"a more effective deposit system" for the Library of Congress). The incentives include the ability to seek legal redress against infringers, a *prima facie* presumption of validity of a copyright in litigation, and entitlement to statutory damages and attorneys' fees. *See* 17 U.S.C. §§ 410-12. In providing such incentives, Congress did not mean to defeat copyright owners' right to sue for infringement. A reading of the statute that permits the filing of an action once the required registration materials have been submitted by the owner to the Copyright Office is fully consistent with Congress' objectives, as a copyright owner has no less an incentive (and in fact may have a greater incentive) to register its works due to the availability of suit. *See Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 620 (9th Cir. 2010) (goal of registration "is accomplished equally by the registration and application approach").

On the other hand, to delay the right to sue infringers until issuance or refusal of a certificate by the Copyright Office would curtail, and in some cases eliminate, for no discernable reason, a copyright owner's ability to enforce its exclusive rights. As a leading commentator has explained, such a rule would consign copyright owners to a "legal limbo" while they wait for an under-resourced agency to take action. 2 Nimmer on Copyright § 7.16[B][3][b][ii]. This scenario makes no sense in light of the overall design and purpose of the 1976 Act. *See United States v. Hayes*, 555 U.S. 415, 426 (2009) (relying on "[p]ractical considerations" in interpreting statute).

For music creators and owners, such an approach is particularly pernicious because digital piracy of musical works and sound recordings works is especially prevalent at the time of initial release. At the same time, this is the period during which a work may have its highest earning potential. The inability to seek an injunction until the Copyright Office is able to act deprives music copyright owners of the most basic right of a copyright owner to protect its works against infringement.

Section 411(a) should not be read "in a vacuum" but in context and "with a view to [its] place in the overall statutory scheme." *Roberts v. Sea-Land Servs., Inc.*, 566 U.S. 93, 101 (2012). As demonstrated by the statutory text and confirmed by the structure, purpose, and legislative record of the 1976 Copyright Act, an interpretation of section 411(a) that diminishes copyright owners' exclusive rights by undermining the ability to enforce them in court is not only misguided, but the opposite of what Congress intended and enacted as law.

CONCLUSION

For the foregoing reasons, the Eleventh Circuit's judgment should be reversed.

Respectfully submitted.

Jacqueline C. Charlesworth
COVINGTON & BURLING LLP
620 Eighth Avenue
New York, NY 10018
(202) 841-1000
jcharlesworth@cov.com

Beth S. Brinkmann
Counsel of Record
Kevin F. King
Rafael Reyneri
COVINGTON & BURLING LLP
850 Tenth Street, NW
Washington, DC 20001
bbrinkmann@cov.com
(202) 662-6000

Counsel for Amici Curiae

September 4, 2018

APPENDIX: DESCRIPTIONS AND INTERESTS OF *AMICI CURIAE*

1. The National Music Publishers' Association (NMPA) is the principal trade association representing the U.S. music publishing and songwriting industry. Over the last 100 years, NMPA has served as a leading voice representing American music publishers before Congress, in the courts, within the music, entertainment, and technology industries, and to the listening public. NMPA's membership includes major music publishers affiliated with record labels and large entertainment companies as well as independently owned and operated music publishers of all catalog and revenue sizes. Compositions owned or controlled by NMPA's hundreds of members account for the vast majority of musical works licensed for commercial use in the United States

2. The Recording Industry Association of America (RIAA) is a nonprofit trade organization representing the American recording industry. RIAA supports and promotes the creative and financial vitality of the major recorded music companies. Its members are the music labels that comprise the most vibrant record industry in the world. RIAA members create, manufacture, and/or distribute approximately 85 percent of all legitimate recorded music produced and sold in the United States. In support of its members, the RIAA works to protect the intellectual property and First Amendment rights of artists and music labels; conducts consumers consumer, industry, and technical research; and monitors and reviews state and federal laws, regulations, and policies. The

RIAA protects the ability of the music business to invest in new brands and new music and, in the digital arena, to give online services space to continue to prosper.

3. The American Society of Composers, Authors and Publishers (ASCAP), the first performing rights organization (PRO) in the United States, was formed in 1914 at the behest of composing legends Victor Herbert, Irving Berlin, and John Phillip Sousa. Its mission is to enable American music authors to receive fair remuneration for the public performance of their works. ASCAP's over 670,000 songwriters, lyricists, composers, music publishers, and foreign society members grant the society a nonexclusive right to license public performances of their works. As a PRO, ASCAP offers blanket licenses to a wide variety of users and also engages in enforcement efforts to protect its members' copyrights.

4. Broadcast Music, Inc. (BMI), a global leader in music rights management, was founded in 1939 by forward-looking thinkers who wanted to represent songwriters in emerging genres such as jazz, blues, and country, and to protect the public performances of their music. BMI represents the public performance rights in nearly 13 million musical works created and owned by more than 800,000 songwriters, composers and publishers. As a PRO, the company negotiates music license agreements for the public performance of nondramatic musical works and distributes the fees it generates as royalties to its affiliated writers and publishers. BMI also serves as advocate for the value of music, representing its members' interests in the courts and to Congress.

5. The Nashville Songwriters Association International (NSAI) is the world's largest not-for-profit trade association advocating for the interests of songwriters, with approximately 5,000 members and 100 chapters in the United States and ten other countries. Founded in 1967 by Eddie Miller, Marijohn Wilkin, Kris Kristofferson, Felice and Boudleaux Bryant, Liz and Casey Anderson, and others, NSAI is dedicated to protecting the rights of songwriters in all genres of music and addressing needs unique to the songwriting profession. In addition to its legal and legislative advocacy work, NSAI offers programs and services designed to provide education and career opportunities for songwriters at every level. It also owns The Bluebird Cafe, a legendary songwriter performance venue in Nashville, Tennessee.

6. Songwriters of North America (SONA) is a grassroots advocacy organization founded in 2015 by songwriting partners and co-executive directors Michelle Lewis and Kay Hanley to advocate for the rights of songwriters in the digital age. A fast-growing organization, SONA has a membership of over 650 full-time, professional songwriters who devote their extra time and energy to the defense of their creative intellectual property before the courts and in Congress. SONA has played a leading role in challenging unfairness to songwriters under current U.S. music licensing laws and advocating for comprehensive legislation to create a more modern and balanced licensing system, currently pending before Congress.

No. 17-571

IN THE

Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
Petitioner,
v.
WALL-STREET.COM, LLC, ET AL.,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

BRIEF OF PUBLIC KNOWLEDGE AND THE R STREET INSTITUTE AS *AMICI CURIAE* IN SUPPORT OF RESPONDENTS

HAROLD FELD
Counsel of Record
MEREDITH F. ROSE
PUBLIC KNOWLEDGE
1818 N Street NW Ste 410
Washington, DC 20036
202-861-0020
hfeld@publicknowledge.org
Counsel for Public Knowledge

CHARLES DUAN
R STREET INSTITUTE
1212 New York Ave NW Ste 900
Washington, DC 20005
202-525-5717
cduan@rstreet.org
Counsel for R Street Institute

TABLE OF CONTENTS

TABLE OF CONTENTS I

TABLE OF AUTHORITIES II

INTEREST OF AMICUS CURIAE 1

SUMMARY OF ARGUMENT 2

ARGUMENT 5

I. Permitting the Filing of Registration on the Eve of Suit Will Leave the Register Incomplete and Inconsistent 5

II. Public Policy Favors a Complete and Comprehensive Public Record of Ownership ... 7

A. The Registration Record Is Only Valuable To The Extent That It Is Complete 7

B. Incentives Aimed Toward Comprehensive Registration Ameliorate the Problem of Orphan Works 9

III. Congress Has Consistently Sought to Promote the Completeness of the Public Record and Discourage Delayed Registration 13

A. Congress Explicitly Sought To Prevent Delayed Registration 13

B. Congress Deliberately Preserved Registration To Promote A Public Record 14

CONCLUSION 16

TABLE OF AUTHORITIES

Cases

Silvers v. Russell, 113 F. Supp. 119 (1953) 11

Washingtonian Publishing Co. v. Pearson, 306 U.S. 30 (1939) 5

Statutes

An Act to Amend and Consolidate the Acts Respecting Copyright, ch. 320, 35 Stat. 1075 (1909) 13

Other Authorities

Alan Latman, *Study 19: The Recordation of Copyright Assignments and Licenses, in* COPYRIGHT LAW REVISION: STUDIES PREPARED FOR THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS 111 (1956) 14

Arthur J. Levine & Jeffrey L. Squires, *Notice, Deposit and Registration: The Importance of Being Formal*, 24 UCLA L. REV. 1232 (1977) 13

Cassidy R. Sugimoto, *The Academic Advantage: Gender Disparities in Patenting*, 10 PLoSONE 5 (2015) 9

CPI Inflation Calculator, U.S. BUREAU OF LABOR STAT., https://data.bls.gov/cgi-bin/cpicalc.pl (last visited Sep. 21, 2018) 12

H.R. Rep. No. 94–1476 (1976) 12

INT'L FED'N OF THE PHONOGRAPHIC INDUS., *Investing in Music: The Value of Record Companies* (2016) 6

Kyle Jensen et al., *Gender Differences in Obtaining and Maintaining Patent Rights*, 36 NATURE BIOTECHNOLOGY 307 (2018) 10

Louis Johnston & Samuel H. Williamson, *What Was the U.S. GDP Then?*, MeasuringWorth (2018), https:// www. measuringworth. com/ datasets/ usgdp/ result. php 6

Maria A. Pallante, *The Curious Case of Copyright Formalities*, 28 BERKELEY TECH. L. J. 1415 (2013) 7

MARIA A. PALLANTE, U.S. COPYRIGHT OFFICE, *Orphan Works and Mass Digitization: A Report of the Register of Copyrights* 35 (2015). 8, 9

MARYBETH PETERS, U.S. COPYRIGHT OFFICE, *Report on Orphan Works* (2006). 7, 8

RECORDING INDUS. ASS'N OF AM., *Labels At Work: The Music Business in the Digital Age* (2018) 6

STEPHEN E. SIWEK, *Copyright Industries in the U.S. Economy* (International Intellectual Property Alliance 2014) 6

INTEREST OF AMICUS CURIAE

Public Knowledge[1] is a non-profit organization that is dedicated to preserving the public's access to knowledge, promoting creativity through balanced intellectual property rights, and upholding and protecting the rights of consumers to use innovative technology lawfully. Public Knowledge advocates on behalf of the public interest for a balanced copyright system, particularly with respect to new and emerging technologies.

The R Street Institute is a non-profit, non-partisan public-policy research organization. R Street's mission is to engage in policy research and educational outreach that promotes free markets, as well as limited yet effective government, including properly calibrated legal and regulatory frameworks that support economic growth and individual liberty.

---

[1] Pursuant to Supreme Court Rule 37.3(a), this brief is submitted under parties' blanket consents of Jul 24-25, 2018. Pursuant to Rule 37.6, no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of the brief. No person or entity, other than amicus, its members, or its counsel, made a monetary contribution to the preparation or submission of this brief.

SUMMARY OF ARGUMENT

The Court should be wary of Petitioner's "application approach" to the registration requirement of 17 U.S.C. § 411(a), as it severely limits the incentive structure, policy rationale, and stated Congressional intent underlying § 411(a)'s registration requirement. By contrast, the "registration approach," adopted by the court below, provides better outcomes on all three fronts.

The Court has before it two opposing interpretations of § 411(a)'s registration language. Petitioners contend that "registration" for the purposes of this section occurs at the moment of filing, while respondents argue that a work is only "registered" once its application has been accepted or rejected by the Register of Copyrights. Aside from parties' rhetorical incongruity, these two visions of registration manifest two completely different incentive structures, with a rational actor approaching registration differently in each case. By withholding the ability to litigate until after the Register of Copyrights has completed the registration process, the "registration approach" espoused by respondents encourages prompt, prophylactic registration well in advance of any potential litigation. In essence, it creates a deterrent against skipping—or untimely making—registration of a work. Conversely, the application approach treats registration as a litigation "step zero" whose value is limited only to cases where an infringement has occurred and litigation is desirous (or inevitable).

This is at odds with the fundamental policy rationale of registration, namely maintaining a

comprehensive public record of ownership in copyrighted works (a category that grows larger with each passing revision of the statute). The size, scope, and growth rate of copyright-reliant industries makes this uniquely important. That same boom growth amplifies the risks posed by orphan works—those works whose owners, due to an incomplete or untimely public record, cannot be determined, and which represent a substantial, endemic risk to the licensing marketplace.

In addition to forestalling those dangers, the data provided by a robust public record can prove exceedingly useful to researchers and policymakers, as demonstrated by the insightful research conducted on the Patent and Trademark Office's public datasets. This is uniquely important to anyone seeking to study the dynamics creative industries, where complex legal regimes, poor historical recordkeeping, and opaque business practices create a dearth of reliable data.

When drafting the 1976 Act, Congress was well aware of the risks that removing formalities posed to the public record. By preserving and modifying the registration requirement into its modern form, Congress expressly sought not to erase, but to *improve upon* the 1909 Act's mandatory registration system as a tool of public record keeping. Missing and tardy registrations were a well-documented problem by 1976, and the legislative record shows that Congress actively sought to ameliorate the problem by the provisions of the new Act.

In light of these logical incentives, policy rationales, and the stated Congressional intent

underlying § 411(a)'s registration requirement, the Court should uphold the decision below.

ARGUMENT

Registration of a work with the United States Copyright Office, though no longer prerequisite for copyright protection, continues to serve an important function in the modern licensing market. When correctly implemented and maintained, registration provides a public record of ownership, tracking who owns what works, and thus providing potential licensees with information that is both practically and legally indispensable to making use of the work.

The notion that the provisions of 17 USC § 411 are nothing more than a vestigial remnant of the old system ignore both the public policy rationale underlying modern formalities, and Congress's explicit intent in crafting those formalities. Not only are modern formalities more critical than ever, but they were explicitly designed to encourage *greater* and more comprehensive registration than occurred under the old system—an outcome that can only be meaningfully achieved by upholding the "registration approach" adopted by the court below.

I. PERMITTING THE FILING OF REGISTRATION ON THE EVE OF SUIT WILL LEAVE THE REGISTER INCOMPLETE AND INCONSISTENT

Petitioners' view—that the benefits of registration are available immediately upon application to the Copyright Office—treats the registration requirement as little more than a strategic prelude to litigation, rather than a reflection of a Congressional policy to encourage a

public record. A rational actor in this scenario would only seek to register their works once (1) an infringement has occurred, and (2) the rightsholder has decided to litigate. This skews incentives away from proactive registration; indeed, absent imminent litigation, a rational rightsholder has little incentive to invest the requisite time and money to register.

Under this approach, the record created by registration is substantially diminished: Rather than being a substantially comprehensive list of ownership, the record reduces down to those works which have been, or will soon be, litigated. This is a far cry from the full public record that Congress sought to achieve by the incentives structure embodied in the 1976 Act.

Respondents' view, by contrast, incentivizes a wider range of rightsholders to register *before* the potential for litigation looms. As noted below, Congress explicitly designed the 1976 Act, with its penalties for non-registration and delay, with the intent "to produce a more effective deposit system than the present [mandatory] one." H.R. Rep. No. 94–1476, at 150. If infringement suits can commence only *after* the Register has examined the work and issued a certificate, then creators have greater incentive to submit their registration as close in time to the moment of fixation as possible—in other words, to create a near-contemporaneous entry in the public record of their ownership.

This is a feature, not a bug. By encouraging copyright holders to preemptively file for registration rather than waiting until an

impending lawsuit, the statute encourages registration by a wider swath of creators—all who might *possibly* want to file suit in the future, rather than only those who will *actually* sue. This most clearly effectuates a holistic, comprehensive public record of ownership.

II. PUBLIC POLICY FAVORS A COMPLETE AND COMPREHENSIVE PUBLIC RECORD OF OWNERSHIP

A. The Registration Record Is Only Valuable To The Extent That It Is Complete

As software, news reporting, and other copyright-protected works have grown more central to the American economy, the importance of a licensee's ability to easily identify owners of these works, and to license these works, has also grown. As early as 1939, Justice Black noted:

> It is of far greater importance to the public today than it was in 1790, 1831, 1870, or 1891, that public record be made of copyright monopolies granted to further the arts and sciences, since these privileges have been extended by statute to include almost every conceivable type of production of the human mind.

Washingtonian Publ'g Co. v. Pearson, 306 U.S. 30, 54 (1939)) (Black, J., dissenting). That importance

has grown not only due to the increased scope of copyright-protectable works, but also due to their economic impact.

The copyright-dependent segments of the economy are large, and fast-moving. According to one industry study, industries that depend on copyright licensing accounted for over $1.9 trillion of U.S. GDP in 2013—an economic impact orders of magnitude greater than the total GDP at the time of the 1790 Act. STEPHEN E. SIWEK, *Copyright Industries in the U.S. Economy* 2 (International Intellectual Property Alliance 2014); Louis Johnston & Samuel H. Williamson, *What Was the U.S. GDP Then?*, MeasuringWorth (2018), https://www. measuringworth. com/ datasets/ usgdp/ result. php. The recording industry alone contracts with over 2,500 domestic streaming services in the United States, and licenses over 4 million tracks globally. *See* RECORDING INDUS. ASS'N OF AM., *Labels At Work: The Music Business in the Digital Age* 7 (2018); INT'L FED'N OF THE PHONOGRAPHIC INDUS., *Investing in Music: The Value of Record Companies* (2016).

To comply with the licensing requirements of copyright law, potential users—including businesses, filmmakers, educational and cultural institutions, to name only a few—need robust, reliable, and usable information. That in turn requires the existence of a comprehensive public ledger of protectable works. "The maintenance of a complete public record is vital to a functioning marketplace for the transfer of rights in copyrighted works and, concomitantly, their exploitation in both original and derivative forms."

Arthur J. Levine & Jeffrey L. Squires, *Notice, Deposit and Registration: The Importance of Being Formal*, 24 UCLA L. REV. 1232, 1253 (1977).

To be useful, the public record must be comprehensive; to be comprehensive, it must be promptly and regularly updated. Because copyright protection inheres at the moment of fixation, the onus for maintaining the record's timeliness falls on copyright holders, who hold all the necessary information to keep the record up-to-date. "It goes without saying that we cannot build a robust and accurate database of copyright title unless copyright owners provide the necessary data." Maria A. Pallante, *The Curious Case of Copyright Formalities*, 28 BERKELEY TECH. L. J. 1415, 1421 (2013). A licensee cannot reasonably trust an out-of-date record any more than a policy advocate can rely on a seven-month-old newspaper.

B. Incentives Aimed Toward Comprehensive Registration Ameliorate the Problem of Orphan Works and Generate Scientifically and Socially Useful Data

When a potential licensee cannot identify the owner of a copyright, they face what is known as an "orphan work" problem. An orphan work is one where "the owner of a copyrighted work cannot be identified and located by someone who wishes to make use of the work in a manner that requires permission of the copyright owner." MARYBETH PETERS, U.S. COPYRIGHT OFFICE, *Report on Orphan Works* 1 (2006). In these scenarios, "the user cannot

identify and/or locate the owner and therefore cannot determine whether, or under what conditions, he or she may make use of the work." MARIA A. PALLANTE, U.S. COPYRIGHT OFFICE, *Orphan Works and Mass Digitization: A Report of the Register of Copyrights* 35 (2015).

A potential licensee is faced with a choice: find a substitute work (which may not serve their needs), or use the orphan work, with a risk that "the copyright owner could emerge after the use has commenced and seek substantial remedies, including "substantial infringement damages, injunctions, and attorneys' fees." *Id.* at 38.

Orphan works are a known, and much-debated problem in copyright: They have been the subject of two multi-year Copyright Office studies, which referred to their proliferation as a "major source of gridlock in the digital marketplace." *Id.* at 35. They have been called "the starkest failure of the copyright framework to adapt," *id.* at 28, and also a "by-product of the United States' modern copyright system [that] has been with us since the day the 1976 Act went into effect." PETERS, *supra* at 43.

While the stymieing of one potential licensee is a nuisance, the aggregate impact of these obstacles is substantial. The burden of orphan works is, at present, a "major cause of gridlock in the digital marketplace":

> The consequences of this uncertainty reverberate through all types of uses and users, all types and ages of works, and across all creative sectors. By

> electing to use a work without permission, users run the risk of an infringement suit resulting in litigation costs and possible damages. By foregoing use of these works, a significant part of the world's cultural heritage embodied in copyright-protected works may not be exploited and may therefore fall into a so-called "20th century digital black hole." This outcome is difficult to reconcile with the objectives of the copyright system and may unduly restrict access to millions of works that might otherwise be available to the public.

Pallante, *Orphan Works and Mass Digitization*, supra at 35.

Not only does spotty registration damage search and licensing efforts by users, but it also deprives researchers and scientists of useful data. The Patent and Trademark Office releases and updates comprehensive datasets on its patent and trademark filings. These have proven to be fertile ground for researchers studying the demographics of market participation and innovation. The Office's Patent Claim, Examination, and Assignment Datasets have provided a wealth of valuable insight. Using these datasets, researchers have learned that patenting rates among women applicants have climbed substantially in the past decades. Cassidy R. Sugimoto, *The Academic Advantage: Gender Disparities in Patenting*, 10 PLoSONE 5 (2015), However, researchers also discovered that the gender gap—with women

comprising only 10% of patent holders—is strongly tied to several structural problems, including higher rejections for traditionally female-sounding names, as well as systematic disparities in rejection rates, limiting language, and appeals outcomes. Kyle Jensen et al., *Gender Differences in Obtaining and Maintaining Patent Rights*, 36 NATURE BIOTECHNOLOGY 307 (2018).

Copyright, despite its centrality to the modern economy, generates no comparable wealth of data. What little information is available is provided largely by corporate players, who have a vested interest in portraying their investments and market conditions in the most favorable possible light. Moreover, complex private ordering of licensing, ownership transfers, and work-for-hire provisions—compounded by a pervasive use, in some sectors, of non-disclosure agreements—makes gleaning a real picture of these markets a Herculean task. *See, e.g.*, Joseph F. Aceto, *Intellectual Property Licensing and Confidentiality Agreements, an Overview*, Am. Mgmt. Ass'n (last visited Oct. 17, 2018), https:// www. amanet. c g/ training/ articles/ intellectual- property- licensing- and- confidentiality- agreements- an- overview. aspx (describing confidentiality provisions as "[a]rguably one of the most critical aspects in any agreement" over intellectual property).

III. CONGRESS HAS CONSISTENTLY SOUGHT TO PROMOTE THE COMPLETENESS OF THE PUBLIC RECORD AND DISCOURAGE DELAYED REGISTRATION

Prior to the 1976 Act, the copyright registration system faced a problem: Courts took an increasingly lax stance on the registration requirement, allowing suits over works that had been published years—and, in some cases, decades—before the owner filed for registration. The legal and legislative history of the 1976 Act shows that Congress was abundantly aware of this trend, and sought to correct it. In constructing the 1976 Act, Congress went to great lengths to both address the growing problem of delayed registration, and preserve the benefits that registration provided.

A. Congress Explicitly Sought To Prevent Delayed Registration

Delayed registration was a known problem by 1976. The structure of the 1976 Act indicates that Congress intended to cure the problem by incentivizing creators to register their works as soon as possible to the point of fixation.

In the decades leading up to the 1976 Act, courts had repeatedly given broad leeway to rightsholders who waited to register their work. In many cases, the requirement for timeliness in deposit was rendered practically null; courts held that delays from 14 months, *Washingtonian Publ'g Co. v. Pearson*, 306 U.S. 30, to thirteen years,

Silvers v. Russell, 113 F. Supp. 119 (1953), were all acceptably "timely."

Congress was keenly aware of these cases; the committee report notes that "[t]here have been cases under the present law in which the mandatory deposit provisions have been deliberately and repeatedly ignored, presumably on the assumption that the Library is unlikely to enforce them." H.R. Rep. No. 94-1476, at 152 (1976). In an attempt to correct this frustrating trend, the new law included fines and "increased inducements" for registration and deposit. *Id.* at 150. This included a $2,500 fine—a number that, adjusted for inflation, represents nearly $11,000 in 2018 dollars. *CPI Inflation Calculator*, U.S. BUREAU OF LABOR STAT., https://data.bls.gov/cgi-bin/cpicalc.pl (last visited Sep. 21, 2018). Congress *explicitly* viewed these provisions as a way "to produce a more effective deposit system than the present [mandatory] one," H.R. Rep. No. 94-1476, at 150—that is, one that would effectuate a greater number of registrations and deposits, with less delay on the part of rightsholders.

B. Congress Deliberately Preserved Registration To Promote A Public Record

Given Congress's awareness of the importance of a comprehensive registration record, the 1976 Act is consistently designed to encourage early registration, even while removing other formalities such as mandatory deposit and printed notice.

Prior to the 1976 Act, copyright was issued—and revoked—by government action. In order to obtain protection, authors had to submit their works to the government for examination and deposit. "The requirement that an author must, as a precondition to the full benefits of copyright, register his claim and deposit his work with a designated public official antedates American copyright law and has been a part of every copyright law enacted in this country." Arthur J. Levine & Jeffrey L. Squires, *Notice, Deposit and Registration: The Importance of Being Formal*, 24 UCLA L. REV. 1232, 1253 (1977). Under the 1909 Act, a work had to go through a number of formalities to obtain copyright protection, including registration with the Copyright Office; deposit at the Library of Congress; and the inclusion of a conforming notice printed on the work itself. An Act to Amend and Consolidate the Acts Respecting Copyright, ch. 320, 35 Stat. 1075 (1909).

The 1976 Act sought to weaken the harsh consequence of failure to comply with formalities—invalidation of the copyright[2]—but even so, Congress still maintained the importance of a comprehensive registration record. As one

---

[2] These changes were largely made to implement the Berne Convention, which called for nations to remove formalities precedent to copyright. Even so, Congress did not fully implement Berne: The treaty's moral rights schema was not implemented, and the encouragements toward registration are another deviation from the Convention.

Congressional study on copyright registration noted,

> In the absence of a basic copyright registry system, identifying the work, the first owner of the copyright, the date from which the term is computed, and other pertinent information, the recording of transfers would often fail to identify the work covered by the transfer, the term of the copyright, and especially the derivation of the transferee's claim to ownership.

Alan Latman, *Study 19: The Recordation of Copyright Assignments and Licenses, in* COPYRIGHT LAW REVISION: STUDIES PREPARED FOR THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS 111, 124 (1956). In other words, Congress not only saw *ex ante* the potential dangers posed by removing formalities, but—as the legislative record shows—sought explicitly to mitigate them through the structure of the new Act.

Thus, Congress took deliberate steps to *preserve* the registration and deposit requirements by attaching them to a complex web of benefits and penalties. This is a testament to the unique and ultimately irreplaceable role that registration plays in the market for creative works; namely, its value in creating and maintaining a comprehensive public record of ownership rights.

CONCLUSION

For the above reasons, the Court should uphold the decision of the Eleventh Circuit.

Respectfully submitted,

HAROLD FELD
Counsel of Record
MEREDITH F. ROSE
PUBLIC KNOWLEDGE
1818 N Street Northwest
Suite 410
Washington, DC 20036
202-861-0020
hfeld@publicknowledge.org

No. 17-571

IN THE

Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORP.,

Petitioner,

v.

WALL-STREET.COM, LLC, AND JERROLD D. BURDEN,

Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

BRIEF OF WASHINGTON LEGAL FOUNDATION AS *AMICUS CURIAE* IN SUPPORT OF RESPONDENTS

CORY L. ANDREWS
Counsel of Record
CORBIN K. BARTHOLD
WASHINGTON LEGAL FOUNDATION
2009 Massachusetts Ave., NW
Washington, DC 20036
(202) 588-0302
candrews@wlf.org

October 18, 2018

QUESTION PRESENTED

Whether, under § 411(a) of the Copyright Act, a copyright owner may file an infringement suit after delivering the requisite deposit, application, and fee to the Copyright Office—but before the Register of Copyrights has acted on the application for registration.

TABLE OF CONTENTS

TABLE OF AUTHORITIES iv

INTEREST OF *AMICUS CURIAE* 1

STATEMENT OF THE CASE 2

SUMMARY OF ARGUMENT 4

ARGUMENT 7

I. THE REGISTRATION APPROACH BEST ACCOMPLISHES CONGRESS'S VITAL AIMS 7

A. The Registration Approach Best Ensures a Robust Copyright Registry 8

B. The Registration Approach Best Conserves Judicial Resources 11

C. The Registration Approach Best Sustains the Library of Congress 15

II. THE PETITIONER'S PRACTICAL CONCERNS ARE OVERSTATED 16

CONCLUSION 21

TABLE OF AUTHORITIES

Page(s)

Cases:

Am. Broad. Cos., Inc. v. Aereo, Inc.,
134 S. Ct. 2498 (2014) 1

Cosmetic Ideas, Inc. v. IAC/Interactivecorp,
606 F.3d 612 (9th Cir. 2010) 3, 8, 9, 11

Hallstrom v. Tillamook Cnty.,
493 U.S. 20 (1989) 17

Kernel Records Oy v. Mosley,
694 F.3d 1294 (11th Cir. 2012) 3

Kregos v. Associated Press,
795 F. Supp. 1325 (S.D.N.Y. 1992) 19, 20

La Resolana Architects, PA v. Clay Realtors Angel Fire, 416 F.3d 1195 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) 3

Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd., 545 U.S. 913 (2005) 1

M.G.B. Homes, Inc. v. Ameron Homes, Inc.,
903 F.2d 1486 (11th Cir. 1990) 3, 4

Petrella v. Metro-Goldwyn-Mayer, Inc.,
134 S. Ct. 1962 (2014) 5, 14, 19

Page(s)

Positive Black Talk, Inc. v. Cash Money Records Inc., 394 F.3d 357 (5th Cir. 2004), abrogated on other grounds by *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) 3

Psihoyos v. John Wiley & Sons, Inc., 748 F.3d 120 (2d Cir. 2014) 19

Reed Elsevier, Inc. v. Muchnick, 559 U.S. 154 (2010) 3

Torres-Negón v. J & N Records, LLC, 504 F.3d 151 (1st Cir. 2007) 11

William A. Graham Co. v. Haughey, 568 F.3d 425 (3d Cir. 2009) 19

Statutes:

Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (1976) ..... *passim*

17 U.S.C. § 407(b) 15

17 U.S.C. § 408(b) 15

17 U.S.C. § 408(f) 20, 21

17 U.S.C. § 410(c) 13

17 U.S.C. § 410(d) 18

17 U.S.C. § 411(a) ..... *passim*

Page(s)

17 U.S.C. § 411(b) 13

17 U.S.C. § 412 18

17 U.S.C. § 501 2

17 U.S.C. § 507(b) 18

17 U.S.C. § 508 14

17 U.S.C. § 508(a) 13, 14

Miscellaneous:

H.R. Rep. No. 94-1476 (1976) 8

H.R. Rep. No. 100-609 (1988) 8, 13

Letter from Ralph Oman, Register of Copyrights, to L. Ralph Mecham, Director, Administrative Office of the U.S. Courts (June 4, 1987) 12

Library of Congress, *About the Library: Fascinating Facts*, http://www/loc.gov/about/fascinating-facts/html 15

Library of Congress, *Annual Report of the Librarian of Congress for the Fiscal Year Ending September 30, 2007* (2008) 15

6 Willam F. Patry, *Patry on Copyright* (2017) 19

Page(s)

Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., Copyright Law Revision (H.R. Judiciary Comm. Print 1961) 8, 9

S. Rep. No. 100-352 (1988) 7, 12, 16

U.S. Copyright Office, *Circular 1—Copyright Basics* (Rev. 09/2017) 9

U.S. Copyright Office, *Circular 10—Special Handling* (Rev. 09/2017) 20

U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* (3d ed. 2017) 7

U.S. Copyright Office, *Fiscal 2017 Annual Report* (2018) 15

U.S. Copyright Office, "Preregister Your Work," at https://copyright.gov/prereg 20

U.S. Copyright Office, "Registration Processing Times," (October 2, 2018) 19

Robert Wedgeworth & Barbara Ringer, *The Library of Congress Advisory Committee on Copyright Registration and Deposit—Letter and Report of the Co-Chairs* 17 Colum.-VLA J.L. & Arts 271 (1994) 10

INTEREST OF *AMICUS CURIAE*[*]

Washington Legal Foundation is a nonprofit, public-interest law firm and policy center with supporters in all 50 states. WLF promotes and defends free enterprise, individual rights, limited government, and the rule of law. Since its founding in 1977, WLF has appeared as an *amicus curiae* in important copyright cases, urging the Court to interpret and apply the Copyright Act as Congress intended. *See, e.g., Am. Broad. Cos., Inc. v. Aereo, Inc.*, 134 S. Ct. 2498 (2014); *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005).

WLF has long supported a federal regime of robust copyright protection under the Copyright Act, to foster and reward the creativity and genius essential to a flourishing free-market economy.

To that end, WLF believes that the decision below, by requiring the Copyright Office to issue or refuse a registration certificate before a copyright is "registered" under § 411(a), best accomplishes Congress's carefully balanced policy aims. As WLF will show, those broad public concerns go far beyond protecting the interests of a copyright-infringement plaintiff in any given suit.

---

[*] No party's counsel authored any part of this brief. No person or entity, other than WLF and its counsel, helped pay for the preparation or submission of this brief. All parties have consented to the filing of WLF's brief.

STATEMENT OF THE CASE

Section 411(a) of the Copyright Act precludes a copyright holder from bringing a copyright-infringement suit until either (1) "registration of the copyright claim has been made" under the Act or (2) the required deposit, application, and fee have been "delivered to the Copyright Office in proper form" and "registration has been refused." 17 U.S.C. § 411(a).

The petitioner, Fourth Estate Public Benefit Corporation, creates online news content and—while retaining the copyright—licenses that content to third-party websites. Pet. App. 2a. The respondents, Wall-Street.com and its owner, Jerrold Burden, published some of the petitioner's news articles under a licensing agreement. *Ibid.* But after the respondents cancelled that agreement, they allegedly continued displaying the petitioner's copyrighted content without permission. *Ibid.*

The petitioner sued the respondents for copyright infringement under § 501 of the Copyright Act. Pet. App. 15a-22a. Though the complaint alleged that the petitioner had applied "to register [the] articles with the Register of Copyrights," *id.* at 18a, it failed to allege that the Copyright Office ever acted on that application.

While the petitioner's copyright application was pending, the respondents moved to dismiss the complaint. They argued that § 411(a) allows a plaintiff to sue for infringement "only after the Register of Copyrights approves or denies an application to register a copyright." Pet. App. 3a. The

district court agreed, rejecting the petitioner's suggestion that merely having "an application to register * * * pending at the time of the suit" is "sufficient to survive a motion to dismiss." *Id.* at 13a.

The Eleventh Circuit affirmed. Pet. App. 1a-10a. Observing that "the question when registration occurs has split the circuits," the appeals court noted that the Tenth Circuit follows the "registration approach," which "requires a copyright owner to plead that the Register of Copyrights has acted on the application—either by approving or denying it—before a copyright owner can file an infringement action." *Id.* at 4a (citing *La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195, 1197 (10th Cir. 2005), abrogated on other grounds by *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010)).

The Fifth and Ninth Circuits, the appeals court explained, follow the "application approach," which only "requires a copyright owner to plead that he has filed 'the deposit, application, and fee required for registration' * * * before filing a suit for infringement." Pet. App. 4a (citing *Cosmetic Ideas, Inc. v. IAC/Interactivecorp*, 606 F.3d 612, 619 (9th Cir. 2010), and *Positive Black Talk, Inc. v. Cash Money Records Inc.*, 394 F.3d 357, 365 (5th Cir. 2004), abrogated on other grounds by *Muchnick*, 559 U.S. at 154).

The Eleventh Circuit recognized that its own circuit precedent may have already embraced the registration approach. *Id.* at 6a (citing *Kernel Records Oy v. Mosley*, 694 F.3d 1294, 1302 n.8 (11th Cir. 2012), and *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488 n.4 (11th Cir.

1990)). But the court went on to reexamine § 411(a) and reaffirm its earlier endorsement of the registration approach.

The Copyright Act "makes clear," the Eleventh Circuit found, that registration is "a process that requires action by both the copyright owner and the Copyright Office." Pet. App. 6a. While the statute requires the copyright owner to begin the registration process—by filing an application, a fee, and a deposit of its work—it directs the Copyright Office to "examine" those submissions and "determine" whether to approve or refuse registration. *Ibid.* The petitioner's arguments about "legislative history and policy," the court held, couldn't overcome the Copyright Act's plain meaning: "[f]iling an application does not amount to registration." *Id.* at 6a-9a.

On that basis, the appeals court entered judgment for the respondents. Several weeks later, the Copyright Office refused the petitioner's registration application for failing to "meet the legal or formal requirements for registration." U.S. Cert. Br. App. 3a-9a. Among other defects, the petitioner had improperly submitted "multiple articles for registration" within a single application. *Id.* at 7a-8a.

SUMMARY OF ARGUMENT

The Copyright Act establishes a copyright holder's rights and remedies under federal law. While formal registration with the Copyright Office isn't a condition of copyright protection, it is a condition for filing a copyright-infringement suit.

Section 411(a) of the Copyright Act provides that "no action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title" or until the Register has refused registration. 17 U.S.C. § 411(a).

As the respondents and the Unites States have convincingly shown, the text, structure, and history of the Copyright Act support the commonsense view that copyright "registration" means more than just *applying* for registration. That is, registration under § 411(a) occurs when the Copyright Office *acts* on the application—either by issuing a certificate or by refusing one. "Although registration is 'permissive,' both the certificate and the original work must be on file with the Copyright Office before a copyright owner can sue for infringement." *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1977 (2014) (citing § 411(a)).

The petitioner's contrary view—that merely applying for a registration certificate accomplishes registration under the Copyright Act—flouts fundamental canons of statutory construction and does violence to the unambiguous words of the statute. WLF won't rehash those statutory-construction arguments here.

WLF wishes to emphasize, however, that the petitioner's reading of § 411(a) severely disrupts Congress's careful balancing of incentives and deterrents in the Copyright Act. Contrary to the petitioner's narrow focus, the Copyright Act advances federal policy concerns that go well beyond

the mere convenience of plaintiffs suing for alleged infringement.

First, vigorous copyright registration promotes a robust public registry that puts the world on notice of copyrighted works. *Second*, pre-suit registration conserves judicial resources by ensuring that federal courts have the benefit of the Register's considered view in copyright litigation. And *third*, by encouraging authors to deposit their creative works with the Copyright Office, § 411(a) gives the Library of Congress a vital source of works for its permanent acquisitions. In contrast, the petitioner's extra-statutory approach to copyright registration advances *none* of these broader policy goals.

The petitioner offers a parade of horribles that supposedly arise from copyright-registration lag time. According to the petitioner, requiring a copyright owner to wait to sue until the Copyright Office acts on the registration application forces the owner "to endure the ongoing theft of intellectual property." Pet. Br. 41. But the Copyright Office provides an expedited registration option for all pending or prospective copyright litigants. And while § 411(a) inconveniences an unregistered copyright owner by forcing her to register before bringing an infringement suit, the time the Copyright Register takes to process her application won't reduce the damages she ultimately recovers.

Here, because the petitioner filed its copyright-infringement suit before the Register of Copyrights acted on the registration application, the Eleventh Circuit rightly affirmed dismissal of the petitioner's suit.

ARGUMENT

I. THE REGISTRATION APPROACH BEST ACCOMPLISHES CONGRESS'S VITAL AIMS.

"The mere submission of an application to the U.S. Copyright Office does not amount to a registration. This is corroborated by the statute and the legislative history." U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 625.5 (3d ed. 2017). The petitioner insists, however, that "a copyright owner's statutory rights do not depend on administrative action." Pet. Br. 37. That is certainly true. But a copyright owner's available *remedies* depend on precisely that.

All the more because § 411(a) promotes distinct public ends that go well beyond the mere convenience of litigants bringing infringement suits. The Copyright Act "is underpinned by a number of incentives—legal, business, and personal—all of which point an author or other copyright proprietor toward the option of registration." S. Rep. No. 100-352, at 20 (1988).

By conditioning the right to sue for copyright infringement on review by the Register of Copyrights, Congress sought to maintain a public registry of copyright ownership, to conserve judicial resources, and to enlarge the Library of Congress's collection of original works. Contrary to the petitioner's view, each of those ends is best advanced by the Eleventh Circuit's registration approach.

A. The Registration Approach Best Ensures a Robust Copyright Registry.

As Congress has explained, registration as a prerequisite to suit "helps to ensure the existence of a central, public record of copyright claims." H.R. Rep. No. 100-609, at 42 (1988). Since 1790, a federal copyright registry has enabled a free market in creative works, allowing consumers to identify copyrighted works and their owners. Under the Copyright Act of 1909, federal copyright protection attached only upon publication, and even then only if the required notice, registration, and deposit occurred. But in 1976, Congress overhauled federal copyright law to create a uniform system giving "federal copyright protection to all works at the time of creation." *Cosmetic Ideas*, 606 F.3d at 618 (citing Pub. L. No. 94-553, 90 Stat. 2541 (1976); H.R. Rep. No. 94-1476, at 129 (1976)).

Though Congress eliminated the mandatory registration of copyrights, it didn't jettison the important goal of maintaining a public registry. On the contrary, Congress was concerned that "[c]opyright registration for published works, which is useful and important to users and the public at large, would no longer be compulsory, and should therefore be induced in some practical way." H.R. Rep. 94-1476, at 158. In early deliberations preceding the 1976 revision, the Register of Copyrights lamented that "[i]t is often cumbersome for would-be users to seek out the copyright owner and get permission." *Report of the Register of Copyrights on the General Revision of the U.S.*

Copyright Law, 87th Cong., Copyright Law Revision 6 (H.R. Judiciary Comm. Print 1961).

So Congress insisted that before a copyright holder may sue to enforce her copyright, she must either obtain a certificate of registration or be refused one. A certificate of registration "creates a public record of key facts" including "the title of the work, the author of the work, the name and address of the claimant or copyright owner, the year of creation, and information about whether the work is published, has been previously registered, or includes preexisting materials." U.S. Copyright Office, *Circular 1—Copyright Basics*, at 5 (Rev. 09/2017), https://www.copyright.gov/circs/circ01.pdf.

True enough, "copyright holders frequently register specifically for the purpose of being able to bring suit." *Cosmetic Ideas*, 606 F.3d at 619. To stop the infringement, a copyright holder whose works are being infringed presumably desires to bring suit as soon as possible. But that is precisely why the Eleventh Circuit's construction of § 411(a) best ensures a comprehensive public registry.

To work as intended, a public copyright registry must include both infringed and uninfringed works. So Congress needed some way to motivate copyright holders to register their works *before* infringement occurs. Only by requiring copyright claimants to obtain a certificate of registration before being able to sue for infringement could Congress guarantee greater public access to all copyrighted works.

By barring suit until the Copyright Office has acted on a registration application, the Eleventh Circuit's approach discourages a copyright holder from registering belatedly only after suffering an infringement. Of course, a copyright holder can avoid any inconvenience simply by registering her copyrighted work soon after she creates it. The registration approach thus ensures that more copyright holders will register more of their works sooner, resulting in a more robust and accurate registry.

The petitioner's application approach, by contrast, rewards delay and invites an incomplete registry. Under the petitioner's reading of § 411(a), dilatory copyright owners suffer only the slightest delay if they wait until infringement before applying for a certificate. They may sue for infringement as soon as the Register receives their application materials. Even worse, the petitioner's approach gives copyright owners *no* incentive to register uninfringed works. Indeed, if this Court were to adopt the petitioner's view, the federal copyright registry would likely become little more than a repository of previously infringed works. But that would defeat the purpose of having a public registry.

In sum, the registration approach best supports "a comprehensive and reliable copyright database, available freely to the public." Robert Wedgeworth & Barbara Ringer, *The Library of Congress Advisory Committee on Copyright Registration and Deposit—Letter and Report of the Co-Chairs* 17 Colum.-VLA J.L. & Arts 271, 280 (1994). Such a registry has proven all the more

valuable "[a]s the communications revolution gathers momentum." *Ibid.*

B. The Registration Approach Best Conserves Judicial Resources.

The decision below furthers another vital public-policy purpose—judicial economy. Far from a "needless formality," *Cosmetic Ideas*, 606 F.3d at 620, requiring a plaintiff to obtain (or to fail to obtain) a registration certificate as a prerequisite to suit insulates the federal courts from dubious copyright-infringement claims by "allow[ing] the Copyright Office to make an initial judgment about the validity of copyrights, based on its experience and expertise." *Torres-Negón v. J & N Records, LLC*, 504 F.3d 151, 161 (1st Cir. 2007). This "reduce[s] the burdens of litigation by giving that judgment some weight in subsequent litigation." *Ibid.*

But allowing copyright-infringement claims for uncertified works (as the petitioner urges) would extract more, not fewer, judicial resources from the federal courts. A party bringing an infringement suit without a registration certificate "bears a greater evidentiary burden of proving the validity of its copyright." *Cosmetic Ideas*, 606 F.3d at 621 n.14. And yet, a court obliged to scrutinize plaintiffs' attempts to clear that higher evidentiary burden must expend extra time and resources to do so.

Without a registration certificate to help streamline the issues for litigation, a claimant must prove authorship, copyrightability, and the lack of any competing claim with priority. And those showings, in turn, require more evidentiary filings,

motions, and arguments—all consuming more of the court's time and attention.

In contrast, the registration approach motivates potential claimants to organize and explicitly define the contours of their creative works ahead of unforeseen litigation. Rightly understood, § 411(a) "greatly ease[s] the strain on the courts by providing a reliable record and screening process." Letter from Ralph Oman, Register of Copyrights, to L. Ralph Mecham, Director, Administrative Office of the U.S. Courts (June 4, 1987). That is why eliminating the Copyright Act's registration prerequisite to suit would "grievously compromise" the "speedy and inexpensive resolution of copyright litigation in the federal courts." *Ibid.*

Indeed, § 411(a)'s registration requirement often relieves the court from ever having to adjudicate an infringement claim. After all, a putative plaintiff whose registration application is denied by the Copyright Office will often forgo suing rather than challenge the Register's determination. Likewise, a copyright defendant confronted with a claimant's bona fide registration certificate is much more likely to settle than to litigate. So after "the Copyright Office makes its preliminary findings, many potential court cases just disappear." Letter from Oman to Mecham, *supra*.

Congress feared that, without § 411(a)'s meaningful precondition to suit, claimants could force courts "to rule on an increased number of novel copyright issues, without benefit of an administrative record to expedite their proceedings." S. Rep. 100-352, at 23. Rather than arrest that fear,

the petitioner's reading of § 411(a) exacerbates it. Under the application approach, copyright claimants with dubious claims could require "courts—often in the context of a shortfused temporary restraining order or a preliminary injunction—to rule directly on their claims without risking the negative implications that would arise from a possible Copyright Office denial of registration." *Ibid.*

In other words, the Register's grant or denial of a certificate materially "assists the courts in resolving the underlying copyright dispute." H.R. Rep. No. 100-609, at 41. Above all, Congress wanted the courts, as well as copyright holders, to benefit from the presumption of validity that attaches to a registered copyright. So if registration occurs within five years of the work's first publication, the certificate is "prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. § 410(c).

Section 411 also empowers the Copyright Office's active participation in many infringement suits after the Register's initial registration decision. The Copyright Office may partake in litigation not only when a plaintiff sues for infringement after his registration application has been denied, *see* § 411(a), but also when the defendant alleges that the plaintiff's certificate contains deliberately misleading information, *see* § 411(b).

Nor is that all. Congress enlisted district courts to ensure that claimants satisfy § 411(a)'s registration requirement. Section 508(a) instructs district courts "[w]ithin one month after the filing of any action under this title," to "send written

notification to the Register of Copyrights [of] * * * the names and addresses of the parties and the title, author, *and registration number* of each work involved in the action." § 508(a) (emphasis added). And the court must update these notices by advising the Register of the registration numbers of any new works added to the litigation. *Ibid.*

Why would Congress insist that courts provide notice of infringement actions to the Copyright Office? To ensure that premature claimants will complete the otherwise voluntary registration process before being allowed to proceed in court. By directing district courts to send registration numbers to the Copyright Office, § 508's notice requirement allows courts to identify—for dismissal—deficient, unregistered infringement claims at the outset of litigation, even if the defendant otherwise may have waived pre-suit registration.

Under the Copyright Act, obtaining—not merely applying for—a copyright certificate is mandatory *before* burdening the courts. "Key evidence in [infringement] litigation, then, will be *the certificate*, the original work, and the allegedly infringing work." *Petrella*, 134 S. Ct. at 1977 (emphasis added). Congress insisted that the Copyright Office have a chance to weigh in before saddling the courts with litigation. That way, federal courts enjoy the benefit of the Copyright Office's expertise *before* expending precious time and resources.

C. The Registration Approach Best Sustains the Library of Congress.

The Library of Congress is the world's largest library, housing "more than 167 million items on approximately 838 miles of bookshelves." Library of Congress, *About the Library: Fascinating Facts*, http://www/loc.gov/about/fascinating-facts/html. "The collections include more than 39 million books and other printed materials, 3.6 million recordings, 14.8 million photographs, 5.5 million maps, 8.1 million pieces of sheet music and 72 million manuscripts." *Ibid.* By motivating authors to deposit their creative works with the Copyright Office, § 411(a)'s pre-suit registration requirement provides the Library of Congress with a major source of works for its acquisitions.

When a copyright holder deposits the registration copy of its work with the Register of Copyrights, the Copyright Office then forwards that work to the Library of Congress's permanent collection. *See* 17 U.S.C. § 407(b), 408(b). "Each year, the Copyright Office registers more than 500,000 claims and transfers more than 1 million copyrighted works to the Library's collection." Library of Congress, *Annual Report of the Librarian of Congress for the Fiscal Year Ending September 30, 2007*, at 25 (2008). In fiscal year 2017, the Copyright Office "forwarded more than 658,045 copies of works with a value of almost $41 million to the Library's collections." U.S. Copyright Office, *Fiscal 2017 Annual Report*, at 10 (2018).

As the oldest federal cultural institution in the United States, the Library of Congress confers a

vital public benefit. By conditioning the right to sue for copyright infringement on registration, Congress sought to expand the Library of Congress's collection of copyrighted works. As Congress recognized, § 411(a)'s pre-suit registration requirement "provides the Library of Congress with an efficient means of obtaining copies of copyrighted works." S. Rep. 100-352, at 19.

Just as it best ensures a robust public registry that includes both infringed and uninfringed copyrighted works, the registration approach best supplies the Library of Congress with the broadest assortment of unique works. Not so the petitioner's application approach, which removes any incentive for copyright holders to provide a copy of *every* work to the Copyright Office, leaving the Library of Congress deprived of countless uninfringed works.

II. THE PETITIONER'S PRACTICAL CONCERNS ARE OVERSTATED.

Urging the Court to sweep aside the plain text and broad public purposes of § 411(a), the petitioner contends that requiring a copyright owner to await registration before suing forces that owner "to endure the ongoing theft of intellectual property rights." Pet. Br. 41. What's more, the petitioner says, "if the Act's statute of limitations elapses before the Office acts on the application, the copyright owner may forever lose any ability to enforce the very rights the Act grants." *Ibid.*

These fears are unfounded. If anything, such concerns are best addressed by the registration approach.

1. "[I]t makes little sense," the petitioner says, for Congress "to give the Copyright Office the power to block suit through bureaucratic delay." Pet. Br. 20. But that assertion begs the question. After all, federal copyright remedies are matters of legislative grace. And the Copyright Act generally protects not the creator of a work, but the owner of a copyright.

To register timely before filing suit isn't that onerous. And like any other intellectual-property litigation, federal copyright-infringement actions are filed by highly specialized attorneys who are presumed to know the Copyright Act's statutory prerequisites. "Under these circumstances, it is not unfair to require strict compliance with a statutory condition precedent to suit." *Hallstrom v. Tillamook Cnty.*, 493 U.S. 20, 28 (1989).

In all events, it is hardly the case that requiring copyright holders to satisfy a straightforward precondition to suit makes "little sense." To cite just one example from above, although § 411(a) allows a copyright owner to sue regardless of the Register's decision on her registration application, the district court adjudicating the infringement suit will benefit greatly from knowing that decision. But under the petitioner's view, the district court can be left to guess. By postponing suit until the Copyright Office has made an initial determination, § 411(a) motivates copyright owners to register as promptly as possible rather than to wait until infringement.

2. At bottom, the petitioner claims that it is unfair to require a copyright plaintiff to endure any pre-suit interval of alleged infringement because of

the Register's bureaucratic delay. But Congress contemplated this very possibility when it enacted § 410(d)'s back-dating provision, which specifies the effective date of registration. Under that provision, registration is effective "the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights * * * to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. § 410(d).

And under § 412, Congress made statutory damages, costs, and attorney fees available to prevailing copyright owners for any infringement occurring after the effective date of registration. *See* § 412. So under the registration approach, the copyright holder can recover for any damages, costs, or fees incurred while the Register considers the registration application.

3. The petitioner also worries that the statute of limitations may expire while a copyright holder's registration application awaits the Copyright Register's review. Pet. Br. 41. But the petitioner cites no case in which that has ever happened.

Such a nightmare scenario is highly implausible. Under the Copyright Act, any civil infringement action must begin "within three years after the claim accrued." 17 U.S.C. § 507(b). As this Court knows, "the separate-accrual rule attends the copyright statute of limitations. Under that rule, when a defendant commits successive violations, the statute of limitations runs separately from each violation." *Petrella*, 134 S. Ct. at 1969.

Besides, the federal courts of appeals have adopted the "discovery rule" for copyright-infringement claims. *See Psihoyos v. John Wiley & Sons, Inc.*, 748 F.3d 120, 124 (2d Cir. 2014) (collecting cases). Under this rule, the limitations period starts to run when "the plaintiff discovers, or with due diligence should have discovered, the injury that forms the basis for the claim." *William A. Graham Co. v. Haughey*, 568 F.3d 425, 433 (3d Cir. 2009); *see* 6 Willam F. Patry, *Patry on Copyright* § 20:19 (2017) ("The overwhelming majority of courts use discovery accrual in copyright cases.").

According to the Copyright Office, the Register takes an average of eight months to resolve a registration application. *See* U.S. Copyright Office, "Registration Processing Times," (October 2, 2018) *available at* https://www.copyright.gov/registration/docs/processing-times-faqs.pdf. And the Register resolves nearly 70% of all applications within two to ten months. *Ibid.* So in the mine-run case, a copyright owner would have to sit on her rights, for years—in the face of glaring, ongoing infringement—before the statute of limitations would cause her to lose out on her claim.

Still, insisting that the petitioner's statute-of-limitations concern is "not idle conjecture," one of the petitioner's *amici* relies on *Kregos v. Associated Press*, 795 F. Supp. 1325 (S.D.N.Y. 1992). *See* ABA Br. at 30. But that case only bolsters the registration approach. As the court's decision reveals, Kregos's statute-of-limitations problem was "a self-induced problem." 795 F. Supp. at 1331. "Had plaintiff not sat on his rights for so long, the Copyright Office's prolonged delay would have been avoided

completely." *Ibid.* In any case, it turns out that Kregos's claim failed to "satisfy the creativity requirement for copyrightable expression." *Id.* at 1332. So any statute-of-limitations concerns were beside the point.

Yet even a dilatory plaintiff isn't without recourse. The Copyright Office's "Special Handling" option allows an applicant in "pending or prospective litigation" to pay a fee to "expedit[e] the examination of an application to register a claim to copyright." U.S. Copyright Office, *Circular 10—Special Handling*, at 1 (Rev. 09/2017), https://www.copyright.gov/circs/ circ10.pdf. "Once a request for special handling is approved, the Office will make every effort to complete its examination of the claim or document within *five working days*." *Id.* at 2 (emphasis added).

And to address the problem of pre-publication infringement, which often can't be remedied while the copyright owner waits to secure a certificate, the Copyright Act permits a claimant to sue for infringement if she has "preregistered." *See* 17 U.S.C. § 408(f). Preregistration "focuses on the infringement of movies, recorded music, and other copyrighted materials" before the copyright owners have had a chance to market their works. U.S. Copyright Office, "Preregister Your Work," at https://copyright.gov/ prereg.

Section 411(a) confers an immediate right to sue for infringement after preregistration. *See* 17 U.S.C. § 411(a). Yet in keeping with Congress's overall desire to cajole owners into formally registering all copyrighted works, the Copyright Act

provides that failure to timely register renders the preregistration ineffective, which can lead to dismissal of the suit. *Id.* at § 408(f)(4).

* * *

While § 411(a) inconveniences an unregistered copyright holder by forcing her to register before she may sue for infringement, the time the Copyright Register takes to process that registration won't reduce the damages she can recover. Even so, Congress provided an expedited registration process for all "pending or prospective litigation." Any gripes the petitioner has about the registration approach are far outweighed by the need to further Congress's broader public goals.

CONCLUSION

The Court should affirm the judgment below.

Respectfully submitted,

CORY L. ANDREWS
Counsel of Record
CORBIN K. BARTHOLD
WASHINGTON LEGAL FOUNDATION
2009 Massachusetts Ave., NW
Washington, DC 20036
(202) 588-0302
candrews@wlf.org

October 18, 2018